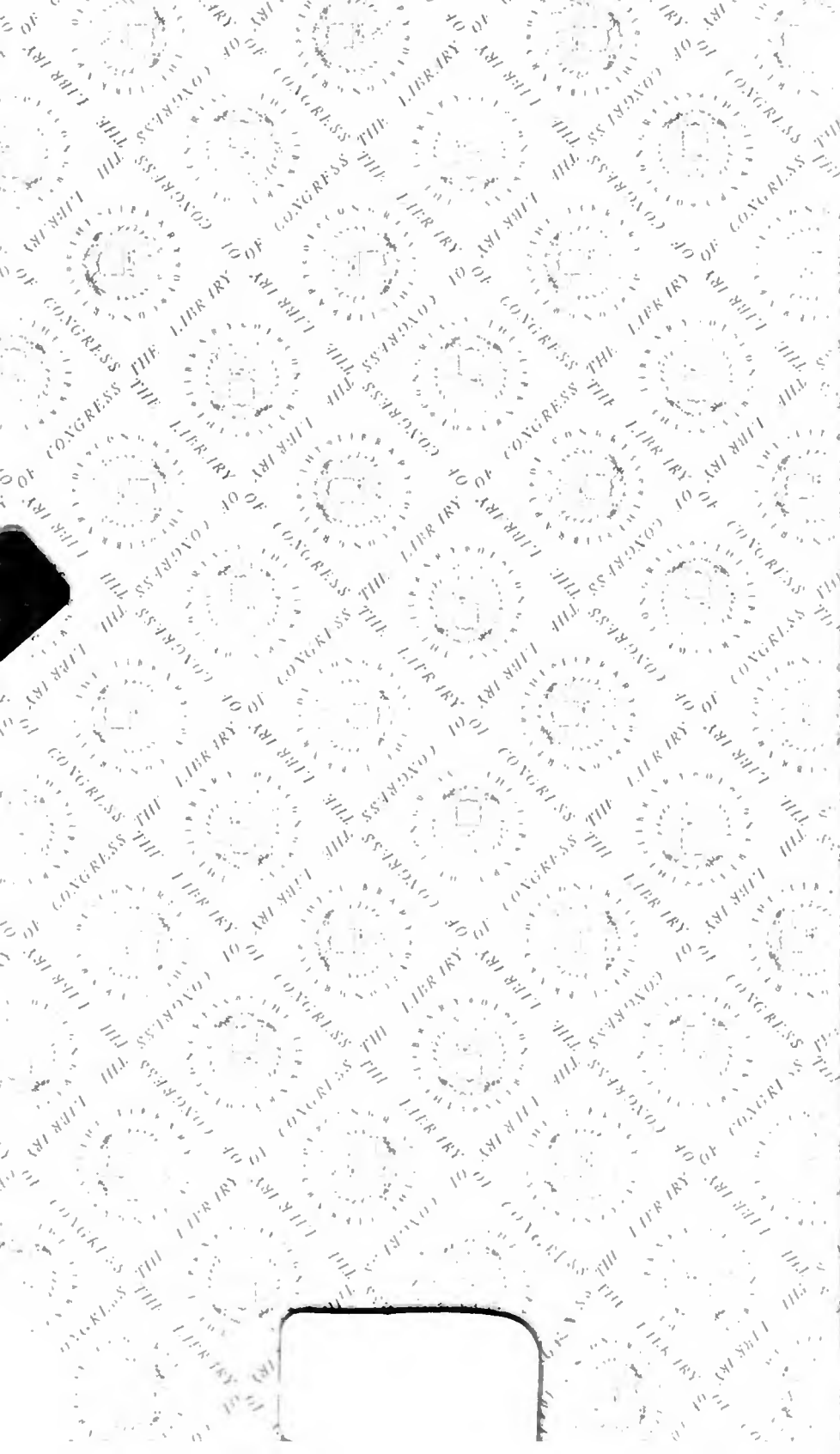


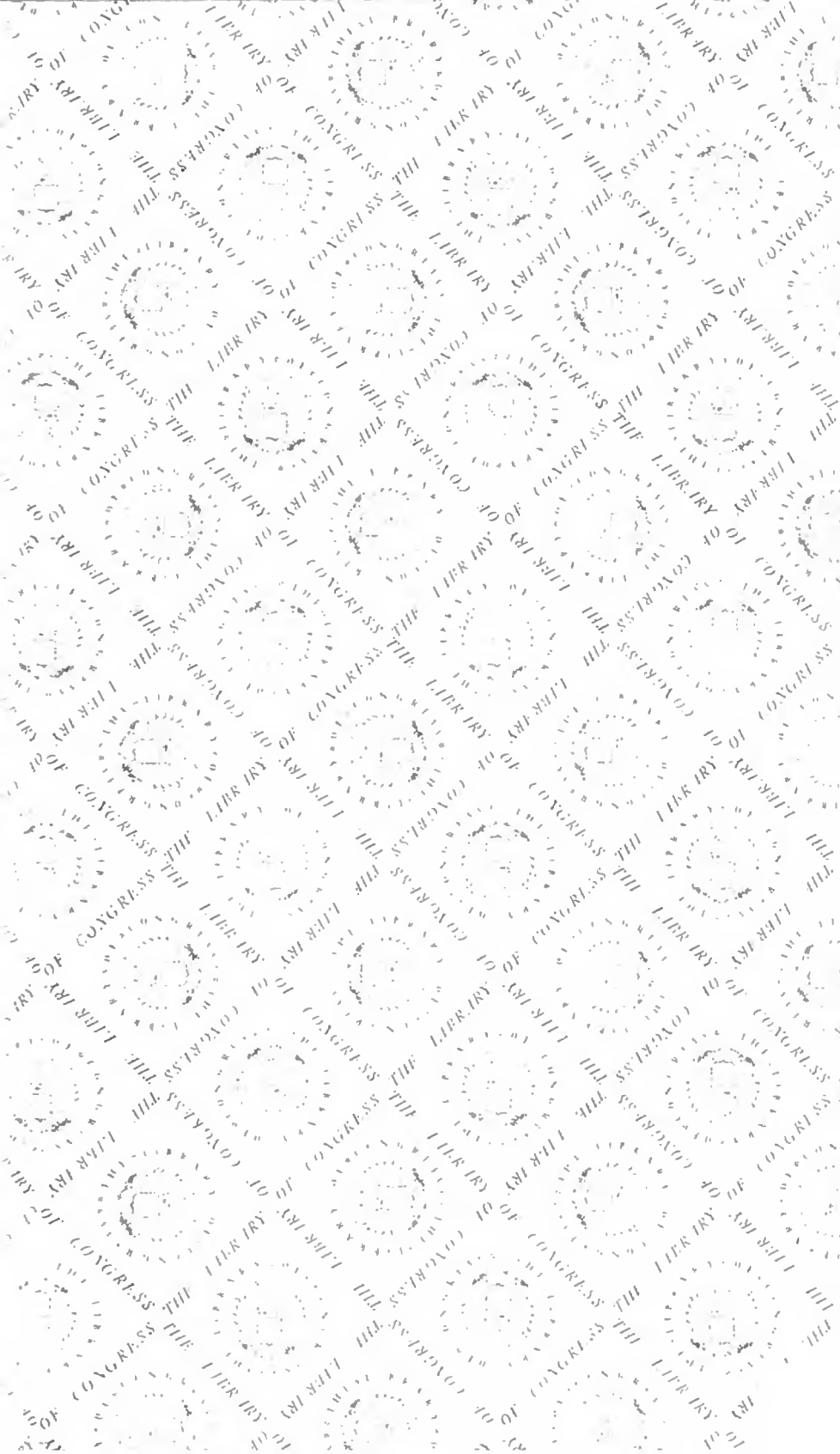
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CARD DIVISION
Congressional
Hearings, Debates, and Reports

**INTERNATIONAL CONVENTION
PATENTS AND TRADEMARKS**

4
Bills

U.S. Congress, House.

HEARINGS

BEFORE

SUBCOMMITTEE NO. 3

OF THE

COMMITTEE ON THE JUDICIARY.

HOUSE OF REPRESENTATIVES

EIGHTY-SEVENTH CONGRESS

FIRST SESSION

ON

H.R. 5754 and H.R. 7347

**BILLS TO CARRY INTO EFFECT A PROVISION OF THE
CONVENTION OF PARIS FOR THE PROTECTION OF INDUS-
TRIAL PROPERTY AS REVISED AT LISBON, PORTUGAL,
OCTOBER 31, 1958**

JUNE 15, 1961

SERIAL NO. 8

Printed for the use of the Committee on the Judiciary



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INTERNATIONAL CONVENTION—PATENTS AND TRADEMARKS

THURSDAY, JUNE 15, 1961

HOUSE OF REPRESENTATIVES,
JUDICIARY COMMITTEE No. 3,
Washington, D.C.

The committee was called to order, pursuant to notice, at 2 p.m., in room 327, Old House Office Building, Hon. Edwin E. Willis, chairman of the subcommittee, presiding.

Present: Representatives Willis (presiding), Libonati, Toll, Lindsay, Mathias, and Kastenmeier.

Also present: Cyril F. Brickfield, counsel.

Mr. LIBONATI. The meeting will come to order.

We are very pleased to see many of you here interested in the bills that are going to be heard and to testify as witnesses.

The first bill to be heard is H.R. 5754, and a similar bill, H.R. 7347; bills to carry in effect the provisions of the Convention in Paris for the Protection of Industrial Property as revised at Lisbon, Portugal, October 31, 1959.

(The bills follow:)

[H.R. 5754, 87th Cong., 1st sess.]

A BILL To carry into effect a provision of the Convention of Paris for the Protection of Industrial Property as revised at Lisbon, Portugal, October 31, 1958

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That section 119 of title 35 of the United States Code, entitled "Patents", is amended by adding the following paragraph thereto:

"In like manner and subject to the same conditions and requirements, the right provided in this section may be based upon a subsequent regularly filed application in a foreign country, instead of the first filed foreign application, provided that any foreign application filed prior to such subsequent application has been withdrawn, abandoned, or otherwise disposed of, without having been laid open to public inspection and without leaving any rights outstanding, and has not served, nor thereafter shall serve, as a basis for claiming a right of priority."

SEC. 2. Section 44(d) of the Act approved July 5, 1946, Public Law 489, Seventy-ninth Congress, chapter 540 (60 Stat. 427; 15 U.S.C. 1126(d)), is amended by adding the following paragraph thereto:

"In like manner and subject to the same conditions and requirements, the right provided in this section may be based upon a subsequent regularly filed application in a foreign country, instead of the first filed foreign application: *Provided*, That any foreign application filed prior to such subsequent application has been withdrawn, abandoned, or otherwise disposed of, without having been laid open to public inspection and without leaving any rights outstanding, and has not served, nor thereafter shall serve, as a basis for claiming a right of priority."

SEC. 3. This Act shall take effect on the date when the Convention of Paris for the Protection of Industrial Property of March 20, 1883, as revised at Lisbon, October 31, 1958, comes into force with respect to the United States and shall apply only to applications thereafter filed by persons entitled to the benefit of said convention, as revised.

[H.R. 7347, 87th Cong., 1st sess.]

A BILL To carry into effect a provision of the Convention of Paris for the Protection of Industrial Property as revised at Lisbon, Portugal, October 31, 1958

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That section 119 of title 35 of the United States Code, entitled "Patents", is amended by adding the following paragraph thereto:

"In like manner and subject to the same conditions and requirements, the right provided in this section may be based upon a subsequent regularly filed application in a foreign country, instead of the first filed foreign application, provided that any foreign application filed prior to such subsequent application has been withdrawn, abandoned, or otherwise disposed of, without having been laid open to public inspection and without leaving any rights outstanding, and has not served, nor thereafter shall serve, as a basis for claiming a right of priority."

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SEC. 3. This Act shall take effect on the date when the Convention of Paris for the Protection of Industrial Property of March 20, 1883, as revised at Lisbon, October 31, 1958, comes into force with respect to the United States and shall apply only to applications thereafter filed by persons entitled to the benefit of said convention, as revised.

MR. LIBONATI. We will hear first from the Honorable David Ladd, Commissioner, U.S. Patent Office, or whoever is here in his stead.

STATEMENT OF P. J. FEDERICO, EXAMINER IN CHIEF, U.S. PATENT OFFICE

MR. LIBONATI. Mr. Federico is an Examiner in Chief in the U.S. Patent Office; he has had a very illustrious career in this capacity and I look forward to the day when we can see him in a higher position.

MR. FEDERICO. Thank you, Mr. Chairman.

I am appearing for the Commissioner of Patents, who is unable to be here today. The bill before us is a result of an executive communication from the Department of Commerce. In other words, the Department of Commerce transmitted the draft and requested its introduction and consideration by the Congress.

My purpose is to explain the nature and objectives of the bill H.R. 7347 and its companion bill. But before going into the details of the bill itself, it is necessary to give some background explanation concerning the international convention and one of its important provisions. The title of the bill states that it is to carry into effect a provision of the Convention of Paris for the Protection of Industrial Property.

The particular treaty we are concerned with is commonly referred to as the International Convention for the Protection of Industrial Property. The term "industrial property," which is more common in Europe than in America, is an expression which is used to refer collectively to patents, designs, trademarks, unfair competition, and

matters of this sort, and the convention deals with these subjects. The treaty is of a special kind in that it is open to any country to become a party to it at any time that it chooses, and at the present moment there are about 50 countries, including the United States, which are parties. These include all the countries of Europe except Russia, Albania, and Andorra; other members are Canada, Mexico, Cuba, Brazil, the United Arab Republic, Morocco, Union of South Africa, Israel, Turkey, Japan, Australia, New Zealand, and others, making a total of about 50.¹

Mr. LIBONATI. Some come as observers, too, don't they?

Mr. FEDERICO. At their meetings—I mention that later, Mr. Congressman.

Mr. LIBONATI. All right.

Mr. FEDERICO. This treaty was first formed in 1883 by a diplomatic conference at Paris and it started in effect with about a dozen countries.

The United States adhered to it in 1887 and has been a party ever since. Since the first treaty of 1883, there have been revisions at diplomatic conferences in 1900, 1911, 1925, and 1934, the 1934 one being at London. The draft currently in force is the revision of London of 1934. There was a further revision in 1958, but this has not yet come into force. Each one of these revisions is a new treaty, which has to go through the ratification procedures, to come into effect; of course, each includes a large number of provisions which are identical with the preceding treaty.

In my own mind these revisions of the treaty are similar to revision bills in Congress whereby a bill might make various changes in an existing statute, but keeping the basic framework of the statute the same, just making improvements and changes.

The diplomatic conference held in Lisbon in October 1958 effected the latest revision of the treaty. Delegates from 40-member countries were present, as well as delegates from 8 nonmember countries. The Russians had a delegation of four observers, including the head of their Patent Office, and several officials, patent officials and political officials. The conference lasted nearly a full month, as you very well know.

Article 19 of the new treaty provides that it comes into force on June 1, 1963, between those countries which have by then ratified it and deposited the instruments of ratification with the Swiss Government. But if six countries ratify it and deposit their ratifications earlier, then the treaty may come into force earlier. The treaty only comes into force between those countries that ratify it and adopt it. The previous treaty continues as between them and the other countries until each one ratifies the new one, so there is a continuity on the common provisions.

¹ The countries which were parties on Jan. 1, 1961, as listed by the International Bureau in its publications are as follows (the year in parentheses after a name indicates the year of the last revision to which the country has adhered, in the case of those countries which have not adhered to the 1934 revision):

Australia, Austria, Belgium, Brazil (1925), Bulgaria (1911), Canada, Ceylon, Cuba (1911), Czechoslovakia (1925), Denmark, Dominican Republic (1925), Finland, France, Germany (Federal Republic of), Greece, Haiti, Hungary (1925), Indonesia, Iran, Ireland, Israel, Italy, Japan, Lebanon, Lichtenstein, Luxembourg, Mexico, Monaco, Morocco (includes Spanish zone (1925) and Tangier zone), Netherlands, New Zealand, Norway, Poland (1925), Portugal, Rhodesia and Nyasaland, Rumania (1911), San Marino, Spain, Sweden, Switzerland, Tunis, Turkey, Union of South Africa, United Arab Republic, United Kingdom, Vatican City, United States, Vietnam, Yugoslavia.

The U.S. Senate has already approved a resolution advising and consenting to the ratification of this treaty, but in advocating the resolution, the Department of State advised the Senate that the ratification would not be deposited, and it is not effective until deposited, until implementing legislation was passed.

The treaty, by its terms, is non-self-executing and any provisions which are inconsistent with our own statutes could not come into effect before amending the statute.

Mr. WILLIS. Say that again, please.

Mr. FEDERICO. The treaty does not operate by itself in overriding existing law. Any statute that is inconsistent with the terms of the treaty must be revised before the new provisions could come into effect. The treaty is subordinated to the authority of Congress in legislating.

Mr. WILLIS. As to laws on the books now?

Mr. FEDERICO. If there is an inconsistent law on the books, a law inconsistent with the new treaty, the new treaty will not change it. Congress itself has to change the law. I will explain that further in connection with the next point.

Mr. WILLIS. All right.

Mr. FEDERICO. As a matter of fact, this treaty is of the type which is not self-operating to override existing legislation.

Mr. LIBONATI. In other words, they could approve the treaty, but it would not have any effect unless the Senate and House change the law.

Mr. FEDERICO. That is the situation. It is written into the terms of the treaty.

Mr. WILLIS. What does it say?

Mr. LIBONATI. The approval of the treaty agreements made by these men as our delegates to these conventions can be accomplished, but in order for it to affect the law upon which the treaty is based, it has no effect until the Senate and House changed that provision.

Mr. WILLIS. I know that. But I am talking about after—

Mr. FEDERICO. That is especially the case with this treaty. It is emphasized in one of the provisions, namely, article 17:

Every country party to this Convention undertakes to adopt, in accordance with its constitution, the measures necessary to ensure the application of this Convention.

This point will be amplified in a moment in connection with the particular provision with which the bills are concerned.

The report of the U.S. delegation to the Lisbon Conference contains a list of the various changes which were made by the Lisbon treaty over the preceding treaty, and gives the discussions and explanation of the various changes. It so happens that practically all of the changes that were made by the new treaty are already in consonance with U.S. law and nothing is needed to change the law. To give an example, a new provision in the treaty requires that each of the countries protect service marks. These are trademarks used in connection with services, rather than in connection with goods. Now our trademark law, the Lanham Act, passed in 1946, for the first time provided for the protection and registration of service marks. So we do not need to do anything in connection with that provision of the treaty.

It is already in our statute. Similarly with most of the other changes, in one way or another, they are taken care of by some statute or common law or various provisions.

It is not necessary here to go into the nature of these various changes, since the bill is not concerned with any of them except one. There is only one provision in the new treaty which is inconsistent with language in our present statute.

As to this particular provision, a change in the patent and trademark statute is necessary to harmonize it with the treaty. That is the subject matter of the bill, to make this one change in the patent and trademark statute, to harmonize it with one of the new provisions of the treaty.

Now this change deals with a subject that is referred to commonly as the right of priority, which I will have to explain first before explaining the point of the change.

It is still necessary for an inventor who wants patent protection to obtain a patent in each country in which he is interested. There is no international patent as yet, although occasionally there is talk about finding ways and means of getting a patent that covers several countries. But a patent now can only confer rights in the jurisdiction that grants it.

At the time that the convention originated, in 1883, there were many difficulties in the way of an inventor who wished to obtain patents for his inventions in a number of different countries. One of the greatest difficulties was that of the timing. According to the laws of most countries, the right to a patent is lost if the invention has become known to the public before the date of applying for a patent. For example, according to the law of France in the 1880's, and still today, if the invention has become known to the public, either by the activities of the inventor himself, or by anybody else's activities, the day before he applies for a patent, then the right to a patent is lost. It is lost completely. That is the law in most foreign countries.

An inventor would naturally apply in his own country first, and if he thereafter applied for patents in foreign countries, he would often be defeated from getting a patent in the other countries by things which had happened in the meantime. For example, if he had sold articles or commercialized his invention or even if his home patent issued, the publication of it, and the knowledge of it by the public, would defeat his right to get a patent in the later country.

To make it easier for inventors to get patents in other countries——

Mr. WILLIS. Are you talking about American inventors now?

Mr. FEDERICO. This was for any inventor who was interested——

Mr. WILLIS. What you are now explaining would result, if an American inventor wanted to get a patent in France, let's say.

Mr. FEDERICO. This principle I mentioned would affect him.

Our own law happens to be more liberal. We don't have this principle that publication of the invention the day before you apply for a patent defeats the patent. Under our law inventors can deal with their invention and apply within a fixed period.

Mr. WILLIS. What is that period?

Mr. FEDERICO. Within a year. But in most foreign countries they do not have the principle that we have. So we have to look at this provision, or at this situation, as Americans being affected in foreign

countries. They would be defeated in getting rights to a patent by their own activities which occurred before they applied for a patent in the foreign country.

We are talking about the situation in the 1880's. So the principle was conceived to ease the situation by making the first application that the inventor filed in one of these member countries equivalent to filing in all of them simultaneously. We could look at it as constructive filing. You file in your home country, and automatically you have filed in all of the countries of the group.

But it must be followed up with the actual filing within a year. One year is the present period. Hence the first application filed by an inventor starts a period of one year, in which he doesn't need to be in a hurry, and anything could happen, but he could apply in any one of these countries during that period and be safe, because he is pushed back to his first date.

Of course, if he applies after this year is over, his application must stand on his own date. He does not get this advantage. So the first application starts a period of a year running, which gives him advantages in filing in foreign countries. When the year is over he can still file, but he would lose the particular advantage.

Mr WILLIS. Of the constructive filing?

Mr. FEDERICO. Yes. Of the original filing date. But usually, or quite often, if you have lost that date, you have also lost a right to get a patent. Not always, but most of the time.

Now this antedating—looking at it another way, if an inventor applies for a patent in one country, one of the member countries, and then applies for a patent in a second country within a year from the first, the second application is antedated back to the date of the first one—this antedating removes any destructive effects of any acts that have occurred in the interim. Not only that, but the application takes precedence over anybody else's application which may have been filed during the period.

I will give a specific example: An American inventor who applies in the United States has 1 year in which to apply for a patent in any one of these 50 countries and those applications will be related back to his U.S. filing date, and any acts that have occurred in the meantime have no effect on his rights. Not only that, but if someone else in that foreign country has applied for a patent for the same invention, the American's application will be dated back to the U.S. date and he will be ahead of him. You not only remove the effects, the destructive effects, of intervening acts, but you also take precedence over any other application that has been filed in the interim.

Of course, the American who files in the foreign country has to observe all the requirements and conditions of the law, whatever they are, and the American must be treated equally with the citizens in this respect by virtue of one of the articles of the treaty. But he has this advantage of the early date.

Now, this principle is worked out in our law in section 119 of title 35.¹ This section relates to a foreigner applying in the United States. The American applying in the foreign country is taken care of by the treaty and the law of the foreign country. This section of the statute provides, in effect, that if the person has first applied in a foreign country and then applies in the United States within a year, his U.S. application is related back in date to the foreign application, subject to various conditions with which we are not concerned at this time. Certain papers have to be filed and so forth.

Now these are established rights that have been in existence for some time, but developed in detail with each succeeding revision of the convention. They put in perfections and various details. According to the convention in force, it is only the first application that an inventor files which starts this 1-year period—that is, serves as the starting point for this right of priority.

If an inventor has filed a series of applications for the same invention, in the same or in different foreign countries, he cannot arbitrarily select one of them, the second, third, or fourth, and use that as a starting point for the year period to file in a later country.

Mr. WILLIS. He must go to the first?

Mr. FEDERICO. He must always go to the first. The year starts running from the first application and when the year is up the time to get this advantage is gone. Everything is related back to the first application. He can only claim the date of the first application for those applications that are filed in other countries, within that original year, and that is all.

This result is also expressed in our statute, by referring to the first or earliest application.

I think it would make the explanation a little bit easier to follow if you look at the diagram which has been devised to bring out the principle of the bill.

¹ This section reads as follows:

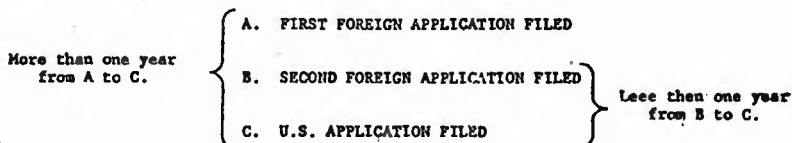
"§ 119. Benefit of earlier filing date in foreign country; right of priority

"An application for patent for an invention filed in this country by any person who has, or whose legal representatives or assigns have, previously regularly filed an application for a patent for the same invention in a foreign country which affords similar privileges in the case of applications filed in the United States or to citizens of the United States, shall have the same effect as the same application would have if filed in this country on the date on which the application for patent for the same invention was first filed in such foreign country, if the application in this country is filed within twelve months from the earliest date on which such foreign application was filed; but no patent shall be granted on any application for patent for an invention which had been patented or described in a printed publication in any country more than one year before the date of the actual filing of the application in this country, or which had been in public use or on sale in this country more than one year prior to such filing.

"No application for patent shall be entitled to this right of priority unless a claim therefor and a certified copy of the original foreign application, specification and drawings upon which it is based are filed in the Patent Office before the patent is granted, or at such time during the pendency of the application as required by the Commissioner not earlier than six months after the filing of the application in this country. Such certification shall be made by the patent office of the foreign country in which filed and show the date of the application and of the filing of the specification and other papers. The Commissioner may require a translation of the papers filed if not in the English language and such other information as he deems necessary."

(The diagram follows:)

Principle of H.R. 5754 and H.R. 7347



Present Treaty and Statute

- (1) Application C cannot be given the benefit of the date of Application A because it was filed more than one year later.
- (2) Application C cannot be given the benefit of the date of Application B because Application B was not the first foreign application.

Revised Treaty and Bill

- (1) Application C cannot be given the benefit of the date of Application A because it was filed more than one year later. (No change).
- (2) Application C can be given the benefit of the date of Application B, provided that Application A has been withdrawn or abandoned, and has not been utilized for any rights, etc.

Mr. FEDERICO. We have to think of three applications. They are A, B, and C, expressed in time sequence. A, first foreign application filed; B, second foreign application filed; and C, U.S. application filed. It is more than 1 year from A to C.

Now, according to the present treaty and statute, the third application, application C, cannot be given the benefit of the date of application A because it was filed more than 1 year later.

Mr. WILLIS. Between A and C, you mean?

Mr. FEDERICO. Yes. The year period starts with A.

Then, point 2, application C cannot be given the benefit of the date of application B, even though there is less than a year between B and C, because application B was not the first foreign application. That is the situation under the present version of the treaty and the present statute.

The revised treaty adds a paragraph 4 to the appropriate article, 4C,¹ to provide that under certain circumstances you can forget the first application and start afresh with the second one.

Looking at the right on the diagram, according to the revised treaty and the bill, and considering the same situation of three applications, the first point remains the same, application C cannot be given the benefit of the date of application A because it was filed more

¹ Article 4C reads as follows:

"C.—(1) The above-mentioned periods of priority shall be twelve months for patents and utility models, and six months for industrial designs and for trademarks.

"(2) These periods shall start from the date of filing of the first application; the day of filing shall not be included in the period.

"(3) If the last day of the period is an official holiday, or a day when the Office is not open for the filing of applications in the country where protection is claimed, the period shall be extended until the first following working day.

"(4) A subsequent application for the same subject as a previous first application within the meaning of paragraph (2) above and filed in the same country of the Union, shall be considered as the first application, of which the filing date shall be the starting point of the period of priority, provided that, at the time of filing the subsequent application, the previous application has been withdrawn, abandoned or refused, without being open to public inspection and without leaving any rights outstanding, and has not served as a basis for claiming a right of priority. The previous application may not thereafter serve as a basis for claiming a right of priority."

than 1 year later. But application C can be given the benefit of the date of application B, the second application, under the conditions specified. And the conditions specified are that application A has been withdrawn or abandoned and no rights have been asserted under it. In other words, it has been, in effect, blotted out. If no advantage has been obtained from it, no rights, and so forth, you are privileged to blot it out and start afresh with application B as starting a new 1-year period.

Mr. WILLIS. What would be an illustration of an abandoned one? Does that contemplate a situation where application A has ripened into a patent or—

Mr. FEDERICO. No, application A must be killed completely.

Mr. WILLIS. How can it be killed? What constitutes an abandonment or withdrawal?

Mr. FEDERICO. I will explain that by applying this principle to an American citizen.

Suppose an American citizen applies for a patent. Now, it sometimes happened that he is dissatisfied—

Mr. WILLIS. In the United States?

Mr. FEDERICO. Yes. It sometimes happens he is dissatisfied with that application; he didn't get all the details in it he wants, or for some reason or other. He can abandon it by writing a letter saying "I abandon this application," or he could abandon it by failing to take appropriate action under the patent law.

Then sometimes the application might be abandoned accidentally. He may not have intended to do so, but due to some lapse on his part, it was permitted to become abandoned. That happens now and then; not too often.

Then the American after the abandonment reapplies in the United States with a fresh application. The first one is dead, no rights can be asserted under it, a patent can't issue on it, it is abandoned; and he reapplies in the United States. Then the second U.S. application can serve as the starting—

Mr. WILLIS. By the same applicant?

Mr. FEDERICO. Yes. We are always talking about one inventor applying in different countries.

Mr. WILLIS. But that assumes, of course, in the case you theorize, that no third party in the meantime applied for another one?

Mr. FEDERICO. That is correct.

Mr. WILLIS. I mean it hasn't been preempted by other parties?

Mr. FEDERICO. That is correct, because in the United States the second application in the situation premised would stand on its own date. If other parties have come in and there are controversies between them, they are outside of this present picture. Then this American inventor can use the second application to start a fresh 1-year period to apply in foreign countries. Under the old principle, the 1-year period only started with his first application.

Mr. WILLIS. There has been a rollover, so we will take a short recess. (Recess.)

Mr. WILLIS. You may proceed, Mr. Federico.

Mr. FEDERICO. Mr. Chairman, I had finished the basic exposition of the principle of the bill. In view of the fact that section 119 of title

35 is limited by its language, in referring to the earliest or first filed application, it is necessary to amend the section.

Section 1 of the bill does this by adding a paragraph to section 119 and this paragraph is in substantially the language of the added provision of the treaty.

The first application must be wiped out in order for the inventor to be able to rely on the second. The conditions are specified in the bill, that the earlier application has been withdrawn, abandoned or otherwise disposed of. That is a general expression to indicate that the first application has been gotten rid of by whatever means is provided in the laws of the particular country. Then it says: "without having been laid open to public inspection."

In certain countries, at a certain stage in the prosecution of the application, it is made public. They refer to it as laying open for inspection, for public inspection. Now if that has happened, it is too late for that application to be wiped out of consideration.

Mr. WILLIS. And that passage then would be a new provision in our law to conform with laws of other nations with reference to open public inspection?

Mr. FEDERICO. This refers to what has happened in the foreign country. If the foreign application has been laid open to public inspection, then it can no longer be eliminated.

Mr. WILLIS. Because under the law of the foreign country, that would be the result?

Mr. FEDERICO. Yes, also the first foreign application must not have served as the basis for claiming any rights. We are speaking now of the conditions that must exist, in order for the first application to be disregarded and a new 1 year started from the second application.

Section 2 of the bill adds the same provision to the trademark law. I haven't said anything about trademarks, but there is a right of priority in connection with trademark applications, similar to the right of priority in patent applications.

In trademark applications the period is 6 months, instead of a year, and the right of priority is not exercised as often as in patent cases, because dates play a lesser part in trademark applications. But since they are in the same general language, we have to treat patents and trademarks together.

Neither the Patent Office nor the State Department has had any objection to adopting, or putting this principle in our law and no controversies have been mentioned in any bar association meetings. The Patent Section of the American Bar Association has passed a resolution recommending that legislation of this type be passed, and so has the American Patent Law Association.

It is in a general sense a small technical change in the patent law to accommodate the language to the language of the new treaty.

Mr. WILLIS. There is one question that occurs to me and it is probably because it is not completely clear to me. Could the privilege of this bill be taken advantage of by a deliberate abandonment in order to obtain a right which does not now exist? In other words, would this result in wide open, not passive abuse, whereby a person, in order to get the advantages of this bill would deliberately abandon his original application in order to be eligible to get a foreign patent?

Mr. FEDERICO. Well, we first must think of the foreigner who is going to get a U.S. patent. He has filed in his own country first,

normally that is the procedure followed. Time has run by, and he is in the stage where he wants to decide what to do. If he files a second application in the foreign country, in order to get the advantage of this new point, he must not only first drop the first application, but drop all rights under it, and he drops down to his second date, so he couldn't very well, by that procedure, overreach somebody, because he is now relying on a later date, and if somebody has come in in the meantime, the foreigner would be after him, later than him.

Mr. WILLIS. Yes, but suppose someone, a German, let's take the present law now—someone in Germany, applies for a patent. He has 1 year, do I understand, to apply for an American patent, 1 year from that application in Germany?

Mr. FEDERICO. He has, under the present law—if he files in the United States, within 1 year—

Mr. WILLIS. No, let's talk about the reverse.

Mr. FEDERICO. The German. The German inventor who applies in Germany; under the present law, if he applies in the United States within 1 year, his U.S. application is antedated back to the German date. He doesn't have to file within the year. If he files later, he loses the advantage of that early date. But he still could get a patent, standing on his own date in the United States if nothing has happened in the meantime, if no others have applied for a patent, etc. he could still get a patent. It is not mandatory to apply within a year. It is just that if you do apply, you get the special advantage of being antedated back.

Mr. WILLIS. Over third-party applicants.

Mr. FEDERICO. Yes. Now the present situation would be this and I will illustrate with a German inventor. Looking at the diagram, the German inventor filed an application in Germany. Then later on he was dissatisfied with that application, and he started afresh and filed a new application in Germany, and then later on he filed in the United States. Under the present system, which is on the left of the diagram, the application in the United States cannot go back to the first application, because it is more than a year later, we are assuming it is more than a year later, and it cannot go back to the second application, because the second one is not the first.

The present law is limited to the first. Under this new principle, assuming the same German inventor filed one application in Germany and filed a second one, and then filed in the United States, provided that first German application has been completely obliterated by no rights having been asserted under it, the date is given up, he hasn't asked for priority for that case any place else, and so on. He can drop down to the second German application and claim that date.

If anybody has moved in, between the first and second German applications, the German would lose out, because he gets no dates from his first German application. If he had his eye on filing in the United States, at the time of point B, if he specifically contemplated filing in the United States, and he had already filed in Germany, it would be foolish for him to give up his early German rights in order to file a new German application, because he could file in the United States right away. He doesn't have to wait to file in the United States.

Mr. TOLL. This gives him two bites at the apple, doesn't it?

Mr. FEDERICO. In one sense. An inventor dissatisfied with his first application is given the privilege of wiping it out and dropping down to a later date.

Mr. TOLL. Or an inventor that never made the time in America, decided to refile in another foreign country, to get another 1-year advantage.

Mr. FEDERICO. If, at the second point, he decides he wants to file in the United States, and he presumably could do that by means of giving up the first German case, filing a new German case, and then filing in the United States, but there would be no particular advantage in doing that, because if he had reached the stage where he decided he wanted to file in the United States, he could keep the first German case and file in the United States directly.

Mr. TOLL. Then what is the motive behind this arrangement? To give Europeans a chance to straighten themselves out in this country with their inventions?

Mr. FEDERICO. It works both ways. In many instances an American has filed a case and it becomes abandoned and he files a new one; he gets a fresh start in this country. Then he would likewise have a fresh start on the 1-year period. It is a reciprocal provision. It works both ways.

Mr. BRICKFIELD. What is the need, the great need for this legislation?

Mr. FEDERICO. I will say frankly we would never have thought of this specific provision, and would never have asked for legislation to put it in, because it does not appear that there is any great need for it. It happens now and then, and it is an advantage that will happen now and then both ways. But there isn't, as far as I know, any large need and I believe that it will have only a very limited application. At the Lisbon Conference, there were a large number of propositions up for consideration for putting into the treaty; some of them, the United States was against; others we were advocating; as to others the position was fairly neutral. This particular provision was in the last category, and during the negotiations, it got narrowed down somewhat.

Now, the majority of countries, when it came to that situation, were faced with the question of voting for it or against it? Those who had to vote against some things at the Conference, used their ammunition on the things worth shooting down.

Mr. TOLL. But the greater advantage here is to the Europeans?

Mr. FEDERICO. It is hard to assess which way it would be greater.

Mr. TOLL. We have the bigger market, haven't we, for inventions?

Mr. LIBONATI. No, we haven't. It is an assumption but it is not true.

Mr. TOLL. To sell results of these inventions in this country would be a tremendous advantage to Europeans.

Mr. FEDERICO. Well, yes. Looking at it another way, Americans file more applications in the European countries than the European countries file in the United States. The numerical advantage, in the sense of more activity and more filing of applications and getting patents and so forth is in the favor of the United States.

If this particular situation comes up uniformly, uniformly distributed, the numerical advantage would be with the United States.

Now the actual value of a patent, once obtained, would be greater in one country than in another country. But in the cross-getting of

patents among countries, the United States files and obtains more in the foreign countries than the foreign countries do in the United States.

Mr. LIBONATI. Further, there is more pilfering of American patents in foreign lands. And this would protect them, especially in the field of medical formulas, chemical formulas and so forth, which was brought out at the convention in discussions on this subject. This would protect the American companies here, and protect their patents along lines of formulas, and especially as to patented rights machinery. There is also quite a bit of pilfering of other American patents, and in Germany and Yugoslavia, especially; and the ultimate result is that this provision protects our large corporations, much more so in view of the fact that so many key patents with other relative patents are filed by large corporations, to protect along the line of different models, different concepts of the invention—discouraging those who might dishonestly abrogate that patent in design and so forth.

I think the greatest protection is enjoyed by the United States on this provision, as far as priority of dates, because we know under some practices that as soon as something is registered in the United States, immediately someone files a patent in another country; it may even be a subsidiary of the company in the United States. That agency will take advantage of its association with the mother company in the United States and file personal and individual patents. And I think that this provision protects us far more than any foreign prohibition of it.

Mr. WILLIS. Under present practice, suppose a person in Germany filed an application for a patent January 1, 1959. And he lets it remain dormant, because he doesn't feel that it might be successful. Anyway, he doesn't prosecute it. Then in November of 1959 someone in the United States, without knowing what went on in Germany, gets the same idea?

Mr. FEDERICO. He files in the United States.

Mr. WILLIS. Yes. And, of course, the Patent Office here doesn't necessarily know what is in Germany. Suppose a patent issues here. Suppose he filed it in May and by some miracle it issues in November 1959; then, without his knowing, if the German patent is perfected, that German patent would be constructive notice here and the German applicant could come here on January 1, 1960, and, in effect, outlaw that patent of November 1959?

Mr. FEDERICO. You ask the basic important question under right of priority. And I want to explain it both ways because our law is a little different from the laws of other countries, I think, taking two examples crisscrossing would illustrate the point.

Let's assume an American has filed an application, on January 1, 1959.

Mr. WILLIS. In America?

Mr. FEDERICO. In the United States. Then in May 1959, a Frenchman files an application in France for the same thing. And the patent issues later that year, November 1959.

Mr. WILLIS. In France?

Mr. FEDERICO. Yes, in France.

Then on January 1, 1960, which is within the year, the last day is included in the year, but make it December 31, 1959, this American files in France. And under the existing provision—we are talking about the existing provision—he goes back in date to January 1, 1959, which overcomes the French applicant's date of May 1959, and according to the French law the first applicant gets the patent, so the American will get his patent and it will be valid over the Frenchman's patent and the Frenchman's patent will be invalid, it will be in effect nugatory. This is not limited to Americans, of course.

Mr. WILLIS. All right.

Mr. FEDERICO. Now, let's take the reverse situation.

The Frenchman files, or the German files in Germany January 1, 1959. Then an American or somebody else files in the United States in May 1959. And then the German files in the United States on December 31, 1959.

Mr. WILLIS. The same thing happens?

Mr. FEDERICO. As to dates. The German's application in the United States, of course, is dated back to January 1, 1959. So he is ahead of the second U.S. applicant. But under our law it is not always the first applicant who gets the patent. The German stands with the January 1 filing date, the other stands with the May filing date and then they proceed under our law, where we require a contest to determine who is the first inventor (however, the applicant with the earliest filing date wins in the majority of cases).

Mr. WILLIS. Irrespective of the filing date?

Mr. FEDERICO. Yes.

Mr. WILLIS. And that is true under the American law?

Mr. FEDERICO. Yes, in our law and in only a few other countries. In the reverse situation, the situation would not be the same, because the foreign laws do not all have the first inventor concept but go by the first applicant concept. So there is a slight advantage our way on the basic principle.

Now, the right of priority has been in existence for quite a long while. And it is a reciprocal advantage. You have to give up something, if you are going to get an advantage the other way. That is the way this right of priority operates today.

Mr. WILLIS. Let's apply my hypothetical case on the assumption that this bill is passed. Suppose the German files an application in Germany January 1, 1959. And some one in the United States files in November 1959. The German discovers about the filing in February 1960. Would he have an incentive to cancel his January 1, 1959, application, file a second one in May 1959?

Mr. FEDERICO. When did he discover it? Are you assuming it was discovered in February 1960?

Mr. WILLIS. Well, of course, I am assuming in this instance that filing and discovery are the same, however, let me pursue it so the record will be plainer. In the situation I have described, the German then, under provision of American law, would have no advantage in deliberately canceling his application of January 1, 1959, and invoking a second filing date in May 1959, in order to have the first application which would apply reversed, because of the provision of the American law as to first discovery and not first filing?

Mr. FEDERICO. That is right. But on the other hand if in May 1959 the German realized he ought to file in the United States, there would be no advantage to him in killing the first German case and starting a new one, because once he knows he ought to file in the United States, all he has to do is translate his German papers, attach an oath and go before the American consul and swear to it and file in the United States. So there would be no necessity to give up the first German date, when he could just file a translation of the case and get the advantage of the first case.

Mr. WILLIS. All this goes back to the question I propounded a while ago. Do you see in this bill, from the point of view of the interest of American citizens, a device or an incentive to deliberately wipe out a first application, pick out a later date and thereby gain an advantage?

Mr. FEDERICO. It is difficult for me to see where there is a chance for chicanery in the situation, because you cannot create dates retroactively.

Mr. WILLIS. Under American law?

Mr. FEDERICO. Well, I am thinking of the foreigner; if he realizes in 1960 that a 1959 date would be good for him, he can't go backward and create it. I can't see any chance for deliberate devising of a situation in advance.

Mr. WILLIS. That is the only troublesome spot in my mind. Is there a bug somewhere under a chip we can't see, under this, whereby it can be taken advantage of, to the prejudice of American citizens?

Mr. FEDERICO. That I can't see. Of course, the original right of priority could be taken advantage of this way. Let's go back to the American who filed in the United States on January 1, 1959, or anyone else who filed in his own country on the same day, and then a Frenchman filed in May 1959, and the patent issued in November, let's say (however the patent actually would not issue until much later).

Then the American or other person sees it. His year is not up yet, so he files in France and he beats the Frenchman out. Now, that isn't chicanery, that is the ordinary working of the right of priority.

Mr. WILLIS. Under the provisions of the French law?

Mr. FEDERICO. Of the current law, yes, because of the operation of the treaty and the French law together, yes.

That situation is apt to arise under the present treaty provisions and the same situation will arise later, but actually quite rarely.

Now, I don't see that that would be increased by the new provision, in either direction.

Mr. WILLIS. I am not seeking advantages, in favor of American citizens.

Mr. FEDERICO. I understand.

Mr. WILLIS. But the possibility of having an advantage, as a practical matter, under the treaty and under the French and general European law, as well as under the present American law and probably under this bill, if enacted, would be balanced on the side of the Americans, rather than the Europeans.

Mr. FEDERICO. Probably so.

With things normally happening, there will be situations where a foreigner will lose and situations where an American will lose by the

routine operation of the laws. In balance, I think the balance is probably in our favor, or about even. I can't see at the moment how anybody could fabricate a situation in advance, to take unfair advantage. The situations arise by the normal occurrence of events.

Mr. LIBONATI. The purpose of the convention is to bring out conformity and protection of rights, isn't it? The very purpose of the convention?

Mr. FEDERICO. Yes.

Mr. LIBONATI. In every facet of this area, and something has been done, something has been accomplished, by the delegates in the series of conventions where they have adopted procedures and protectionary rights.

Mr. FEDERICO. Yes. Of course, one general purpose of this particular treaty is to make it easier for inventors in one country to protect their rights abroad. If they are first among inventors, and establish their rights in one country, they can then expand to other countries. And that works between all the countries that are members of this treaty.

Mr. WILLIS. Now, can you restate the need for this. I understand we were not the advocator of it, but we went along with it. Is that about it?

Mr. FEDERICO. That is correct.

Mr. WILLIS. From the point of view of the proponents, what is behind it?

Mr. FEDERICO. From the point of view of the proponents at the present moment, which is the Patent Office, with the cooperation of the Department of State, we have this treaty with a large number of provisions. The majority of them are definitely advantageous. Here is one particular minor provision that got into the treaty because of the negotiations that is balanced in our view, sort of neutral. If we want the treaty to come in operation, because overall, it is a good thing for the United States, we must put our own law into shape, to match the terms of the treaty, and this is one provision where the language of one feature of our statute doesn't match the new treaty and our only need for the bill is to do that.

Mr. WILLIS. In order to obtain the whole treaty?

Mr. FEDERICO. Yes.

Mr. WILLIS. From the point of view of the proponents on the other side of the Atlantic who had the idea, what did they have in mind?

Mr. FEDERICO. On this particular point?

Mr. WILLIS. Yes.

And I can see the balancing of advantages.

Mr. FEDERICO. The original proponents of this situation may have had a somewhat broader thing in view.

Mr. BRICKFIELD. Who were the proponents?

Mr. FEDERICO. The proposal was on the original agenda of the Lisbon Conference, which was prepared by the International Bureau and a committee. At this time it was in somewhat broader form. The specific origin I have not traced.

During the discussions of the proposition and the negotiations, some countries were in favor and some raised various objections on theoretical grounds, and a subcommittee was appointed to work out a proposition that the majority would not object to.

In the result, it was revised to the proposition we have in the treaty now.

My own view is that by that time the advocates——

Mr. WILLIS. Sort of lost taste for it?

Mr. FEDERICO. They might have lost taste, but did not want to withdraw and most of the other countries had no particular objection and did not vote against it.

I am speaking frankly about my own views of this particular measure. It is a question of this is a detail that got into the treaty as a whole. We must take the treaty as a whole and fix up our statute on this incidental detail. That is the picture to me.

Mr. WILLIS. And the treaty would not become effective insofar as the United States is concerned without this bill?

Mr. FEDERICO. If we do not fix our statute, we do not deposit our ratification.

Mr. WILLIS. Why should not this be initiated on the Senate side, why did you knock at the House door, instead of over there, where they have the treaty power whereas——

Mr. FEDERICO. The executive communication forwarded by the Patent Office, the Department of Commerce, rather, went to both the House and Senate, as is customary. When legislation is requested by a department, they address the Speaker of the House and the President of the Senate.

Mr. Chairman, before I finish, I would like to leave for the counsel of the committee for your records, first a copy of the official translation of the treaty, the entire treaty, second, a copy of a paper that was prepared, giving the new treaty and the old treaty, interlined together, so that the changes can be observed, and third, a copy of the report of the American delegation at the Conference, which gives discussions.

The counsel of the committee indicated these might be useful to have in your files and I will leave them with you for that purpose.

(The second document, which includes the first, and the report referred to follow the hearing.)

Mr. WILLIS. Do you have any questions, gentlemen?

Counsel has a technical question first.

Mr. BRICKFIELD. On page 2, line 24, Mr. Federico, the bill speaks about its effective date and states that it applies only to applications thereafter filed.

Does that mean filed in a foreign country or filed in the United States?

Mr. FEDERICO. The latter was intended and if not clear the language can be revised.

Mr. WILLIS. On the technical language?

Mr. FEDERICO. Yes.

Mr. LIBONATI. At this portion, you will draw up your resumé of what you decide on for the record?

Mr. WILLIS. You and counsel will discuss it?

Mr. FEDERICO. Yes, sir.

Mr. WILLIS. All right.

Any other questions?

Mr. LINDSAY. What is the need for speed on this?

How fast should it be acted on?

Is there a timetable involved?

Mr. FEDERICO. The treaty itself, the Senate consented to the ratification last summer. The terms of the treaty bring it into operation in 1963, among the countries that have then ratified it and if six ratify before that date, it will come into effect before that date.

In the sense of speed in dashing it out, it is not a thing we must all work on and get out overnight. It would be a good thing if the United States was a country that deposited its ratification in early time to serve as some encouragement to other countries to also move.

I do know that some countries have passed or are working on legislation on the same point plus other points that they have to change in their laws.

Mr. LINDSAY. Will these other countries have done it by September?

Mr. FEDERICO. A few might, but—

Mr. LIBONATI. They generally wait for the United States.

Mr. TOLL. Is there any expression of any group on this, a manufacturers' group, inventors, chambers of commerce, have they had a chance to look at it?

Mr. FEDERICO. Groups that have acted directly are the Patent Trademark and Copyright Section of the American Bar Association, which passed a resolution urging legislation on this point. The American Patent Law Association has also approved it.

Then there is an American group of international patent and trademark lawyers, and others interested in international matters, the International Patent and Trademark Association, that likewise passed a resolution favoring it.

The actual specific provision is not of too great interest to a large group. The situation as envisaged would arise rarely, either way. As I stated earlier, we have not heard of any objection from anybody that has looked at the proposition.

Mr. LIBONATI. But there are provisions in the treaty that are very necessary, that have been debated for a long period of time.

Is that true?

Mr. FEDERICO. Yes.

Mr. LIBONATI. That are of benefit to American industry, right?

Mr. FEDERICO. Yes.

Actually you do not get, from looking at this one provision, a good picture of the treaty as a whole, because there are broad provisions protecting rights of various kinds and so forth.

Mr. WILLIS. The next witness is Mr. Hadraba, Director of the Office of International Trade, the State Department.

STATEMENT OF HON. THEODORE J. HADRABA, DIRECTOR, OFFICE OF INTERNATIONAL TRADE, DEPARTMENT OF STATE

Mr. HADRABA. Mr. Chairman, I am appearing on behalf of the Department of State, in support of H.R. 5754.

A good many of the things that I was prepared to say have been covered by my cherished colleague from the Patent Office and if it would suit your purpose, I would be happy merely to submit my statement.

Mr. WILLIS. That is the usual practice.

Mr. HADRABA. On the other hand, if you wish me to proceed orally, I would be pleased to do so.

Mr. WILLIS. It is in support of the bill?

Mr. HADRABA. Very much so.

Mr. WILLIS. And along the lines of the testimony of Mr. Federico?

Mr. HADRABA. In every respect, yes, sir.

Mr. WILLIS. I think we can receive your statement.

(The statement in full follows:)

STATEMENT BY THEODORE J. HADRABA, DIRECTOR OF THE OFFICE OF INTERNATIONAL TRADE, DEPARTMENT OF STATE, IN SUPPORT OF H.R. 5754 (AND H.R. 7347, AN IDENTICAL BILL)

Mr. Chairman, I am appearing in support of H.R. 5754 which is designed to implement in the United States the latest revision of the Convention of Paris for the Protection of Industrial Property. The bill would amend the U.S. patent and trademark laws to permit applicants to claim their right of priority in the United States not only from the date of their filing of patent or trademark applications but also from the date of a subsequent filing in a member country should the first filing be withdrawn under certain specified conditions.

As to the implementation of the latest revision of the Industrial Property Convention, under the terms of article 17, it is clear that this new revision is not self-executing, that is, its ratification would not by itself modify our domestic law. Any changes in the U.S. patent or trademark laws that are necessary to apply the provisions of the new revision must be enacted by the Congress. Most of the changes embodied in the new revision do not require amendments to U.S. statutes since such changes are already consistent with our law. Only those changes contained in H.R. 5754 relating to the right of priority provisions of our patent and trademark laws will be needed in order fully to implement the new convention. The United States therefore will be able to deposit its instrument of ratification upon the enactment of the proposed legislation contained in H.R. 5754.

The Industrial Property Convention, to which the United States and 50 other countries are parties, was originally adopted in 1883 and was revised 4 times (1900, 1911, 1925, and 1934) prior to the revision adopted at Lisbon in 1958. The Lisbon revision was transmitted to the U.S. Senate by the President on February 17, 1960 (S. Doc. Ex. D, 86th Cong., 2d ses.) and received the Senate's advice and consent to ratification on August 17, 1960. The United States became a party to the original convention of 1883 and the four subsequent revisions.

The Lisbon revision is not yet in force among any countries. It will come into force on June 1, 1963, with respect to those countries which have deposited their ratification before May 1, 1963. If before that date six countries ratify the Lisbon revision, it will come into force after the sixth ratification has been deposited. To date no other country has deposited its instrument of ratification.

U.S. adherence will set an excellent example for other countries which are considering adherence to the new revision. It will also serve as tangible evidence of our interest in effecting improvements in the protection of industrial property rights through the medium of the Industrial Property Convention. This convention is the major intergovernmental instrument assuring protection abroad of the industrial property of U.S. nationals, namely patents, trademarks, designs, commercial names, and related rights. The Department also considers this convention the most effective mechanism for assuring continuing sound cooperative relations with other countries in the industrial property rights field. It is based on two important principles, namely "national treatment" and the extension of special rights or advantages. Under the national treatment principle, each member country is required to extend to nationals of other member countries the same protection and rights which it grants to its own nationals in this field. Under the second principle, each country is required to provide certain rights or special advantages for other members' nationals, one of the most important of which is the right of priority for foreign patent and trademark applicants.

The changes which have been made in the convention over the years have strengthened and made more effective the patent and trademark protection afforded nationals of member countries. The Department believes that this latest revision provides for significant improvements in the industrial property rights field. It was strongly supported by the Department in testimony before the Senate Foreign Relations Committee on June 21, 1960. One of the most important improvements embodied in this new revision relates to the establishment of machinery for interim meetings by the member governments between diplo-

matic conferences of revision to enable them to study and discuss problems arising under the convention. In this connection the revised convention includes a provision for regular triennial meetings of representatives of the member governments. Significant changes have also been effected by the Lisbon revision through a rewriting of the basic provisions in the convention concerning the protection of trademarks. Also for the first time specific provision has been made for the protection of trademarks associated with services, as distinct from those used to identify goods.

I should also like to emphasize that leading business and professional groups in the United States interested in the industrial property rights field, such as the National Foreign Trade Council, the U.S. Council of the International Chamber of Commerce, and the Patent and Trademark Section of the American Bar Association, have endorsed this new revision. In fact, the Department is not aware of any business or professional group that is opposed to the United States becoming a party to this latest revision.

The Department accordingly strongly supports the enactment of H.R. 5754 at an early date since the legislation which it embodies is essential for deposit of ratification of the revised convention and its entry into force as between the United States and other countries. U.S. participation in the new revision will insure that our relations with the other member countries will continue on a sound basis in this important area of our foreign economic policy relating to the protection of industrial property rights. For these reasons the Department is convinced that enactment of H.R. 5754 is most desirable and that it will be in the public interest by fully implementing under our present laws the Convention of Paris for the Protection of Industrial Property, as revised at Lisbon.

Mr. HADRABA. Thank you very much.

Mr. WILLIS. We will recess at this time and will notify the witnesses on H.R. 459 when they may be heard. The record will be kept open for such reports and materials as the subcommittee decides should be made a part of this hearing.

(Whereupon, at 4 p.m., the committee was adjourned, subject to call of the Chair.)

APPENDIX

TEXT OF THE CONVENTION

(The following gives the text of the convention as revised at Lisbon, so arranged as to show the changes over the London 1934 revision. Matter deleted from the London revision is enclosed in brackets and new matter added by the Lisbon Conference is printed in italic. The English translation used for the Lisbon text is the official translation established by the International Bureau, in cooperation with English-speaking member countries, in accordance with article 19(3).)

CONVENTION [OF THE UNION] OF PARIS

for the

Protection of Industrial Property

of 20th March, 1883

revised

at BRUSSELS on 14th December, 1900, at WASHINGTON on 2nd June, 1911,

at THE HAGUE on 6th November, 1925, [and] at LONDON on 2nd June, 1934.

and at LISBON on 31st October, 1958

Article 1

(1) The countries to which the present Convention applies constitute themselves into a Union for the protection of industrial property.

(2) The protection of industrial property is concerned with patents, utility models, industrial designs, trademarks, *service marks*, trade names, and indications of source or appellations of origin, and the repression of unfair competition.

(3) Industrial property shall be understood in the broadest sense and shall apply not only to industry and commerce proper, but likewise to agricultural and extractive industries and to all manufactured or natural products; for example, wines, grain, tobacco leaf, fruit, cattle, minerals, mineral waters, beer, flowers and flour.

(4) The term "patents" shall include the various kinds of industrial patents recognized by the laws of the countries of the Union, such as patents of importation, patents of improvement, patents and certificates of addition, etc.

Article 2

(1) Nationals of each of the countries of the Union shall, as regards the protection of industrial property, enjoy in all the other countries of the Union the advantages that their respective laws now grant, or may hereafter grant, to nationals, without prejudice to the rights specially provided by the present Convention. Consequently, they shall have the same protection as the latter, and the same legal remedy against any infringement of their rights, provided they observe the conditions and formalities imposed upon nationals.

(2) However, no condition as to the possession of a domicile or establishment in the country where protection is claimed may be required of persons entitled to the benefits of the Union for the enjoyment of any industrial property rights.

(3) The provisions of the laws of each of the countries of the Union relating to judicial and administrative procedure and to jurisdiction, and to the election of domicile or the designation of an agent, which may be required by the laws on industrial property, are expressly reserved.

Article 3

Nationals of countries not forming part of the Union, who are domiciled or who have real and effective industrial or commercial establishments in the territory of one of the countries of the Union, are treated in the same manner as nationals of the countries of the Union.

Article 4

A.—(1) A person who has duly filed an application for a patent, or for the registration of a utility model, or of an industrial design, or of a trademark, in one of the countries of the Union, or his successors in title, shall enjoy, for the purpose of filing in the other countries, a right of priority during the periods hereinafter stated.

(2) Every filing that is equivalent to a regular national filing under domestic law¹ of any country of the Union or under [international] *bilateral or multilateral* treaties concluded between [several] countries of the Union shall be recognized as giving rise to a right of priority.

(3) *By a regular national filing is meant any filing that is adequate to establish the date on which the application was filed in the country concerned, whatever may be the outcome of the application.*

B.—Consequently, the subsequent filing in any of the other countries of the Union before the expiration of those periods shall not be invalidated through any acts accomplished in the interval, as, for instance, by another filing, by publication or exploitation of the invention, by the putting on sale of copies of the design or model, or by use of the mark, and these acts cannot give rise to any right of third parties, or of any personal possession. Rights acquired by third parties before the date of the first application which serves as the basis for the right of priority are reserved under the domestic legislation of each country of the Union.

¹ "domestic law"—different French words are used in London and Lisbon revisions.

C.—(1) The above-mentioned periods of priority shall be twelve months for patents and utility models, and six months for industrial designs and for trademarks.

(2) These periods shall start from the date of filing of the first application; the day of filing shall not be included in the period.

(3) If the last day of the period is an official holiday, or a day when the Office is not open for the filing of applications in the country where protection is claimed, the period shall be extended until the first following working day.

(4) *A subsequent application for the same subject as a previous first application within the meaning of paragraph (2) above and filed in the same country of the Union, shall be considered as the first application, of which the filing date shall be the starting point of the period of priority, provided that, at the time of filing the subsequent application, the previous application has been withdrawn, abandoned or refused, without being open to public inspection and without leaving any rights outstanding, and has not served as a basis for claiming a right of priority. The previous application may not thereafter serve as a basis for claiming a right of priority.*

D.—(1) Any person desiring to take advantage of the priority of a previous filing shall be required to make a declaration indicating the date of such filing and the country in which it was made. Each country will determine the latest permissible date for making such declaration.

(2) These particulars shall be mentioned in the publications issued by the competent authority, and in particular in the patents and the specifications relating thereto.

(3) The countries of the Union may require any person making a declaration of priority to produce a copy of the application (specification, drawings, etc.) previously filed. The copy, certified as correct by the authority which received the application, shall not require any authentication, and may in any case be filed, without fee, at any time within three months of the filing of the subsequent application. They may require it to be accompanied by a certificate from the same authority showing the date of filing, and by a translation.

(4) No other formalities may be required for the declaration of priority at the time of filing the application. Each of the countries of the Union shall decide what consequences shall follow the omission of the formalities prescribed by the present Article, but such consequences shall in no case go beyond the loss of the right of priority.

(5) Subsequently, further proof may be required.

A person who avails himself of the priority of a previously filed application shall be required to specify the number of that application, which shall be published under the conditions provided for by paragraph (2) above.

E.—(1) Where an industrial design is filed in a country by virtue of a right of priority based on the filing of a utility model, the period of priority shall be only that fixed for industrial designs.

(2) Furthermore, it is permissible to file a utility model in a country by virtue of a right of priority based on the filing of a patent application, and vice versa.

F.—No country of the Union may refuse a *priority or a patent application* on the ground that [it contains multiple priority claims]

the applicant claims multiple priorities, even originating in different countries, or on the ground that an application claiming one or more priorities contains one or more elements that were not included in the original application or applications whose priority is claimed, provided that, in both cases, there is unity of invention within the meaning of the law of the country.

With respect to the elements not included in the original application or applications whose priority is claimed, the filing of the later application shall give rise to a right of priority under the usual conditions.

G.—(1) If examination reveals that an application for a patent contains more than one invention, the applicant may divide the application into a certain number of divisional applications and preserve as the date of each the date of the initial application and the benefit of the right of priority, if any.

(2) *The applicant may also, on his own initiative, divide a patent application and preserve as the date of each divisional application the date of the initial application and the benefit of the right of priority, if any. Each country of the Union shall have the right to determine the conditions under which such division shall be authorized.*

H.—Priority may not be refused on the ground that certain elements of the invention for which priority is claimed do not appear among the claims formulated in the application in the country of origin, provided that the application documents as a whole specifically disclose such elements.

Article 4^{bis}

(1) Patents applied for in the various countries of the Union by persons entitled to the benefits of the Union shall be independent of patents obtained for the same invention in other countries, whether members of the Union or not.

(2) This provision is to be understood in an unrestricted sense, in particular, in the sense that patents applied for during the period of priority are independent, both as regards the grounds for invalidation and for forfeiture and as regards their normal duration.

(3) The provision shall apply to all patents existing at the time when it comes into effect.

(4) Similarly, it shall apply, in the case of the accession of new countries, to patents in existence on either side at the time of accession.

(5) Patents obtained with the benefit of priority shall have in the various countries of the Union a duration equal to that which they would have had if they had been applied for or granted without the benefit of priority.

Article 4^{ter}

The inventor shall have the right to be mentioned as such in the patent.

Article 4^{quater}

The grant of a patent shall not be refused and a patent shall not be invalidated on the ground that the sale of the patented product or of a product obtained by means of the patented process is subject to restrictions or limitations resulting from the domestic law.

Article 5

A.—(1) The importation by the patentee into the country where the patent has been granted of articles manufactured in any of the countries of the Union shall not entail forfeiture of the patent.

(2) [Nevertheless] Each country of the Union shall have the right to take [the necessary] legislative measures *providing for the grant of compulsory licences* to prevent the abuses which might result from the exclusive rights conferred by the patent, for example, failure to work.

(3) [These measures shall not provide for forfeiture of the patent unless the grant of compulsory licences is insufficient to prevent such abuses.] *Forfeiture of the patent shall not be prescribed except in cases where the grant of compulsory licences would not have been sufficient to prevent such abuses. No proceeding for the forfeiture or revocation of a patent may be instituted before the expiration of two years from the grant of the first compulsory licence.*²

(4) [In any case, an application for the grant of a compulsory licence may not be made before the expiration of three years from the date of the grant of the patent, and this licence may be granted only if the patentee fails to justify himself by legitimate reasons. No proceedings for the forfeiture or revocation of a patent may be instituted before the expiration of two years from the grant of the first compulsory licence.] *An application for a compulsory licence may not be made on the ground of failure to work or insufficient working before the expiration of a period of four years from the date of filing of the patent application or three years from the date of the grant of the patent, whichever period last expires; it shall be refused if the patentee justifies his inaction by legitimate reasons. Such a compulsory licence shall be non-exclusive and shall not be transferable, even in the form of the grant of a sub-licence, except with that part of the enterprise or goodwill using such licence.*

(5) The foregoing provisions shall be applicable, *mutatis mutandis*, to utility models.

B.—The protection of industrial designs shall not, under any circumstance, be liable to any forfeiture either by reason of failure to work or by reason of the importation of articles corresponding to those which are protected.

C.—(1) If, in any country, the use of a registered trademark is compulsory, the registration shall not be cancelled until after a reasonable period, and then only if the person concerned cannot justify his inaction.

(2) The use of a trademark by the proprietor in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered in one of the countries of the Union, shall not entail invalidation of the registration and shall not diminish the protection granted to the mark.

(3) The concurrent use of the same mark on identical or similar goods by industrial or commercial establishments considered as co-proprietors of the mark according to the provisions of the national law of the country where protection is claimed, shall not prevent the registration or diminish in any way the protection granted to the mark

² Formerly second sentence of old paragraph 4.

in any country of the Union, provided the use does not result in misleading the public and is not contrary to the public interest.

D.—No indication or mention of the patent, of the utility model, of the registration of the trademark, or of the deposit of the industrial design shall be required upon the product as a condition of recognition of the right to protection.

Article 5^{bis}

(1) A period of grace of not less than [three] *six* months shall be allowed for the payment of the prescribed fees for the maintenance of industrial property rights, subject to the payment of a surcharge, if the domestic law so provides.

(2) [In the case of patents, the countries of the Union further undertake, either to increase the period of grace to not less than six months, or to provide for the restoration of a patent which has lapsed by reason of the non-payment of fees, such measures being subject to the conditions prescribed by the domestic legislation.] *The countries of the Union shall have the right to provide for the restoration of patents which have lapsed by reason of non-payment of fees.*

Article 5^{ter}

In each of the countries of the Union the following shall not be considered as infringements of the rights of a patentee:

1. the use on board vessels of other countries of the Union of devices forming the subject of his patent in the body of the vessel, in the machinery, tackle, gear and other accessories, when such vessels temporarily or accidentally enter the waters of a country, provided that such devices are used there exclusively for the needs of the vessel;
2. the use of devices forming the subject of the patent in the construction or operation of aircraft or land vehicles of other countries of the Union, or of accessories to such aircraft or land vehicles, when those aircraft or land vehicles temporarily or accidentally enter the country:

Article 5^{quater}

When a product is imported into a country of the Union where there exists a patent protecting a process of manufacture of the said product, the patentee shall have all the rights, with regard to the imported product, as are accorded to him by the domestic law of the country of importation, on the basis of the process patent, with respect to products manufactured in that country.

Article 5^{quinques}

Industrial designs shall be protected in all the countries of the Union.

Article 6

(1) *The conditions for the filing and registration of trademarks shall be determined in each country of the Union by its domestic law.*

(2) *However, an application for the registration of a trademark filed by a national of a country of the Union in any country of the*

Union may not be refused nor may a registration be cancelled on the ground that filing, registration or renewal has not been effected in the country of origin.

(3) *A mark duly registered in a country of the Union shall be regarded as independent of marks registered in the other countries of the Union, including the country of origin.²*

Article 6^{bis}

(1) The countries of the Union undertake, either administratively if their legislation so permits, or at the request of an interested party, to refuse or to cancel the registration *and to prohibit the use* of a trademark which constitutes a reproduction, imitation or translation, liable to create confusion, of a mark considered by the competent authority of the country of registration *or use* to be well-known in that country as being already the mark of a person entitled to the benefits of the present Convention and used for identical or similar goods. These provisions shall also apply when the essential part of the mark constitutes a reproduction of any such well-known mark or an imitation liable to create confusion therewith.

(2) A period of at least [three] *five* years *from the date of registration* shall be allowed for seeking the cancellation of such a mark. [This period shall run from the date of registration of the mark.] *The countries of the Union may provide for a period within which the prohibition of use must be sought.*

(3) No time limit shall be fixed for seeking the cancellation *or the prohibition of the use* of marks registered *or used* in bad faith.

Article 6^{ter}

(1) (a) The countries of the Union agree to refuse or to invalidate the registration, and to prohibit by appropriate measures the use, without authorization by the competent authorities, either as trademarks or as elements of trademarks, of armorial bearings, flags and other State emblems of the countries of the Union, official signs and hall-marks indicating control and warranty adopted by them and all imitations thereof from a heraldic point of view.

(b) *The provisions of sub-paragraph (a) above apply equally to armorial bearings, flags and other emblems, abbreviations or titles of international intergovernmental organizations of which one or more countries of the Union are members, with the exception of armorial bearings, flags and other emblems, abbreviations or titles that are already the subject of existing international agreements intended to ensure their protection.*

(c) *No country of the Union shall be required to apply the provisions of sub-paragraph (b) above to the prejudice of the owners of rights acquired in good faith before the entry into force, in that country, of the present Convention. The countries of the Union shall not be required to apply the said provisions when the use or registration covered by sub-paragraph (a) above is not of such a nature as to suggest to the public that a connection exists between the organization concerned and the armorial bearings, flags, emblems, abbrevia-*

² Compare old Article 6D.

tions or titles, or if such use or registration is clearly not of a nature to mislead the public as to the existence of a connection between the user and the organization.

(2) The prohibition of the use of official signs and hall-marks indicating control and warranty shall apply solely in cases where the marks which contain them are intended to be used on goods of the same of a similar kind.

(3) (a) For the application of these provisions the countries of the Union agree to communicate reciprocally, through the International Bureau, the list of state emblems and official signs and hall-marks indicating control and warranty which they desire, or may thereafter desire, to place wholly or within certain limits under the protection of the present Article and all subsequent modifications of this list. Each country of the Union shall in due course make available to the public the lists so communicated.

Nevertheless, this communication is not obligatory so far as the flags of States are concerned.

(b) The provisions of sub-paragraph (b) of paragraph (1) of this Article shall only apply to armorial bearings, flags and other emblems, abbreviations or titles of international intergovernmental organizations that the latter have communicated to the countries of the Union through the International Bureau.

(4) Any country of the Union may, within a period of twelve months from the receipt of the communication, transmit through the International Bureau its objections, if any, to the country or international intergovernmental organization concerned.

(5) In the case of State [emblems which are well known] flags, the measures prescribed by paragraph (1) above shall apply solely to marks registered after 6th November, 1925.

(6) In the case of State emblems [which are not well known] other than flags, and of official signs and hall-marks of the countries of the Union and in the case of armorial bearings, flags and other emblems, abbreviations or titles of international intergovernmental organizations, these provisions shall be applicable only to marks registered more than two months after the receipt of the communication provided for [by] in paragraph (3) above.

(7) In cases of bad faith the countries shall have the right to cancel the registration of marks that contain State emblems, signs or hall-marks even though registered before 6th November, 1925.

(8) Nationals of each country who are authorized to make use of State emblems, signs or hall-marks of their country, may use them even though they are similar to those of another country.

(9) The countries of the Union undertake to prohibit the unauthorized use in trade of the State armorial bearings of the other countries of the Union, when the use is of such a nature as to be misleading as to the origin of the goods.

(10) The above provisions shall not prevent the countries from exercising the power given in [sub] paragraph (3) [of paragraph 1] of Article 6^{quinqutes} B, to refuse or to cancel the registration of marks containing, without authorization, the armorial bearings, flags [decorations] and other State emblems or official signs or hall-marks adopted by a country of the Union as well as the distinctive signs of international intergovernmental organizations mentioned in paragraph (1) of this Article.

Article 6^{quater}

(1) When, in accordance with the law of a country of the Union, the assignment of a mark is valid only if it takes place at the same time as the transfer of the business or goodwill to which the mark belongs, it shall suffice for the recognition of this validity that the portion of the business or goodwill situated in that country be transferred to the assignee, together with the exclusive right to manufacture or sell there the goods bearing the mark assigned.

(2) This provision does not impose upon the countries of the Union any obligation to regard as valid the assignment of any mark the use of which by the assignee would, in fact, be of such a nature as to mislead the public, particularly as regards the origin, nature or material qualities of the goods to which the mark is applied.

Article 6^{quinquies} 4

A.—(1) Every trademark duly registered in the country of origin shall be accepted for filing and protected in its original form in the other countries of the Union, subject to the reservations indicated [below] in the present Article. These countries may, before proceeding to final registration, require the production of a certificate of registration in the country of origin, issued by the competent authority. No authentication shall be required for this certificate.

[C] (2) The country of the Union where the applicant has a real and effective industrial or commercial establishment, or, if he has not such an establishment *within the Union*, the Union country where he has his domicile, or if he has no domicile in the Union, the country of his nationality if he is a national of a Union country, shall be considered his country of origin.

B.—(1) Nevertheless, registration of the following may be refused or cancelled: *Trademarks under the present Article may not be denied registration or invalidated except in the following cases:*

1. [Marks which] *when they* are of such a nature as to infringe rights acquired by third parties in the country where protection is claimed;

2. [Marks which] *when they* are devoid of any distinctive character, or consist exclusively of signs or indications which may serve in trade to designate the kind, quality, quantity, intended purpose, value, place of origin of the goods or time of production, or have become customary in the current language or in the bona fide and established practices of the trade of the country where protection is claimed [In arriving at a decision as to the distinctive character of a mark all the circumstances of the case must be taken into consideration, particularly the length of time during which the mark has been in use];

3. [Marks which] *when they* are contrary to morality or public order and, in particular, [those] of such a nature as to deceive the public. It is understood that a mark may not be considered contrary to public order for the sole reason that it does not conform to a provision of the law relating to trademarks, except where such provision itself relates to public order.

The above is, however, subject to Article 10^{bis}.

* Formerly Article 6.

C.—(1) To determine whether a mark is eligible for protection, all the factual circumstances must be taken into consideration, particularly the length of time the mark has been in use.⁵

(2) Trademarks shall not be refused in the other countries of the Union for the sole reason that they differ from the marks protected in the country of origin only by elements that do not alter the distinctive character and do not affect the identity of the marks in the form in which these have been registered in the said country of origin.⁶

D.—[When a trademark has been duly registered in the country of origin and then in one or more of the other countries of the Union, each of these national marks shall be considered, from the date of its registration, as independent of the mark in the country of origin, provided it conforms to the domestic legislation of the country of importation.] No person may benefit from the provisions of the present Article if the mark for which he claims protection is not registered in the country of origin.

E.—However, in no case shall the renewal of the registration of a mark in the country of origin involve the obligation to renew the registration in the other Union countries where the mark has been registered.

F.—The benefit of priority shall be accorded to applications for the registration of marks filed within the period fixed by Article 4, even when registration in the country of origin does not occur until after the expiration of such period.

Article 6^{series}

The countries of the Union undertake to protect service marks. They shall not be required to provide for the registration of such marks.

Article 6^{septides}

(1) If the agent or representative of the person who is the proprietor of a mark in one of the countries of the Union applies, without such proprietor's authorization, for the registration of the mark in his own name in one or more Union countries, the proprietor shall be entitled to oppose the registration applied for or demand its cancellation or, if the law of the country so allows, the assignment in his favour of the said registration, unless such agent or representative justifies his action.

(2) The proprietor of the mark shall, subject to the reservations of paragraph (1) above, be entitled to oppose the use of his mark by his agent or representative if he has not authorized such use.

(3) Domestic laws may provide an equitable time limit within which the proprietor of a mark must assert the rights provided for in the present Article.

Article 7

The nature of the goods to which the trademark is to be applied shall in no case form an obstacle to the registration of the mark.

⁵ Revision of second sentence of old Article 6B(1)2.

⁶ Old Article 6B2.

Article 7^{bis}

(1) The countries of the Union undertake to accept for filing and to protect collective marks belonging to associations the existence of which is not contrary to the law of the country of origin, even if such associations do not possess an industrial or commercial establishment.

(2) Each country shall be the judge of the particular conditions under which a collective mark shall be protected and may refuse protection if the mark is contrary to the public interest.

(3) Nevertheless, the protection of these marks shall not be refused to any association the existence of which is not contrary to the law of the country of origin, on the ground that such association is not established in the country where protection is sought or is not constituted according to the law of the latter country.

Article 8

A trade name shall be protected in all the countries of the Union without the obligation of filing or registration, whether or not it forms part of a trademark.

Article 9

(1) All goods unlawfully bearing a trademark or trade name shall be seized on importation into those countries of the Union where such mark or name has a right to legal protection.

(2) Seizure shall likewise be effected in the country where the unlawful application occurred or in the country into which the goods have been imported.

(3) Seizure shall take place at the request either of the public prosecutor or of any other competent authority or of any interested party, whether a natural or a juridical person, in conformity with the domestic law of each country.

(4) The authorities shall not be bound to effect seizure in transit.

(5) If the law of a country does not permit seizure on importation, such seizure shall be replaced by prohibition of importation or by seizure within such country.

(6) If the law of a country permits neither seizure on importation nor prohibition of importation nor seizure within the country, then, until such time as the law is modified accordingly, these measures shall be replaced by the actions and remedies available in such cases to nationals under the law of such country.

Article 10

(1) The provisions of the preceding Article shall apply [to any goods which falsely bear as an indication of origin the name of a specified locality or country, when such indication is joined to a trade name of a fictitious character or used with fraudulent intent] *in cases of direct or indirect use of a false indication of the source of the product or the identity of the producer, manufacturer or trader.*

(2) Any producer, manufacturer or trader, whether a natural or juridical person, engaged in the production or manufacture of or trade in such goods and established either in the locality falsely indicated as the source or in the district where this locality is situ-

ated, or in the country falsely indicated, or in the country where the false indication of source is used, shall in any case be deemed an interested party.

Article 10^{bis}

(1) The countries of the Union are bound to assure to persons entitled to the benefits of the Union effective protection against unfair competition.

(2) Any act of competition contrary to honest practices in industrial or commercial matters constitutes an act of unfair competition.

(3) The following in particular shall be prohibited:

1. all acts of such a nature as to create confusion by any means whatever with the establishment, the goods, or the industrial or commercial activities of a competitor;

2. false allegations in the course of trade of such a nature as to discredit the establishment, the goods, or the industrial or commercial activities of a competitor;

3. *indications or allegations the use of which in the course of trade is liable to mislead the public as to the nature, the manufacturing process, the characteristics, the suitability for their purpose or the quantity of the goods.*

ARTICLE 10^{ter}

(1) The countries of the Union undertake to assure to nationals of the other countries of the Union appropriate legal remedies to repress effectively all the acts referred to in Articles 9, 10 and 10^{bis}.

(2) They undertake, further, to provide measures to permit syndicates and associations which represent the industrialists, producers or traders concerned and the existence of which is not contrary to the laws of their countries, to take action in the Courts or before the administrative authorities, with a view to the repression of the acts referred to in Articles 9, 10 and 10^{bis}, in so far as the law of the country in which protection is claimed allows such action by the syndicates and associations of that country.

ARTICLE 11

(1) The countries of the Union shall in conformity with their domestic law, grant temporary protection to patentable inventions, utility models, industrial designs and trademarks, in respect of goods exhibited at official or officially recognized international exhibitions held in the territory of one of them.

(2) This temporary protection shall not extend the periods provided by Article 4. If later the right of priority is invoked, each country may provide that the period shall start from the date of introduction of the goods into the exhibition.

(3) Each country may require, as proof of the identity of the article exhibited and of the date of its introduction, such evidence as it considers necessary.

ARTICLE 12

(1) Each of the countries of the Union undertakes to establish a special industrial property service and a central office for the com-

munication to the public of patents, utility models, industrial designs and trademarks.

(2) This service shall publish an official periodical journal. It shall publish regularly:

- (a) the names of the proprietors of patents granted, with a brief description of the inventions patented;
- (b) reproductions of trademarks registered.

ARTICLE 13

(1) The international office established [at Bern] under the name International Bureau for the Protection of Industrial Property is placed under the high authority of the Government of the Swiss Confederation, which regulates its organization and supervises its operation.

(2) [The official language of the International Bureau is French.]
 (a) *The French and English languages shall be used by the International Bureau in performing the tasks provided for in paragraphs (3) and (5) of this Article.*

(b) *The conferences and meetings referred to in Article 14 shall be held in the French, English and Spanish languages.*

(3) The International Bureau centralizes information of every kind relating to the protection of industrial property and compiles and publishes it. It undertakes studies of general utility concerning the Union and edits, with the help of documents supplied to it by the various Administrations, a periodical journal [in French] dealing with questions relating to the objects of the Union.

(4) The issues of this journal, as well as all the documents published by the International Bureau, shall be distributed to the Administrations of the countries of the Union in proportion to the number of contributing units mentioned below. Additional copies as may be requested, either by the said Administrations or by companies or private persons, shall be paid for separately.

(5) The International Bureau shall at all times hold itself at the disposition of the countries of the Union, to supply them with any special information they may need on questions relating to the international industrial property service. The Director of the International Bureau shall make an annual report on his administration, which shall be communicated to all the countries of the Union.

(6) The ordinary expenditure of the International Bureau shall be borne by the countries of the Union in common. Until further authorization, it shall not exceed the sum of 120,000 Swiss francs per annum. This sum may be increased, when necessary, by a unanimous decision of one of the conferences provided for in Article 14.

(7) Ordinary expenditure does not include expenses relating to the work of conferences of plenipotentiaries or administrative conferences nor the expenses caused by special work or publications effected in conformity with the decisions of a conference. Such expenses, the annual total of which may not exceed 20,000 Swiss francs, shall be divided among the countries of the Union in proportion to their contributions towards the operation of the International Bureau in accordance with the provisions of paragraph (8) below.

(8) To determine the contribution of each country to this total expenditure, the countries of the Union and those which may afterwards join the Union are divided into six classes, each contributing in the proportion of a certain number of units, namely:

First class-----	25 units
Second class-----	20 units
Third class-----	15 units
Fourth class-----	10 units
Fifth class-----	5 units
Sixth class-----	3 units

These coefficients are multiplied by the number of countries in each class, and the sum of the products thus obtained gives the number of units by which the total expenditure is to be divided. The quotient gives the amount of the unit of expense.

(9) Each of the countries of the Union shall, at the time it becomes a member, designate the class in which it wishes to be placed. However, any country of the Union may declare later that it desires to be placed in another class.

(10) The Government of the Swiss Confederation will supervise the expenditure of the International Bureau[.], and its accounts, and will make the necessary advances[, and render an annual account, which will be communicated to all the other administrations].

(11) *The annual account rendered by the International Bureau shall be communicated to all the other Administrations.*

Article 14

(1) The present Convention shall be submitted to periodical revision with a view to the introduction of amendments designed to improve the system of the Union.

(2) For this purpose conferences shall be held successively in one of the countries of the Union between the delegates of the said countries.

(3) The Administration of the country in which the conference is to be held shall make preparations for the work of the conference, with the assistance of the International Bureau.

(4) The Director of the International Bureau shall be present at the meetings of the conferences, and take part in the discussions, but without the right of voting.

(5) (a) *During the interval between the Diplomatic Conferences of revision, Conferences of representatives of all the countries of the Union shall meet every three years in order to draw up a report on the foreseeable expenditure of the International Bureau for each three-year period to come and to consider questions relating to the protection and development of the Union.*

(b) *Furthermore, they may modify, by unanimous decision, the maximum annual amount of the expenditure of the International Bureau, provided they meet as Conferences of Plenipotentiaries of all the countries of the Union, convened by the Government of the Swiss Confederation.*

(c) Moreover, the Conferences provided for in paragraph (a) above may be convened between their triennial meetings by either the Director of the International Bureau or the Government of the Swiss Confederation.

Article 15

It is understood that the countries of the Union reserve the right to make separately between themselves special arrangements for the protection of industrial property, in so far as these arrangements do not contravene the provisions of the present Convention.

Article 16

(1) Countries which are not parties to the present Convention shall be permitted to accede to it at their request.

(2) Any such accession shall be notified through diplomatic channels to the Government of the Swiss Confederation, and by it to all the other Governments.

(3) Accession shall automatically entail acceptance of all the clauses and admission to all the advantages of the present Convention and shall take effect one month after the dispatch of the notification by the Government of the Swiss Confederation to the other countries of the Union, unless a subsequent date is indicated in the request for accession.

Article 16^{bis}

(1) Any country of the Union may at any time notify in writing the Government of the Swiss Confederation that the present Convention is applicable to all or part of its colonies, protectorates, territories under mandate or any other territories subject to its authority, or any territories under its sovereignty, and the Convention shall apply to all the territories named in the notification one month after the dispatch of the communication by the Government of the Swiss Confederation to the other countries of the Union unless a subsequent date is indicated in the notification. Failing such a notification, the Convention shall not apply to such territories.

(2) Any country of the Union may at any time notify in writing the Government of the Swiss Confederation that the present Convention ceases to be applicable to all or part of the territories that were the subject of the notification under the preceding paragraph, and the Convention shall cease to apply in the territories named in the notification twelve months after the receipt of the notification addressed to the Government of the Swiss Confederation.

(3) All notifications sent to the Government of the Swiss Confederation in accordance with the provisions of paragraphs (1) and (2) of the present Article shall be communicated by that Government to all the countries of the Union.

Article 17

[The carrying out of the reciprocal engagements contained in the present Convention is, in so far as necessary, subject to the observance of the formalities and rules established by the constitutional

laws of those of the countries of the Union which are bound to procure their application; which they undertake to do with as little delay as possible.] *Every country party to this Convention undertakes to adopt, in accordance with its constitution, the measures necessary to ensure the application of this Convention.*

It is understood that at the time an instrument of ratification or accession is deposited on behalf of a country, such country will be in a position under its domestic law to give effect to the provisions of this Convention.

Article 17^{bis}

(1) The Convention shall remain in force for an indefinite time, until the expiration of one year from the date of its denunciation.

(2) Such denunciation shall be addressed to the Government of the Swiss Confederation. It shall affect only the country in whose name it is made, the Convention remaining in operation as regards the other countries of the Union.

Article 18

(1) The Present Act shall be ratified and the instruments of ratification deposited in [London] *Bern* not later than [1st July, 1938] *1st May, 1963*. It shall come into force, between the countries in whose names it has been ratified, one month after that date. However, if before that date it is ratified in the name of at least six countries, it shall come into force between those countries one month after the deposit of the sixth ratification has been notified to them by the Government of the Swiss Confederation, and for countries in whose names it is ratified at a later date, one month after the notification of each such ratification.

(2) Countries in whose names no instrument of ratification has been deposited within the period referred to in the preceding paragraph shall be permitted to accede under the terms of Article 16.

(3) The present Act shall, as regards the relations between the countries to which it applies, replace the Convention [of the Union] of Paris of 1883 and the subsequent acts of revision.

(4) As regards the countries to which the present Act does not apply, but to which the Convention [of the Union] of Paris revised at [the Hague in 1925] *London in 1934* applies, the latter shall remain in force.

(5) Similarly, as regards countries to which neither the present Act nor the Convention [of the Union] of Paris revised at [the Hague] *London* apply, the Convention [of the Union] of Paris revised [Washington in 1911] at *The Hague in 1925* shall remain in force.

(6) *Similarly, as regards countries to which neither the present Act nor the Convention of Paris revised at London, nor the Convention of Paris revised at The Hague apply, the Convention of Paris revised at Washington in 1911 shall remain in force.*

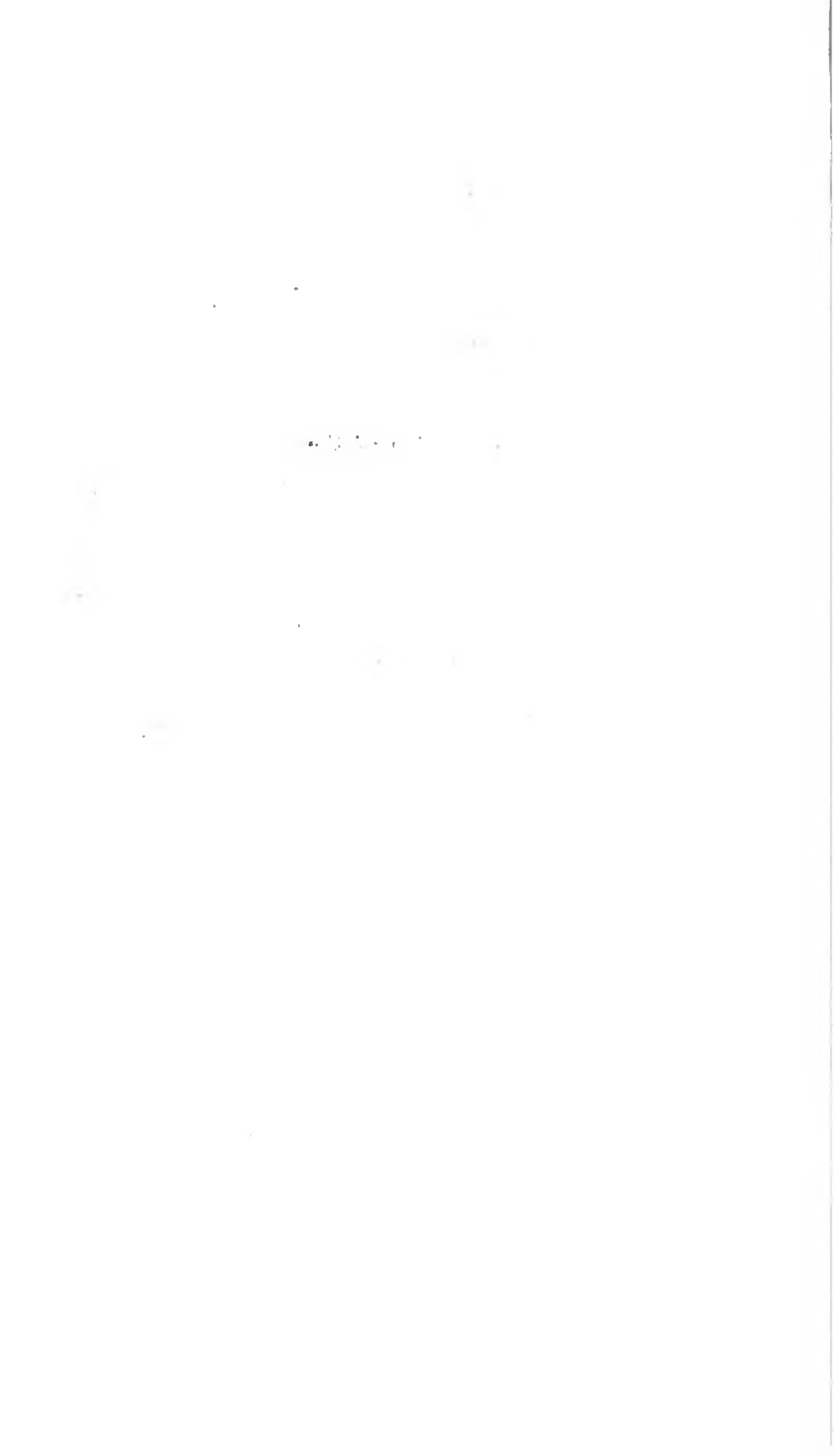
Article 19

(1) The present Act shall be signed in a single copy *in the French language*, which shall be deposited in the archives of the Government of the [United Kingdom of Great Britain and Northern Ireland] *Swiss Confederation*. A certified copy shall be forwarded by the latter to each of the Governments of the countries of the Union.

(2) *The present Act shall remain open for signature by the countries of the Union until 30th April, 1959.*

(3) *Official translations of the present Act shall be established in the English, German, Italian, Portuguese and Spanish languages.*

OFFICIAL REPORT
of the
UNITED STATES DELEGATION
to the
CONFERENCE OF LISBON
for the Revision of the
INTERNATIONAL CONVENTION FOR THE PROTECTION
OF INDUSTRIAL PROPERTY
Lisbon, Portugal, October 6-31, 1958
Submitted to the Secretary of State by Robert C. Watson, Commissioner of
Patents, Chairman of the Delegation
(July 27, 1959)
(Prepared by P. J. Federico)



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CONFERENCE OF LISBON

REPORT OF THE UNITED STATES DELEGATION

1. DATE AND PLACE

The Conference of Revision of the International Convention for the Protection of Industrial Property met in Lisbon, Portugal, from October 6 to October 31, 1958.

The official title of the treaty taken up for revision is the "Convention of the Union of Paris for the Protection of Industrial Property of March 20, 1883, revised at Brussels, December 14, 1900, at Washington, June 2, 1911, at The Hague, November 6, 1925, and at London, June 2, 1934," but it is commonly referred to in English as the "International Convention for the Protection of Industrial Property." It will be referred to as the "International Convention" or as the "Convention", in this report.

Previous conferences which resulted in revision of the Convention were held at Brussels, December 1 to 14, 1897 and December 11 to 14, 1900, at Washington, May 15 to June 2, 1911, at The Hague, October 8 to November 6, 1925, and at London, May 1 to June 2, 1934. A resolution of the London Conference fixed the place of the next meeting as Lisbon, with the time to be set by the Government of Portugal and the International Bureau.

The meetings were held in a building known as the "Pavilhão da Feira das Industrias Portuguesas," the Portuguese Industries Fair Building. The building is a fairly new one, of modern design, used for exhibitions and meetings. A section of the building had been partitioned into a large hall for plenary sessions, smaller halls for meetings of committees of the whole, and office rooms, and equipped with facilities for the meetings and for the delegates.

2. PREPARATORY WORK

Article 14 of the Convention, which provides for conferences of revision, states that the Administration of the country in which the conference is to be held shall make the preparations for the work of the conference, with the assistance of the International Bureau for the Protection of Industrial Property (established by Article 13).

There had been some talk of a conference of revision, after the war, and at one time in 1949 and 1950 the prospects of a conference being called appeared to be materializing. However, no actual steps appear to have been taken until much later when the Government of Portugal and the International Bureau arranged an informal meeting of experts from selected countries, in Berne, Switzerland, for the purpose of advising on the date of a conference, and the contents of the agenda. Countries represented, in addition to Portugal, were the United States, Great Britain, France, Germany, Italy, and Switzerland. While

selected by their respective governments, the persons attending the meeting did not act as representatives speaking for their governments, but only as an advisory committee of experts. The United States participants in this meeting were Mr. Robert C. Watson, Commissioner of Patents and Mr. P. J. Federico, from the Patent Office. The meeting was held April 25 to May 3, 1955. At the meeting there were considered and discussed a large number of resolutions and proposals which had been made for amending the Convention during the preceding twenty years, and recommendations were made as to which should and which should not be included on the agenda of the anticipated conference. Most of the resolutions and proposals considered were by private organizations interested in industrial property, such as the International Association for the Protection of Industrial Property and the International Chamber of Commerce, but a number had been originated by the International Bureau and a few by the countries represented. The resultant agenda was in large part based upon the recommendations of this preparatory meeting, although in instances the agenda items did not follow the recommendations of the committee.

The meeting discussed the time of the conference and, with a dissent, recommended that it be held as soon as practicable.

Following this meeting the Bureau and the Portuguese Government proceeded with the preparatory work. This consisted in the preparation of various documents, referred to as Preliminary Documents, the preparation of the physical arrangements, and the other planning necessary for a large extended conference. The printed program issued at the opening of the Conference shows that the Portuguese Government had formed an Honorary Committee consisting of sixteen high government officials and heads of commercial and industrial organizations, and a Committee on Organization.

Preparatory work on the part of the United States included the appointment, when the Conference was officially announced, through the Commissioner of Patents at the request of the Secretary of State, of an Advisory Committee of twenty-five individuals representing organizations interested in the subject matter. This Committee studied the items on the agenda and submitted a transcript of their discussions, and their recommendations. An Interdepartmental Committee of representatives of interested Government departments and agencies was also formed by the Department of State.

3. ANNOUNCEMENT OF CONFERENCE

The Conference was announced by a circular letter sent to each of the invited governments in December 1956. At the same time the first part of the first volume of the Preliminary Documents was distributed. The second part of the first volume was distributed the following month. These two works contained most of the agenda for the Conference.

This announcement stated that the Conference would begin the first week of November, 1957, and indicated that it was expected to last six weeks. The invited countries were requested to transmit their comments and observations, and counter-proposals, by March 31, 1957. The United States transmitted brief comments and obser-

vations on some of the items on the agenda shortly after this date, and was one of the few which approached the deadline.

A number of countries felt that the time was too short to prepare themselves adequately, and made representations to the Portuguese Government to postpone the date. Discussion of postponement occurred during the [first part] of 1957. The date of the Conference was postponed for the reason given, and presumably also to allow more time for preparation of the physical and other arrangements which had not progressed. Official notification of the new date was sent in [August] 1957, although unofficial word that the Conference would be postponed had been received earlier. The original length set for the Conference was also changed, as many countries, including the Portuguese Government, felt that six weeks was too long.

4. AGENDA OF THE CONFERENCE

As the Conference was one called under Article 14 for the specific purpose of revising the existing Convention, as last revised at London in 1934, the agenda for the Conference naturally consisted of a series of proposals to amend particular articles or to introduce new articles. In addition, the agenda included proposals to amend several of the existing so-called Arrangements and to form new Arrangements, these Arrangements being separate treaties on particular subjects between some only of the countries adhering to the general Convention.

The agenda prepared in advance was transmitted to the countries in a series of Preliminary Documents beginning with the first one sent in December 1956 and ending with some distributed on the opening day of the Conference. These Preliminary Documents are listed with a short description following the list.¹

- (1) Preliminary Documents, Vol. 1, Part 1, December 1956.
Proposals with Explanatory Notes.
Printed French Text, 128 pages.
Mimeographed English translation, 213 pages.
- (2) Preliminary Documents, Vol. 1, Part 2, January 1957.
Proposals with Explanatory Notes.
Printed French Text, 57 pages.
Mimeographed English translation, 92 pages.
- (3) Preliminary Documents, Vol. 1, Part 3, August 1958.
Amended Proposals (Items XXIV, XXV, XXVI).
Printed French Text, 7 pages.
Mimeographed English translation, 9 pages.
- (4) Preliminary Documents, Vol. 1, Part 4, September 1958.
Supplementary Proposals.
Printed French Text, 7 pages.
Mimeographed English translation, 5 pages.
- (5) Annex I. Agreements between the International Bureau and other International Organizations.
Mimeographed French Text, 31 pages.
No English translation.
- (6) Letter of August 18, 1958, from Secretary-General of the United Nations.
Mimeographed French Text, 3 pages.
Mimeographed English translation, 3 pages.
- (7) Supplementary Proposals (Item XV).
Mimeographed French Text, 5 pages.
Mimeographed English translation, 5 pages.

¹ A bound set of these documents is in the library of the U.S. Patent Office.

- (8) Preliminary Documents, Vol. 2, May 1957.
Rearrangement of the Text.
Printed French Text, 80 pages.
Mimeographed English translation, 186 pages.
- (9) Preliminary Documents, Vol. 3, May 1957.
Collection of Resolutions.
Printed French Text, 55 pages.
Typewritten English translation, 90 pages.
- (10) Preliminary Documents, Vol. 4, Part A, July 1958.
Proposals, Counter-Proposals and Observations.
Printed French Text, 190 pages.
Mimeographed English translation, 195 pages.
- (11) Preliminary Documents, Vol. 4, Part B, September 1958.
Proposals, Counter-Proposals and Observations.
Printed French Text, 24 pages.
Mimeographed English translation, 22 pages.
- (12) Preliminary Documents, Observations submitted by the Government of Japan.
Mimeographed French Text, 9 pages.
Mimeographed English translation, 9 pages.
- (13) Preliminary Documents, Observations submitted by a committee appointed by the Mexican Government.
Mimeographed French text, 11 pages.
Mimeographed English translation, 13 pages.

The first of these Documents contained a series of twenty-six proposals, with background material and explanatory notes, for amending the International Convention, which had been prepared by the International Bureau. These are numbered with Roman numerals and will be referred to as Item I, Item II, etc.

The second part of Volume 1 contained the following: B, Proposals to amend the Arrangement of Madrid on the Repression of False Indications of Origin; C, proposals to amend the Arrangement of The Hague on the International Registration of Designs; D, proposals relating to a Documentation Center for Patents under Priority; E, proposal for a new Arrangement for the Protection of Appellations of Origin; F, proposal for a new Arrangement on Patents of Importation. These will be referred to as Item B, Item C, etc.

The third part of Volume 1 contained revisions by the Bureau of three items.

The next four papers listed were not distributed until the opening day of the Conference. They include additional proposals prepared by the Bureau.

Volume 2, Rearrangement of the Text, contained a proposal for what might be called a codification of the Convention.

Volume 3 was a collection of proposals made by private groups such as the International Association for the Protection of Industrial property and the International Chamber of Commerce during the period 1934 to 1956. This collection was not part of the agenda, but included background material from which many of the items on the agenda had been derived. No English translation was supplied, but one was compiled by the United States Patent Office from prior sources of the same material.

Volume 4, Part A, was a collection of the comments and observations of 27 countries on the items of Volume 1, Parts 1 and 2, with some new proposals. These became an official part of the agenda. The comments of several private organizations were also included. The remaining papers, which were not distributed until the opening day

of the Conference, contained the observations of three additional governments and two private organizations.

Except as noted, English translations of these documents were distributed. Spanish translations were also available.

The Preliminary Documents which have been noted make a total of 548 pages of printed French text, with 69 additional typewritten pages, and 851 pages of typewritten English translation.

The subject matter of various items on the agenda given in the above papers, and additional items introduced during the course of the Conference, are explained in detail in the supplementary part of this report.

5. ATTENDANCE AT CONFERENCE

The International Bureau in its monthly publication, *La Propriété Industrielle*, for January 1958, listed 45 countries as parties to the International Convention (counting Egypt and Syria, now the United Arab Republic, as two countries). During the course of the year, two additional countries, Haiti and the Federation of Rhodesia and Nyasaland, adhered, bringing the total to 47. Of these 47 countries, 38 have adhered to the London 1934 revision; 5, namely Brazil, Czechoslovakia, Hungary, Poland, and Yugoslavia, have adhered to The Hague 1925 revision but not to the later version; and 4, namely Bulgaria, Cuba, Dominican Republic and Roumania have adhered to the Washington 1911 revision and not to either of the later revisions. The first article of the Convention denominates all these countries as members of a "Union for the Protection of Industrial Property."

The countries invited to participate in the actual Conference were the countries which are members of the Union, that is, countries which have adhered to existing versions of the International Convention. Forty of the 47 member countries were represented. In addition, non-member countries were invited to send delegates and were given all privileges except that of voting; eleven non-member countries were represented. Certain intergovernmental organizations and certain private organizations were also invited to send representatives and eight of the former and eight of the latter were represented; the former had the same privileges as non-member countries and the latter could be invited by the chairman of the working committees to speak and present proposals.

The total number of persons registered for attendance is shown by the following table:

	Number of countries or organiza- tions	Number of delegates or representa- tives
Member countries.....	40	177
Non-member countries.....	11	18
Intergovernmental organizations.....	8	8
Private organizations.....	8	25
International Bureau staff.....		14
Miscellaneous.....		8
Total.....		250

The above tabulation does not include staff interpreters, translators, typists, etc.

The meetings were not closed and a number of additional persons attended some of the sessions.

a. Member countries

Following is a list of the 40 member countries who were represented at the Conference. The countries are listed in alphabetical order according to the name in French, which was the voting order. The list gives the size of the delegation of each country. Where a country has not adhered to the London 1934 revision, the year of the latest revision to which the country has adhered is placed in parentheses after the name.

<i>Country</i>	<i>Delegation</i>
1. Germany, Federal Republic of (République Fédérale d'Allemagne)-----	11
2. Australia-----	4
3. Austria-----	8
4. Belgium-----	6
5. Brazil (1925)-----	4
6. Bulgaria (1911)-----	3
7. Canada-----	5
8. Cuba (1911)-----	2
9. Denmark-----	4
10. Dominican Republic (1911)-----	1
11. Spain (Espagne)-----	4
12. United States (Etats-Unis d'Amérique)-----	8
13. Finland-----	2
14. France-----	10
15. Hungary (1925)-----	4
16. Indonesia-----	1
17. Ireland-----	1
18. Israel-----	3
19. Italy-----	12
20. Japan-----	9
21. Liechtenstein (represented by Swiss Delegation).-----	
22. Luxemburg-----	1
23. Morocco (Maroc)-----	3
24. Mexico-----	2
25. Monaco-----	3
26. Norway-----	3
27. New Zealand-----	1
28. Netherlands (les Pays-Bas)-----	8
29. Poland (1925)-----	3
30. Portugal-----	10
31. Rhodesia and Nyasaland, Federation of-----	1
32. Roumania (1911)-----	3
33. United Kingdom of Great Britain and Northern Ireland (Royaume-Uni, etc.)-----	8
34. Sweden-----	6
35. Switzerland-----	6
36. Czechoslovakia (1925) (Tchécoslovaque)-----	6
37. Turkey-----	2
38. Union of South Africa-----	3
39. Viet-Nam-----	1
40. Yugoslavia-----	1

The above list of delegates does not include secretaries, translators and observers, identifiable as such, who might have been officially attached to a delegation; these are included under Miscellaneous in the tabulation in the first part of this section. In the case of the United States, the delegation listed as eight persons, excludes Congressional and other observers.

The seven member countries which were not represented are: Ceylon, Egypt, Greece, Haiti, Lebanon, Syria, Tunis.

In size the delegations ranged from one country with twelve members down to seven countries with one member each. One country had no representatives of its own but was represented by the delegation of another country. The average size of the delegations was 4.4 members, but the median was 3. Half the countries had delegations of 3 or fewer members, and this half of the countries had less than one-fourth of the delegates. Ten countries, one-fourth of the number, accounted for slightly more than half of the delegates.

In view of the technical nature of the subject matter of the Conference, it is not surprising that a substantial proportion of the delegates were specialists in the field of patent and trademark law. As near as can be determined, 64 of the delegates, or 36 percent were officials of the offices of the countries in charge of patents and trademarks. Forty-one of the delegates, or 23 percent, were private individuals, mostly specialists in the field. Thus 59 percent of the delegates could be considered as specialists. The remaining 41 percent (72 in number) were government officials mostly from the Departments of State or Foreign Offices of the various countries, with some from other branches of the governments, mainly those branches in which the patent offices are located. Twenty-five of these 72 were diplomatic or consular officers stationed in Portugal or, in a few instances, some other European country. These figures should be taken as approximations since the positions of a few delegates were not clear from their designations in the list of delegates.

b. Non-member Countries

Following is a list of the non-member countries represented at the Conference, with the number of representatives.

Argentina-----	1	Panama-----	1
El Salvador-----	1	Saudi Arabia-----	2
Ecuador-----	1	U.S.S.R.-----	4
Iran-----	1	Vatican City-----	2
Iraq-----	2	Venezuela-----	2
Liberia-----	1		

These eighteen persons included five resident diplomatic officers, three patent office officials, five other government officials, and five private individuals, as nearly as can be determined.

c. Others

The following, listed as intergovernmental organizations, had one observer each present at the Conference:

- International Labor Organization
- European Economic Community
- Council of Europe
- International Office of the Vine and of Wines
- United Nations Food and Agriculture Organization
- World Health Organization
- United Nations Educational, Scientific and Cultural Organization (UNESCO)
- International Institute for the Unification of Private Law, Rome

The following private international and other organizations had observers present during the Conference:

Association International pour la Protection de la Propriété Industrielle (AIPPI)—International Association for the Protection of Industrial Property-----	2
Association Littéraire et Artistique Internationale (ALAI)—International Literary and Artistic Association-----	2
Chambre de Commerce International (CCI)—International Chamber of Commerce-----	7
Confédération International des Sociétés d'Auteurs et de Compositeurs (CISAC)—International Confederation of Societies of Authors and Composers-----	1
Fédération Internationale des Ingenieurs-Conseils en Propriété Industrielle (FIICPI)—International Federation of Patent Agents-----	5
Ligue Internationale Contre la Concurrence Deyale (LICCD)—International League Against Unfair Competition-----	3
Union des Fabricants (UNIFAB)-----	4
Chamber of Commerce of Lisbon-----	1

The staff of the International Bureau present during the Conference numbered fourteen persons. In addition there were five staff interpreters, six staff translators, four staff "Proces-Verbalistes", and two staff sound engineers.

6. UNITED STATES DELEGATION

The United States Delegation consisted of one delegate, six advisers and one Congressional adviser. In addition there was one Congressional observer, three Congressional staff observers, and one observer from the Department of Defense. The Delegation also included a translator from the Department of State. The names of the delegation members and observers follow:

Delegate: Honorable Robert C. Watson, Commissioner of Patents, United States Patent Office, Department of Commerce.

Advisers:

Roger C. Dixon, Chief, International Business Practices Division, Department of State.

Pasquale J. Federico, Examiner in Chief, United States Patent Office, Department of Commerce.

Stephen P. Ladas, 10 Columbus Circle, New York 19, New York.

Stanley D. Metzger, Assistant Legal Adviser for Economic Affairs, Department of State.

John Dashiell Myers, 1420 Walnut Street, Philadelphia 2, Pennsylvania.

Albert R. Teare, 1114 Terminal Tower, Cleveland 13, Ohio.

Congressional Adviser: Honorable Alexander Wiley, United States Senate.

Congressional Observer: Honorable Roland V. Libonati, House of Representatives.

Congressional Staff Observers:

Carlile Bolton-Smith, Counsel for the Antitrust and Monopoly Subcommittee, Senate Committee on the Judiciary.

Cyril F. Brickfield, Counsel for the Judiciary Committee, House of Representatives.

Robert L. Wright, Counsel for the Subcommittee on Patents, Trademarks and Copyrights, United States Senate, Committee on the Judiciary.

Observer: George F. Westerman, Lt. Col., U.S.A., Patent Adviser to the Defense Adviser, USRO, Paris.

Translator: Marcella F. Woerheide, Department of State.

Other persons from the United States who were present during the Conference were Mr. Walter Everett Hopper of New York City, who attended as a representative of the International Chamber of Commerce, Mr. Kenneth Perry and Mr. Norman St. Landau, Vice President and counsel, respectively, of the firm of Johnson and Johnson, who attended in a purely private capacity, and Mr. Arpad Bogsch who attended as an observer for the United States Copyright Office but who was not attached to the Delegation.

7. ORGANIZATION

The officers of the Conference and of the committees were chosen on the first day, and rules of procedure adopted. A Credentials Committee was also chosen.

The rules of procedure in general were those customary at International Conferences, and were similar to those adopted at the London Conference of 1934, with a few modifications.

An innovation in the rules was the explicit recitation of the rule of unanimity, as expressing the custom of these Conferences. According to this rule a unanimous vote, not counting abstentions, is required for adoption of a text by a plenary session. The rule was also applied in the meetings of the General Committee, but not in the meetings of the working committees.

According to the rules, all proceedings were conducted in French or English, with translations made from one to the other. The working documents of the Conference were prepared in both French and English.

For consideration of the items on the agenda the Conference constituted itself into a "General Committee", which was a committee of the whole. The General Committee formed itself into several working Committees, which were also committees of the whole as each country was a member of each Committee. (This was also the case at the Conference of Revision of London in 1934 but at the Conference of The Hague in 1925 the members of the Committees were selected.) There were five of these Committees, which were identified by Roman numerals.

Committee I. General and Administrative Questions

To this Committee were assigned the items on the agenda, and new items, relating to general matters not specifically pertaining to patent or trademark law. However, Item XV, relating to the protection of State emblems was also assigned to this Committee.

Committee II. Patents

To this Committee were assigned all the items relating to patents.

Committee III. Trademarks

To this Committee were assigned the items on the agenda relating to trademarks.

Committee IV. Unfair Competition and False Identifications of Origin

To this Committee were assigned the special Arrangement of Madrid concerning false indications of origin, a proposed new Arrangement on the protection of appellations of origins and Item XIX on the agenda relating to false indications of origins.

Committee V. Industrial Designs

To this Committee were assigned the Arrangement of The Hague concerning the international registration of industrial designs, Item XI on the agenda, and resolutions of certain inter-governmental committees relating to designs.

There was also a General Drafting Committee of the conference.

Each of the five working Committees had a Drafting Committee of its own, the members of which, other than its chairman, were selected by the Committee. Also, a member of the International Bureau staff sat with the officers of each Committee.

To avoid confusion, the following terms will be used uniformly:

General Committee—the Conference sitting as the Committee of the Whole.

Committee—the five special working committees of the whole, among which the work was divided.

General Drafting Committee—the drafting committee of the Conference.

Drafting Committee—the special drafting committees of each Committee.

The French word "Commission" used in this connection was translated into English sometimes as "Commission" and sometimes as "Committee" in the various papers. "Committee" is used here uniformly.

The word "committee" with a small "c" will be used to refer to small working groups designated by a Chairman of one of the Committees to study and report on particular designated subjects.

The officers of the Conference and of the various Committees were as follows:

Officers of the Conference

President: Dr. Luis da Câmara Pinto Coelho, Professor of Law at the University of Lisbon, Chairman of the Portuguese Delegation.

First Vice President: Dr. Afonso Marchueta, Director General of Commerce of Portugal, Chairman of the Committee on Organization.

Vice Presidents: The Chairmen of each of the five Committees, and the Chairmen of the General Drafting Committee.

Secretary General: Mr. Charles-Louis Magnin, Vice Director of the International Bureau.

Assistant Secretary General: Mr. Ross Woodley, Counsellor, International Bureau.

Secretaries:

Mr. Victor Hugo Fortes Rocha, Ministry of Foreign Affairs, Portugal.

Mr. John-Day Lamb, Secretary, International Bureau.

Rapporteur: Mr. Guillaume Finnis, Inspector General of Industry and Commerce, France (Head of French Patent Office).

Chairman of Credentials Committee: Mr. Giuseppe Talamo Atenolfi Brancaccio, Marquis of Castelnuovo [Italy].

Committee I. General

Chairman: Mr. B.A.S. Petré, Ambassador from Sweden.

Vice Chairman: (Portugal).

Rapporteur: Mr. P. Racz, Hungary.

Drafting Committee: Mr. F. Ayiter, Turkey, Chairman.

Committee II. Patents

Chairman: Mr. C. J. de Haan, Head of the Netherlands Patent Office.

Vice Chairmen:

Mr. R. C. Watson, United States.

Mr. H. Kühnemann, Germany.

Rapporteur: Mr. H. R. Wilmot, Australia.

International Bureau Representative: Mr. R. Woodley.

Drafting Committee: Mr. J. P. Hoffman, Luxembourg, Chairman;

Mr. P. J. Federico, United States; Mr. P. J. Pointet, Switzerland;

Mr. F. Vitacek, Czechoslovakia; Mr. S. Takahashi, Japan.

Committee III. Trademarks

Chairman: Mr. P. Bolla, Former President of the Supreme Court of Switzerland.

Vice Chairmen:

Mr. L. A. Ellwood, Great Britain.

Mr. J. Cech, Czechoslovakia.

Rapporteur: Mr. T. Lorenz, Austria.

International Bureau Representative:

Drafting Committee: Mr. T. Mekouar, Morocco, Chairman; Mr. G.

H. C. Bodenhausen, Netherlands, Vice Chairman; Mr. P. L. C. A.

van Reepinghen, Belgium; Mr. R. M. von Filseck, Germany.

Committee IV. Unfair Competition

Chairman: Mr. S. Takahashi, Ministry of Foreign Affairs, Japan.

Vice Chairman: Mr. T. Ascarelli, Italy.

Rapporteur: (Spain).

International Bureau Representative: Mr. G. Ronga.

Drafting Committee: (Belgium).

Committee V. Industrial Designs

Chairman: Mr. Z. Muszynski, Head of the Polish Patent Office.

Vice Chairman: Mr. G. Marchegiano, Italy.

Rapporteur: Mr. M. Boutet, France.

International Bureau Representative: Mr. G. Ronga.

Drafting Committee: Mr. J. M. Notari, Monaco, Chairman.

General Drafting Committee

Chairman: Mr. C. Robinson, Lawyer, Canada.

Members: The Chairmen of Committees I to V and others.

8. DOCUMENTATION OF THE CONFERENCE

As noted above, the main "Preliminary Documents" which included the bulk of the agenda were distributed to the individual countries in advance of the Conference, in the form of printed French texts and, except in the case of one of them, mimeographed English translations. Some of the Preliminary Documents, however, were not distributed until the opening day of the Conference.

On the opening day of the Conference copies of all the Preliminary Documents were distributed to each delegate, together with a number of miscellaneous papers not identified as any particular series. These included a printed program, schedules of Committees and meetings, draft regulations, a printed concordance of the agenda items and the observations of the countries which had been prepared by the International Federation of Patent Agents, copies of the existing text of the Convention, etc.

Beginning with the first day of the meetings there began the distribution of documents which were numbered in series as "Document No. —, Lisbon". The distribution of these continued until the closing day of the Conference. These documents were issued in English, identified by the letter "A" (*Anglaise*) after the number, and in French, identified by the letter "F" after the number. A few of them, however, in view of their nature, were issued only in English or only in French; these were mainly corrections of particular English or French documents. A few documents in English and French were consolidated, which was indicated by "A/F" after the number. The last few documents were not distributed and copies were not received until several months later, after request for them.

These documents reached No. 323. They included propositions submitted by various delegations during the course of the sessions, including revisions and drafts of propositions on the agenda, reports of special committees, minutes of the various sessions, amendments and additions to the minutes, reports of the Committee, General Drafting Committee texts, etc.²

9. MEETINGS OF THE CONFERENCE

A tentative schedule of the meetings of the Committees, the General Committee, and the Plenary Sessions, was distributed on the opening day, which was followed with some variations.

The scheduling was arranged so as to finish the work of the Conference on October 31. It had been stated in the first official announcement of the Conference that it was expected to last six weeks. There were some objections to the proposed length, and the final schedule was arranged to finish within a much shorter time. In order to do this it was necessary for several Committees to meet simultaneously, which was an innovation for a Conference of Revision. This meant that the delegations had to divide their memberships in order to participate in the simultaneous meetings, or fail to attend some of

² A bound set of these documents is in the library of the U.S. Patent Office.

the meetings. Although it had been expected that there would be simultaneous meetings, the regular sitting of three, and sometimes four, Committees at the same time was rather unexpected and somewhat inconvenient. The meetings of the various Committees were scheduled with the prospect of finishing their work on the 18th, but some of the Committees were unable to make their schedule while a few were ahead of their schedule.

Meetings of the Committees began on the morning of October 7 and continued through October 22nd, the last few days, however, being concerned with only a few matters. There were a total of 43 sessions of the Committees.

The last act of each Committee was the submission of a report which summarized its activities and gave the texts of the proposals which it had adopted. These texts served as the basis of further consideration by the General Committee.

The General Committee had its first session on October 23rd and continued through the 29th, with a total of eight sessions. Following the last meeting of the General Committee, on the same date, there was a Plenary Session at which the proposition adopted by the General Committee went through a formal final vote. The texts of the various propositions as they had been adopted by the General Committee were turned over to the General Drafting Committee which edited them and prepared drafts which were distributed for the Plenary Session. There was an interval of one day for preparation of the final printed texts and the closing and signing meeting was held the morning of October 31.

In general the schedule of the Conference was very tight and required constant attention and a great deal of work on the part of the delegations.

A summary of the work of the Committees and the General Committee, together with a summary of other meetings of the Conference, is presented in the supplementary part of this report.

Following is a tabulation of the sessions held. This list does not include meetings of the many special ad hoc working groups or committees set up from time to time to work on particular problems and report to a particular Committee, special meetings of heads of delegations, and meetings of the General Drafting Committee. There were one or more of such auxiliary meetings practically every working day.

CALENDAR OF FORMAL SESSIONS

Monday, October 6:

Morning: Preliminary Session.

Afternoon: Preliminary Session, continued. Opening Session. First Plenary Session.

Tuesday, October 7:

Morning: Committees II, III, V.

Afternoon: Committee II.

Wednesday, October 8, morning: Committees II, III, V.

Thursday, October 9, morning: Committees I, II, III.

Friday, October 10:

Morning: Committees I, II, III.

Afternoon: Committee V.

Saturday, October 11, morning: Committees I, II, III.

Monday, October 13, morning: Committees I, II, III.

Tuesday, October 14, morning: Committees II, III, IV.

Wednesday, October 15, morning: Committees II, IV.

Thursday, October 16:

Morning: Committees II, IV.

Afternoon: Committees III, V.

Friday, October 17:

Morning: Committees I, II, III, IV.

Afternoon: Committees II, IV.

Saturday, October 18, morning: Committees I, II, IV, V.

Monday, October 20, morning: Committees I, II.

Wednesday, October 22:

Morning: Committee IV.

Afternoon: Committee I.

Thursday, October 23:

Morning: General Committee.

Afternoon: General Committee.

Friday, October 24:

Morning: General Committee.

Afternoon: General Committee.

Saturday, October 25, morning: General Committee.

Monday, October 27, morning: General Committee.

Tuesday, October 28, morning: General Committee.

Wednesday, October 29:

Morning: General Committee.

Afternoon: Plenary Session.

Friday, October 31, morning: Closing Session.

10. ACTIVITIES OF THE UNITED STATES DELEGATION

The members of the United State delegation (most of whom had met for four days early in September to study the agenda together and discuss the positions to be taken on the various items) held a meeting the day before the opening date of the Conference to discuss general plans, which were modified from time to time as the occasion arose. It was emphasized at the meeting that the delegation should act as a unit and that they should meet each day for the purpose of advising each other of all the happenings and planning further activities. It was also decided as a matter of general policy that the delegation would not seek or accept the chairmanship of any of the Committees or other high offices. Owing to the simultaneous conducting of three sessions of the Committees, various members of the delegation were assigned primary responsibility for attendance and participation in the work of particular Committees. As carried out, Messrs. Dixon and Metzger attended the sessions of Committee I and certain sessions of Committee V; Messrs. Teare and Federico attended the sessions of Committee II, with the latter also attending certain sessions of Committees I and IV, and Messrs. Myers and Ladas attended the sessions of Committee III with the latter also attending some sessions of Committee IV. The Chairman of the delegation, during its sessions, was primarily occupied with the position of Vice Chairman of Committee II, and at other times attended sessions of other Committees.

The members of the delegation attended regularly the meetings of the Committees and of the General Committee and participated actively in the discussions of all the subjects in which the United States had an interest. They served as members of many working groups or special committees to report on particular subjects. The United States delegation, represented by Mr. Federico, was also active in an informal working party of delegates from English speaking countries developing a common English text of the resulting Convention.

Mrs. Woerheide, the State Department translator attached to the delegation, was indispensable in this work, and her assistance to members of the delegation in language problems was also of great value.

The member of the delegation handling a particular item carried it through from beginning to end, doing all the speaking for the delegation on the subject, with some exceptions due to conflicts of Committee sessions and a few other exceptions. The delegation met practically every day after the meetings of the Committees for the purpose of informing each other of the happenings of the day and discussing future action, including modifications of previous plans in the light of developments and changed circumstances.

The Congressional Advisor, Senator Wiley, regularly attended the sessions of the Conference, and most of the meetings of the delegation. By his own wish, he refrained from taking part in the debates and from expressing opinions on the substance of propositions discussed, in view of his position. The various observers attended sessions of the Conference and some of the meetings of the delegation.

11. ACTS OF THE CONFERENCE

The main Act of the Conference was, of course, the revision of the International Convention for the Protection of Industrial Property. This document, as a new treaty, was signed on the last day of the Conference. Thirty of the member countries present signed; four of them, Cuba, Hungary, Roumania and Spain, with the notation "ad referendum". The delegate from Liberia, a non-member country, also signed on behalf of his country. The ten member countries present which did not sign were Australia, Bulgaria, Canada, Czechoslovakia,¹ Dominican Republic, Indonesia, Mexico, Turkey,¹ Union of South Africa and Viet-Nam.

The official title of the new treaty is the "Convention of Paris for the Protection of Industrial Property of March 20, 1883, revised at Brussels, December 14, 1900, at Washington, June 2, 1911, at The Hague, November 6, 1925, at London, June 2, 1934 and at Lisbon, October 31, 1958." The words "of the Union" which appeared after the first word in the title of the previous revisions have been dropped and, of course, the reference to Lisbon has been added.

A revision of the Arrangement of The Hague on False or Misleading Indications of Origin was signed by seventeen countries: Germany, Cuba, Spain, France, Great Britain, Hungary, Ireland, Israel, Italy, Japan, Liechtenstein, Morocco, Monaco, New Zealand, Poland, Portugal, Sweden, Switzerland. The United States is not a member of this Arrangement and took no part in its revision.

A new Arrangement of Lisbon on the Protection of Appellations of Origin and their International Registration was concluded and signed by ten countries: Cuba, Spain, France, Hungary, Israel, Italy, Portugal, Roumania, Czechoslovakia, Morocco. The United States delegation took no part in the discussion of this Arrangement since the United States did not contemplate becoming a member thereof.

In addition to the above, the Conference adopted eight Resolutions.

The changes introduced into the International Convention and the Resolutions are summarized in the following two sections of this report.

¹ Czechoslovakia and Turkey signed after October 31, 1958, in accordance with Article 18.

12. SUMMARY OF CHANGES IN THE INTERNATIONAL CONVENTION

Changes were made in fourteen articles of the Convention, either by revising the existing article or adding material thereto, and six entirely new articles were inserted, the whole being presented as a new document embodying both the unchanged, the changed and the new articles. Following is a brief summary of the changes made in the Convention:

Article 1(2), revised. The list of the various species of industrial property in Article 1 was amended to include "service marks", this change, however, only being ancillary to new Article 6 sexies.

Article 4A, revised. A paragraph 3 defining a regularly filed application for the purpose of right of priority was added to Article 4A. At the same time paragraph 2 of Article 4A was amended slightly in language.

Article 4C, revised. A new paragraph 4 was added to Article 4C. This paragraph defines certain conditions under which the right of priority can be based on a second or later filed application instead of the first filed application.

Article 4D, revised. A sentence was added to the fifth paragraph of Article 4D relating to identification by number of an application on which a right of priority is based.

Article 4F, revised. This article was revised to provide that the right of priority must be granted even though the application claiming it contains subject matter additional to that contained in the basic application.

Article 4G, revised. A second paragraph was added to Article 4G providing that if an applicant on his own initiative divides a patent application, the date of the original application and the right of priority which it may have are to be preserved.

Article 4 quater, new. New Article 4 quater provides that a patent cannot be refused or invalidated on the ground that the sale of the patented product or of a product produced by a patented process is subject to restrictions or limitations under the domestic law.

Article 5A, revised. Paragraphs 2, 3, 4 of Article 5A, dealing with the compulsory licensing of patents were revised. In addition to language changes, the revised article accepts the interpretation by the majority of countries that the time limitation on applying for a compulsory license is limited to cases of non-working; the period after which a compulsory license may be applied for in such cases is changed to four years from the date of the filing of the application or three years from the date of the grant of the patent, whichever expires later; and a sentence is added providing that compulsory licenses shall be non-exclusive and not transferable except with the business in which it is used.

Article 5 bis, revised. Article 5 bis has been revised to provide a period of grace of six months, instead of three months, within which to pay fees required for the maintenance of industrial property rights; the countries, however, may further provide for restoration of patents which have lapsed after this period.

Article 5 quater, new. New Article 5 quater provides that when a product is imported into a country of the Union where there exists a patent protecting a process of manufacture of the said product,

the patentee shall have all the rights, with regard to the imported product, as are accorded to him by the domestic law of the country of importation, on the basis of the process patent, with respect to products manufactured in that country.

Article 5 quinquies, new. New Article 5 quinquies provides simply that industrial designs shall be protected in all the countries of the Union, the previous version of the Convention containing no such obligation.

Article 6, new. New Article 6 provides in effect that a person is entitled to register his trademark in a country if he complies with the conditions obtaining in that country, and specifically provides that an application for registration of a trademark in one country cannot be refused or cancelled on the ground that there is no registration in the country of origin of the owner. Registrations obtained are to be independent of registrations which may have been obtained in other countries of the Union.

Article 6 bis, revised. Article 6 bis, dealing with well-known marks, has been revised to prohibit the use of such marks of others, as well as their registration, and to change the period for seeking cancellation of such a registered mark from three years to five years.

Article 6 ter, revised. This article, dealing with state emblems, has been amended to include analogous provisions with respect to emblems and names of international intergovernmental organizations, with some reservations. At the same time the existing provisions for communicating the emblems to the International Bureau has been removed in the case of flags of countries.

Article 6 quinquies, revised. Former Article 6 has been revised and renumbered as 6 quinquies, the number 6 being given to a new basic trademark article. The revisions, however, make little substantial change in the article.

Article 6 sexies, new. New Article 6 sexies obligates the countries to protect service marks, although they are not required to provide for the registration of such marks.

Article 6 septies, new. New Article 6 septies deals with the situation in which the agent or representative of a trademark owner seeks to register or registers the trademark without the owner's authorization, and gives the owner the right to oppose the registration or seek its cancellation, or have it assigned to him if the law of the country so permits. The owner may also oppose the use of the mark which has not been authorized.

Article 10, revised. The first paragraph of Article 10, dealing with false indications of origin, has been revised to eliminate the reference to joint use with a trade name of a fictitious character as a condition, and to broaden the false indications to include not only false indications of origin but also of the identity of the producer, manufacturer or trader.

Article 10 bis, revised. The third paragraph of Article 10 bis, naming particular instances of unfair competition, has been amended to add indications or allegations the use of which in the course of trade is liable to mislead the public as to the nature, the manufacturing process, the characteristics, the suitability for their purpose or the quantity of the goods.

Article 13, revised. Paragraph 2 of Article 13 has been revised to specify that the International Bureau shall use the French and English languages in performing the tasks assigned to it by the article, and that conferences and meetings referred to in Article 14 shall be held in the French, English and Spanish languages. An incidental change has been made in paragraph 3, and the words "at Berne" in paragraph 1, with reference to the location of the International Bureau, have been deleted in view of the moving of the Bureau to Geneva. Paragraph 10 of the article has been revised and a new paragraph 11 added, dealing with the supervision of the expenditures and accounts of the Bureau by the Swiss Government.

Article 14, revised. Article 14, providing for periodical conferences of revision, has been amended by adding paragraph 5 divided into subparagraphs (a), (b) and (c). This new paragraph provides for conferences of representatives of the countries of the Union to meet every three years to consider the expenditures of the Bureau, and questions related to the subject matter of the Convention; furthermore, these conferences may modify the maximum annual amount of the expenditures of the Bureau.

Article 17, revised. Article 17, the non-self-executing clause, has been completely rewritten.

Article 18, revised. Article 18, dealing with the time of taking effect of the London revision, and its relationship to previous revisions, has been amended to refer to the Lisbon revision and its relationship to the previous revisions.

Article 19, revised. Article 19, relating to signature, has been revised to explicitly state that the language of the treaty is French; at the same time a paragraph has been added to leave the Act open for signature for six months, and another paragraph added stating that official translations shall be established in the English, German, Italian, Portuguese and Spanish languages.

13. RESOLUTIONS OF THE CONFERENCE

The Conference adopted eight resolutions which are summarized.

1. *Patentability of Chemical Products.* The Conference recommends that the member countries study the possibility of providing for the patenting of new chemical products, independently of the process, in their national legislations.

2. *Consultative Committee.* During the interim until the establishment of the conferences provided for by amended Article 14, a Consultative Committee composed of representatives of the countries of the Union shall meet every three years at the call of the Swiss Government to report on the expenditures of the Bureau for the next three-year period. This committee may also be convened between the three-year meetings on the initiative of the Director of the International Bureau or the Swiss Government.

3. *Finances.* Considering the urgency of remedying the financial situation of the International Bureau, the countries are invited to raise their contributions, beginning January 1, 1959, in order to bring the funds of the Bureau to the amount of 600,000 Swiss francs annually.

4. *Exchange of Patent Publications.* The Conference recommends that the countries of the Union exchange their periodical publications

and open negotiations toward exchanging, under conditions to be agreed upon, printed descriptions of inventions and patents granted.

5. *Search Center for Trademarks.* The Conference recommends that each country study means whereby persons can be enabled to determine whether a given trademark conflicts with marks already registered.

6. *Rearrangement of the Text of the Convention.* The rearrangement of the text of the Convention is considered desirable and the Bureau is invited to resume the study of the question in order to draft a new text and submit it to the countries of the Union for comment. The principle embodied in the proposal for rearrangement is approved.

7. *Industrial Designs and Models.* The Conference accepts the invitation extended by the Permanent Committee of the International Union for the Protection of Literary and Artistic Works, and the Intergovernmental Copyright Committee, to the International Union for the Protection of Industrial Property to participate, on an equal footing, in the studies and meetings envisaged for the purpose of ensuring the best means of international protection of works of applied art, designs and models.

8. *Arrangement of The Hague Concerning the International Registration of Industrial Designs and Models.* Revision of the Hague Arrangement is postponed to a subsequent date, not later than 1960, and the invitation issued on behalf of the Netherlands Government for a conference for that purpose to meet in its country is accepted.¹

¹ The texts of the resolutions adopted by the Conference are as follows:

"I. PATENTABILITY OF CHEMICAL PRODUCTS

"Whereas, in order to promote technical progress, inventions must be protected to the greatest possible extent,

"The Conference recommends that the member countries of the Union study the possibility of providing, in their national legislations, for the protection by patents of new chemical products, independently of their manufacturing process, with such limitations and conditions as may seem advisable."

"II. CONSULTATIVE COMMITTEE

"The Conference while waiting the establishment of the bodies provided for in Article 14(5) of the Convention,

"Decides:

"Every three years, on the convocation of the governments of the Swiss Confederation, a Consultative Committee composed of representatives of all the countries of the Union shall meet and draw up a report on the foreseeable expenditure of the Bureau for the next three-yearly period.

"Further, the Consultative Committee may be convened between such three-yearly meetings on the initiative either of the Director of the international Bureau or of the Government of the Swiss Confederation."

"III. FINANCE

"The Conference

"Considering the financial situation of the International Bureau,

"Considering the urgency of remedying it,

"Invites

"The countries of the Union to raise their contribution, beginning on the 1st of January 1959, in order to bring the funds of the International Bureau to the amount of 600,000 Swiss francs annually."

"IV. EXCHANGE OF PERIODICAL PUBLICATIONS OF THE NATIONAL ADMINISTRATIONS

"The Conference recommends that the countries of the Union proceed to an exchange of their periodical publications and open negotiations with a view to arriving at the exchange, under conditions to be agreed upon, of printed descriptions of inventions and of patents granted."

Footnotes continued next page.

14. PROPOSITIONS NOT ADOPTED

Following is a brief summary of certain propositions which were not adopted, including in a few instances separable parts not adopted of propositions which were adopted in revised form.

1. *Proposed New Article; Disclosure of Invention Before Applying for Patent.* A proposed new article, providing that disclosure of the invention for a certain period before applying for patent does not defeat the right to a patent, did not pass the Committee stage.

"V. RECOMMENDATION CONCERNING A SEARCH CENTRE FOR MARKS

"The Conference recommends that each country of the Union study by what means any person can, at his own request and with the help of Government bodies or private organisations, be enabled to determine whether a given mark is in danger of conflicting, in the case of certain specified goods, with a mark already registered in the country concerned."

"VI. REARRANGEMENT OF THE CONVENTION

"The Conference,

"Having noted the proposal of the International Bureau for a rearrangement of the text of the Convention of Paris,

"Considering that such a rearrangement is desirable,

"Approving in principle the system of rearrangement recommended for that purpose by the Bureau,

"Invites the Bureau to resume the study of the question in order to draft a new text and submit it to the countries of the Union for possible comment,

"Recommends that this new text be studied as soon as possible at a Conference of the countries of the Union."

"VII. DESIGNS AND MODELS

"The Conference, having noted the Resolutions of the Permanent Committee of the International Union for the Protection of Literary and Artistic Works, and of the Intergovernmental Copyright Committee, both of August 1958, relating to applied arts, designs and models,

"Considering that the Conventions of the International Unions for the Protection of Industrial Property and of Literary and Artistic Works and the Universal Copyright Convention deal with the works of applied art, designs and models, and that better co-ordination between the provisions of these conventions would result in more effective protection in this field and possibly filling gaps and preventing overlapping,

"Considering that the possibilities of improving the present status of international protection could most effectively be explored by joint studies of the International Union for the Protection of Industrial Property, the Permanent Committee of the International Union for the Protection of Literary and Artistic Works, and the Intergovernmental Copyright Committee,

"Accepts the invitation extended by the Permanent Committee of the International Union for the Protection of Literary and Artistic Works and the Intergovernmental Copyright Committee to the International Union for the Protection of Industrial Property to participate, on an equal footing, in the studies and meetings envisaged for the purpose of ensuring the best means of international protection of works of applied arts, designs and models,

"Invites the Director of the Bureau of the International Union for the Protection of Industrial Property to co-operate in the establishment and work of the contemplated study group for preparing a report on the above questions; it being understood that participation in the study group shall be open also to all persons designated by any member country of the International Union for the Protection of Industrial Property."

"VIII. ARRANGEMENT OF THE HAGUE

"The States party to the Arrangement of The Hague concerning the International deposit of industrial designs or models,

"Considering the more drastic amendments than those at present contemplated are necessary to maintain the existing number of countries party to this Arrangement and to allow other States to adhere,

"Considering that the proposals to this effect formulated by certain States at the present Conference make a fuller examination desirable particularly with regard to detailed methods of application,

"Considering that such examination could usefully take place within the existing framework of industrial property and could profit from the studies to be undertaken by the Study group provided for in the resolution of the Permanent Committee of the International Union for the Protection of Literary and Artistic Works and by the Intergovernmental Committee on Copyright at their meetings at Geneva (18-23 August, 1958), without in any way delaying the study suggested in the preceding paragraph,

"Decide to postpone the revision of the Arrangement of The Hague to a subsequent date, not later than 1960;

"Welcome the invitation issued on behalf of the Netherlands Government for a Conference for that purpose to meet in its country."

The United States spoke in favor of this proposition but there were too many countries objecting on grounds of principle to give it much chance.

2. *Proposed New Article; Patentability of Chemical Products.* A proposed new article providing that the countries grant patents for chemical products, independently of the process of producing them, did not pass the Committee stage owing to the opposition of a number of countries. The United States spoke in favor of the proposal and there was strong support by delegates of some countries which do not now grant patents for chemical products. A resolution on the subject was adopted.

3. *Proposed New Article; Importation of Products Produced According to a Patented Process.* A proposed new article forbidding the importation, use or sale of products produced according to a patented process did not pass the Committee stage. The United States delegation spoke in opposition to the broad proposal as introduced. A substitute proposal of much more limited scope, new Article 5 quater, was adopted.

4. *Article 5A; Revocation of Patents.* Part of the initial proposal for revision of Article 5A provided for the elimination of the penalty of revocation, which cannot be invoked until two years after the grant of the first compulsory license. This part did not pass the Committee stage owing to the opposition of a relatively small number of countries.

5. *Article 11; Temporary Protection at Exhibitions.* A proposed revision of this article did not pass the Committee stage. The proposal contained some features which the United State delegation opposed. An alternate proposal to cancel Article 11 was also defeated at the Committee stage.

6. *Article 4C; Extension of the Period of Priority for Trademarks.* A proposal to extend the period of priority from six months to one year in the case of trademarks was defeated at the Committee stage without much discussion.

7. *Article 5C 3; Concurrent Use of Trademarks.* A revision of paragraph 3 of Article 5C to require freer licensing of trademarks was defeated in the General Committee session, mainly due to the opposition of the United States which insisted on the inclusion of a limitation requiring control over the nature and quality of the products on which the mark was used.

8. *Article 5C 1; Cancellation of Trademarks for Non-use.* A proposed revision of paragraph 1 of Article 5C, dealing with non-use of trademarks, to provide a period of five years before a registration could be cancelled for non-use, was defeated in the General Committee.

9. *Article 6 bis; Well-Known Trademarks.* Several propositions proposed in connection with Article 5 bis and also separately, dealing with well-known marks and exceptionally well-known marks, did not pass the Committee stage.

10. *Article 6 quater; Assignment of Trademarks.* A proposed revision of Article 6 quater which would require the free assignment of trademarks was defeated at the Committee stage. The United States delegation spoke against the proposal.

11. *Article 7; Nature of the Product Covered by a Trademark.* A proposed revision of Article 7 providing that the exclusive right to use a trademark could not be suppressed or limited when the sale of

the goods on which it was used was legal was defeated in the General Committee.

12. *Article 6 ter; Protection of State Emblems, etc.* A proposed revision of the first paragraph of Article 6 ter considerably enlarging its scope and rendering it difficult, if not impossible, to apply, was defeated in the General Committee. The United States delegation spoke against the proposal and voted against it.

13. *Proposed New Article; International Court of Justice.* A proposed new article requiring disputes concerning interpretation or application of the Convention to be brought before the International Court of Justice was not even brought to vote as no one spoke in favor of it. The United States delegation, among many others, spoke against the proposal.

14. *Finances.* A resolution directly raising the ceiling of the budget of the International Bureau was not carried owing to the interjection by the "Iron Curtain" countries of the East German question into the subject. The alternative resolution mentioned in the preceding section was all that could be gotten through.

15. *Rearrangement of the Text of the Convention.* A proposed rearrangement of the text of the Convention to place the various articles and parts of articles in more logical order was not acted on, and in fact it would have been impossible to consider the particular proposal. A resolution to continue the work on the subject was adopted instead.

15. FUTURE MEETINGS

During one of the final Plenary Sessions, the delegation from Austria invited the next Diplomatic Conference of Revision to be held in Vienna and this invitation was accepted. No other action was taken. In accordance with previous practice, no date was set for a new conference. Undoubtedly, it will not be held for a substantial period of time.

Article 14(5) of the new Convention provides for conferences of representatives of the countries to meet every three years for certain purposes. As such conferences cannot be held until after the new Convention comes into force, Resolution 2 provides for an interim Consultative Committee to be convoked every three years by the Swiss Government.

Resolution 8 postpones revision of the Arrangement of The Hague for the International Registration of Designs to not later than 1960 and accepts the invitation of the Netherlands Government for a Conference for this purpose to meet in the Netherlands.

16. CONCLUSIONS

Those changes to the International Convention which were agreed upon, while in many instances individually not of outstanding significance, cumulatively were well worthwhile in that the member nations of the Union thereby agreed to facilitate to an increased extent the efforts of their nationals to more freely proceed to protect their industrial property rights throughout other nations of the Union.

The results of the Conference of Revision must be considered in the light of the fact that its objective was the revision of a Convention which has been in existence for about seventy-five years and has been revised four times during this period. Also, the fact that such a large number of different countries are parties makes adoption of major changes rather difficult. On the whole, the number of changes introduced by the Lisbon Conference compares quite favorably with the changes made by previous Conferences of Revision and in general the resulting document may be considered a substantial improvement over the preceding versions. The Conference was also of importance in the discussions of subjects which were not adopted as considerable change in sentiment, for example in the case of chemical products, was felt even though desirable propositions were not adopted. Following are some general recommendations with respect to future action.

1. *Ratification.* There is no question but that the United States should ratify the new Convention at the earliest practicable time.

2. *Implementation.* By its terms the Convention is not self-executing and statutory implementation is needed. A study of all the changes introduced by the new Convention has resulted in the conclusion that statutory implementation is essential only in connection with the new paragraph added to Article 4C which provides that the right of priority may be claimed for a second or later filed application in certain cases. In view of the fact that 35 U.S.C. 119 and 15 U.S.C. 1126d, dealing with the right of priority in the case of patents and trademarks, respectively, specifically refer to the first filed application, amendments to these two sections will be necessary.

3. *Finances.* The resolution referred to in section 13 of this report requests the countries to raise their contributions to the support of the International Bureau. The total share of the United States at this increased level would be a comparatively small amount, in the neighborhood of seven to eight thousand dollars. In view of the fact that most countries had raised their contributions from 1947 on, while the United States did not do so, that deficits have been borne by the Swiss Government and by other means, and in view of the proceedings at the Conference relating to the subject of finances, it is considered imperatively necessary that the United States take prompt steps to raise its contribution to the higher level.

4. *Participation in future meetings.* Since another Conference of Revision may not be held for some time, the question of participation by the United States need not now be considered, but there is no doubt that the United States should participate in any future Conference of Revision.

The United States will, of course, be invited to participate in the triennial conferences provided by new paragraph 5 of Article 14 and should be represented at these meetings not only because of the business involved but also because these meetings will provide excellent opportunities for keeping abreast of and participating in international developments in the field of patent and trademark law. The same remarks apply to the ad interim consultative committee proposed to be set up before the meetings of these conferences begin.

SUPPLEMENT

TRANSACTIONS OF THE CONFERENCE

Owing to the fact that so much of the work of the Conference was concerned with technical matters, a rather full explanation of the proposals and summary of the work of the Committees is presented as a supplement, instead of merely incorporating a brief summary, which could not be adequate, in the main part of this report. The work of each of the five Committees is summarized, in approximately the order in which the items on the agenda were first taken up by them. Further activity in the General Committee with respect to a particular item, if any, is discussed following the treatment of the working Committee action on that item. Some of the proposals which were not adopted, dealing with subjects which have been discussed many times in the past, are nevertheless treated in full as of possible interest in future considerations of the same subjects. For completeness, a brief summary of the opening and closing sessions is also included. Since this is part of the report of the United States Delegation, naturally the activities of the Delegation are in places treated more fully than those of other countries.

A. OPENING SESSIONS AND RULES OF THE CONFERENCE

The first day of the Conference was taken up with introductory and organizational matters.

A Preliminary Meeting opened at 11:30 A.M., with the chairman of the Portuguese delegation in the chair. After an address of welcome by the Chairman of the Organization Committee, the first order of business was the appointment of a Credentials Committee. This was done through nomination by the Chairman and voice approval by the assembly. The Czech delegation proposed and obtained approval of the addition of delegates from Poland and Finland. The Credentials Committee consisted of four delegates, from Italy, France, Finland, Poland, one representative of the Portuguese Foreign Ministry, and two representatives of the International Bureau. The meeting then adjourned, at 11:50, until 1:00 P.M.

At the resumed session of the Preliminary Meeting, which lasted fifty minutes, the Credentials Committee reported that the official documents authorizing the delegates to attend the Conference were in order, and that the plenary powers, not all of which had been filed, would be examined later. The Credentials Committee did not report on the plenary powers until the day before the last day of the Conference.

The next order of business was the adoption of rules of procedure for the Conference, a printed copy of proposed rules having been distributed before the morning session. These rules were adopted with a few minor amendments and will be summarized below.

The meeting then proceeded with the election of a President (chairman) of the Conference, a "Rapporteur" and a Chairman of the General Drafting Committee, which was done by acclamation, and the approval of an Assistant Secretary General and Secretaries.

The formal Opening Session of the Conference, consisting of addresses only, was held at 3:30 P.M. and lasted half an hour.

The First Plenary Session was held from 6:00 to 6:15 P.M. Its first action was to ratify the appointments made at the Preliminary Meeting. After several formal complimentary matters, the President declared the meeting to be a meeting of the General Committee to consider officers of the Special Committees. Nominations, by country, were made by the Chairman and agreed to by acclamation.

The rules adopted at the Preliminary Meeting were similar to the rules adopted at the London Conference of 1934, with a few modifications. The articles will be briefly summarized with comments on some of them.

1. **Agenda.** The proposals prepared by the International Bureau and the proposals submitted by the Governments and coordinated by the International Bureau form the agenda. This refers to the Preliminary Documents described in section 4 of this report. In practice, however, proposals submitted by the Governments were ordinarily not specifically considered unless re-presented as new proposals according to Rule 7.

2. **Officers.** The Conference shall appoint a President, and on the proposal of the President, a Rapporteur. The Chairman of the Committee on Organization of the Conference is ex-officio First Vice President of the Conference. The chairmen of the special Committees and the General Drafting Committee are ex officio Vice Presidents of the Conference. The Vice Director of the International Bureau is ex officio Secretary General of the Conference. An Assistant Secretary General and two Secretaries shall be appointed on the proposal of the Secretary General.

3. **Duties of the President.**

4. **Voting.** Any member of a delegation may speak and vote, but each country is entitled to only one vote. Voting shall be by roll-call of the countries in alphabetical order of their names in French. Unanimity shall be required for the adoption of a text in Plenary Sessions, but not in meetings of the Committees.

Voting by roll-call was not always applied in meetings of the special Committees, where a show of hands, or the consensus as determined by the Chairman, was often all that was necessary.

There had been some discussion previous to the Conference as to whether the rule of unanimity should be changed to a different rule, such as a four-fifth majority, and the International Association for the Protection of Industrial Property had even passed a resolution in favor of a change. The explicit statement was inserted in the proposed rules for the purpose of expressing the existing status, making it necessary for those who wish to change it to take positive action. Despite the previous activity, no suggestion for a change in the existing rule was made during the Conference.

5, 6. **Non-member delegates.** Members of delegations of non-member countries and representatives of Intergovernmental Organizations may take part in the discussions and present observations. Representatives of private organizations are qualified as observers but may be invited to speak by the chairmen of the Committees. None of these non-member delegates could vote.

7. **New Propositions.** New texts proposed shall be submitted in writing and distributed before being discussed.

8. **Work of the Conference.** The Conference shall constitute itself a General Committee for the purpose of examining the proposals.

The General Committee may form itself into several Committees. The results of the work of these Committees is to be submitted to the General Committee.

9. The Conference shall appoint a General Drafting Committee, to which the texts adopted by the General Committee are to be submitted before being considered by the Plenary Conference.

10, 11. Reports of the Rapporteur and of the Committees.

12. Languages. Following the rule of the London Conference, the proceedings were conducted in French and English, with translations made from one to the other. Simultaneous translation was used. The rule also provided that the working documents of the Conference were to be prepared in French and in English, which requirement was not present in the rules of the London Conference.

B. COMMITTEE II, PATENTS

Committee II was faced with the heaviest work load. It held fourteen sessions (not counting meetings of subcommittees), from Tuesday, October 7, to Monday, October 20, more than any of the other Committees. This Committee had more subjects to consider, and its Chairman adopted a policy of permitting full discussion. The United States delegation played an active part in the work of this Committee. Mr. Watson attended all sessions as Vice-Chairman. Mr. Teare and Mr. Federico attended all sessions and took part in the discussions, and served on various select subcommittees; the latter also served as a member of its Drafting Committee which prepared the final Committee texts and the report of the Committee.

After opening remarks by the Chairman, the first action of the Committee was to elect the members of its Drafting Committee and to designate Mr. Paul Mathely, a delegate for the International Association for the Protection of Industrial Property, as a technical expert for the Committee, to assist the Rapporteur and the Drafting Committee.

The Committee considered sixteen separate items and adopted nine proposals to amend the Convention, and two resolutions, for action by the General Committee. These were all carried in the General Committee, some with drafting amendments and one with an amendment of substance.

1. *Item I. Right of Priority: Regularly Filed Application*

That article of the Convention which is probably most often utilized directly is Article 4 dealing with the right of priority. In general, the article provides that if a person has regularly filed an application for patent in one country of the Union and thereafter, within one year, files another application for a patent for the same invention in another country, the second application is given as an effective filing date the date of filing the first application. In effect, the filing of an application for patent in one country constitutes a constructive filing of applications for patent for the same invention in all the other countries on the same date, which constructive filing is made actual in a particular country by the filing of a formal application in that country within one year of the date of filing of the first application. Various details concerning this right of priority are specified in the subsections and paragraphs of Article 4. The benefits of this pro-

vision are realized constantly by inventors who obtain patents for the same invention in different countries and hence is that provision of the Convention which is most familiar in its practical operation. It is not at all surprising then that a number of the propositions to be considered by the Conference related to the right of priority.

Item I on the agenda was a proposed new paragraph 3 to be added to Article 4A. Two separate thoughts were embodied in the original proposal; first, a definition of that which constitutes a regularly filed application upon which a right of priority may be based, and second, a requirement that the country in which an application is regularly filed be required to supply the applicant with whatever might be needed to enable him to assert, in another country, the right of priority based upon that application.

After initial discussion the subject was referred to the Drafting Committee. The proposal was drawn up in appropriate form by that Committee and discussion of the revised proposal was continued.

The discussion of the first of the two concepts revolved around the formalities incident to the filing of an application and which country, the first or the second, should decide whether or not the first application had been regularly filed. It was made clear by the discussion that the first concept related to matters of form only and that the question as to whether or not an application was correct in form should be decided by the country in which the first application was filed. The United States member, in speaking on the subject, brought out the fact that in the United States the right of priority would be refused if the first application did not contain an adequate disclosure of the invention, and the sense of the meeting appeared to be that the proposal was not concerned with the substance of the first application but only with the formal correctness of the application according to the requirements of the country of filing. In this respect the language, or the derivation of the language, submitted by Great Britain was adopted, this merely stating that a regularly filed application was any application which is adequate to establish a filing date in the country concerned. One of the original objectives of the proposal appeared to involve substance but this was not asserted by anyone in the discussion. The phrase added to the proposition, "whatever may be the outcome of the application" makes it clear that, if the application is formally correct so that it may be given a filing date in the country concerned, then the subsequent fate of the application is immaterial and the right of priority cannot be refused by a second country merely because a patent was not granted in the first country. However, this does not prohibit the refusal of the right of priority by the second country on the ground that the first application does not disclose the invention, or even perhaps on the ground that the first application may not have been a bona fide application.

The second proposition, requiring the country of first filing to supply the necessary proofs to assert the right of priority, although included in the Drafting Committee's text, was dropped after some discussion. It was pointed out by the United States member that this second proposition merely required a country to supply its own citizens with proofs necessary to maintain or obtain rights abroad, and that all countries normally would do whatever was necessary. Hence, it was generally considered that adoption of the proposition was unnecessary.

The amendment adopted, the addition of paragraph (3) to Article 4A was carried in the General Committee without comment. At the same time a drafting amendment was made in paragraph (2).

The particular revision accords with the practice in the United States under existing law and it will not be necessary to either make any changes in the statute, or to make any changes in the practice under the statute, to comply with the provision.

2. *Item III. Right of Priority: Definition of First Application*

Article 4C provides that the period of priority starts from the date of filing the first application and, as generally interpreted and applied, the right of priority can *only* be based upon the first application filed by an inventor in one of the countries of the Union. This interpretation is embodied in the language of the United States statute in 35 U.S.C. 119. Accordingly, if an inventor files a first application in one country then later files a second application in the same or another country, he cannot base the right of priority for a third application on the second one, but it must be based upon the first or none at all. If the third application mentioned is filed outside the year from the first application, then it is not entitled to any right of priority at all. Item III on the agenda constituted a proposal that under certain circumstances the right of priority might be based upon a second or later filed application instead of upon the first application. This provision occasioned considerable discussion. The main objections made to it were by the French who, after their practical objections were met, maintained theoretical objections based upon the notion that a first application was inviolate as a first application, and a later application could not be the first. This was probably based to some extent upon the language used in referring to the proposition as the "definition of the first application" rather than by more appropriate language. The Chairman appointed a subcommittee to study the matter and report if any compromise could be reached. Eventually a form of wording which the French agreed to accept was evolved and became new paragraph 4 added to Article 4C. According to this paragraph, a second or later filed application can serve as the basis for the right of priority under certain conditions. These conditions are, that the first application must have been withdrawn, abandoned, or refused at the time of filing of the second application, without having been open to public inspection and without leaving any rights outstanding; also it must not have served as the basis for claiming any right of priority. These conditions render the provision of limited application. There are, however, some situations in which it may be of benefit to American inventors. After an inventor has filed an application in the United States, then if this application becomes abandoned and thereafter the inventor files a second application here for the same invention, this second application may serve as the basis for the right of priority in another country. However, the provision does not necessarily apply to the common situation where the inventor has filed an application in the United States and later has filed a second application, which might be a division or so-called continuation of the first application, during the pendency of the first application. Under 35 U.S.C. 120, this second application may be entitled to the benefit of the date of the first application and hence it cannot be said

that the abandonment of the first application leaves no rights outstanding if the applicant claims the date of the first application under 35 U.S.C. 120; in this situation some countries may presumably refuse a right of priority based upon the second application, as to the subject matter disclosed in the first application.

The amendment was carried in the General Committee without comment.

Section 119 of title 35 enacts the right of priority for the United States in patent cases. In view of the fact that the section specifically refers to the first filed foreign application as giving rise to the right of priority, changes in this section will be needed to carry the new proposition into effect.

The right of priority in trademark cases is incorporated in section 44(d) of the Trademark Act of 1946 (15 U.S.C. 1126d). This provision also refers to the date on which the application was first filed in the foreign country and hence revision will also be necessary.

3. *Item IV. Right of Priority: Partial Priority*

The term "partial priority" refers to the situation in which the second application contains the disclosure of the invention of the first filed application and, in addition, claims other matters, and the right of priority is sought with respect to the common subject matter. In many countries this cannot be done and the object of the proposal in Item IV was to require a country to give the right of priority in this particular situation. The proposal as originally embodied in a second paragraph to be added to Article 4F evolved into a modification of the existing paragraph in 4F and the addition of another paragraph. There was very little dispute as to the desirability of the proposal and no difficulty in its acceptance.

In the United States the right of priority has been regularly accorded in the type of situation mentioned, under the existing statute, and hence no change in the statute or change in existing practice is required to carry out the requirements of the amended provision.

4. *New Item: Divisional Applications*

In many countries the Patent Office will require an applicant to divide or restrict his application if it is determined that it claims a plurality of inventions. The applicant may then elect one invention to remain in the existing application and file additional applications for the other inventions. These additional applications normally are given the benefit of the date of the first application and also are normally given the same right of priority to which the first application may have been entitled. Article 4G of the Convention requires this result when "examination reveals that an application for a patent contains more than one invention." The practice mentioned is followed in the United States. In addition, however, there are occasions in which an applicant voluntarily divides his application without having been required to do so. In the United States, when this happens, the second application is given the benefit of the date of the first, and also the right of priority of the first, if any.

The British introduced a proposal, in the Preliminary Documents and by circulating a text of a substitute for Article 4G, to the effect that the applicant has the right to divide his application, preserving the original filing date and the right of priority, if any. The distinc-

tion between the existing article which related to forced divisions and the proposal which created a right to voluntarily divide engendered some confusion which was clarified by the remarks of the United States member, who suggested that the proposal should be an addition rather than a substitution. Further, it was pointed out that the provision related solely to the matter of dates and did not require a country to issue a second patent. In the United States, while second applications may voluntarily be filed by an applicant, and they are accorded the benefits of the original dates, nevertheless, a patent might be refused if there is not sufficient distinction between the two cases, and it was to be understood that the proposal did not necessarily require the country to grant two patents. After initial discussion of the proposition, the Chairman appointed a subcommittee to produce a draft which, after some modification, was accepted. The last sentence in the final draft, that each country has the right to determine the conditions under which such divisions shall be authorized, would preserve the existing practice in the United States.

The proposal, a new paragraph added to Article 4G, was adopted in the General Committee without discussion.

The proposal does not require any changes in the United States statute or in the existing practice of the Patent Office to carry it into effect.

5. *Item D. Documentation Center for Patents Under Priority*

Item D. of the agenda proposed in the alternative an amendment to Article 4D(1) and a new separate arrangement. The Bureau is concerned with setting up what it calls a Documentation Center for Patents Under Priority. This would seem to be a central index or concordance in which patents issued in different countries to the same party for the same invention could be located. The primary source of information for making up the index would be the information contained in publications of patents which have been granted after claiming the priority of an earlier application filed in another country. From this source corresponding cases could be tabulated. This index would need to be built up on a continuing basis and considerable labor might be involved. During the course of the discussion, the Bureau representative made the remark that the Bureau already had authority to carry on this work. The United States member asserted that the amendment to Article 4D(1) did not in itself authorize any new activity by the Bureau and that some authorization as by a resolution of the Conference or otherwise would seem to be necessary in the absence of specific authority in the Convention itself.

Article 4D(1) of the Convention requires the applicant to supply in the second application certain data concerning the first application, and the second country must publish this information, which is ordinarily done at, or shortly before, the time the second application becomes a patent.

The separate arrangement was discussed first and the general opinion was in opposition. During the course of the discussions it appeared that there was a strong attempt to make the index one of applications as well as patents. The proposed arrangement, it should be noted, would require publication or sending of information to the International Bureau, concerning applications for patents. The

United States member opposed this idea unless the information was not required to be published or supplied until the time the application became a patent and was available to the public, or, in countries having oppositions, the time when the application was published for opposition. The British delegation, after the proposal for the new arrangement was considered defunct, submitted a specific amendment to Article 12 of the Convention requiring each country to publish, in its official patent periodical, lists of the names of applicants for patent, the number of the application, the date of filing, as well as the same information relating to a previously filed application for which the right of priority was claimed. The United States member strongly opposed the publication of information concerning pending applications for patent in view of the principle maintained in the United States that such applications are confidential, and the opposition was supported by several other countries. The new British proposal was thereupon dropped.

The proposal to amend Article 4D(1) consisted in adding to the particulars specified a requirement that the applicant claiming the right of priority of a previously filed application also give the number of the prior application. The United States member opposed the insertion of this additional requirement at the particular place in view of the practice of many countries in requiring the particulars specified in Article 4D(1) at the time the second application is filed (in the United States these particulars may be supplied at any time). The addition to particulars required at the time the application was filed would have further complications and, in some cases, would involve loss of the right of priority. The United States delegation did not oppose the requirement in general but merely the making of it obligatory. The objection to the obligatory requirement was supported by the German delegation. As a result of the discussion and the various objections, the proposal eventually adopted was an addition to paragraph 5 of Article 4D, which, in its present wording, permits the subsequent requiring of further proof. By the addition to this paragraph the applicant will be required to give the number of his first application but not at any particular time.

When patents are issued in the United States the heading of the printed specification and the lists published in the Official Gazette give the date and country of an earlier filed application for which the right of priority is claimed. In view of the amendment to Article 4D(5), the Patent Office will at some time in the future need to include also the serial number of the foreign application. No change in the statute will be needed by the present amendment (the last sentence of 35 U.S.C. 119 already gives the Commissioner of Patents authority to require any information deemed necessary), but, as indicated, the Patent Office will need to make the slight addition to the information in its printed publications.

6. *Item V. Disclosure of Invention Before Applying for Patent*

The proposal on the agenda consisted of a new article which would permit an invention to be disclosed before applying for a patent, without losing the right to a patent. The period of permissible disclosure specified was six months.

This particular proposal represents a conflict of different principles concerning patents and illustrates the difficulty of reconciling these

differences. In the European countries, and in most other countries, the disclosure of an invention by the inventor or by anyone else before applying for a patent will defeat the right to a patent (with in some countries certain minor exceptions not relevant generally). These countries, in effect, strictly follow the so-called contract theory of patents. This theory is that a patent is a contract between the government and the inventor. In exchange for the patent the inventor discloses his invention to the public, the consideration for the patent being the disclosure by the inventor. If the public has already become possessed of the information, no matter in what manner, there is no consideration and a patent cannot be granted. Another aspect of this concept is that of novelty. The invention must be novel at the time of applying for a patent; if it has been published before that time it is not novel and cannot be patented. In the United States, on the other hand, a patent may be granted even though the invention has been published in printed form or used publicly, by the inventor or by anyone else, for a period of one year before applying for a patent. This principle introduces several complications in the law. Many countries were completely unwilling to revise their concepts and permit publication generally of the invention for a period before filing, with the attendant difficulties, and the proposition in a broad form had not much chance of being accepted.

The proposal possibly being susceptible of a narrow construction, the United States offered a substitute expressed in broad terms that an act of disclosure of the invention within the six months preceding the application would not prejudice the right to a patent, and also offered language to insure that the present one year in the United States law would not be extended to 18 months. Austria, supported by Germany, suggested that the non-prejudicial disclosure be limited to that based on the invention of the applicant, so as to avoid the possibility that a stranger could still get a patent after the disclosure. Australia and the International Association for the Protection of Industrial Property proposed to limit the paragraph to disclosure by a person other than the inventor or his representative, while amendments proposed by Japan and Yugoslavia would limit the disclosure to one made against the wishes of the inventor, or wrongfully by some person other than the inventor.

The first discussion of the subject took most of one meeting with some 20 countries participating. A variety of opinions were expressed, with much opposition. Only a few countries, including the United States, were in favor of a broad proposal; some countries were definitely against anything on the subject, while others might accept some compromise. The Chairman adjourned the discussion to a later meeting.

On resumption of the discussion only the specific limited proposals of Japan (Doc. No. 55) and Yugoslavia (Doc. No. 56) were taken up. The vote on the first was 22 in favor, 3 against (Austria, France, The Netherlands), and 3 abstentions. The delegates voting "No", in response to a question by the Chairman, indicated that they would not reconsider their votes, and they also expressed their opposition to the second proposal. The Chairman concluded that it would be useless to submit the matter to the General Committee.

7. *Item VI. Patentability of Chemical Products*

The proposal on the agenda included the broad proposition that "each country of the Union undertakes to permit the patentability of chemical products independently of their manufacturing processes." A second paragraph to the proposal, relating to compulsory licensing of dependent patents, was not taken up, as the discussion in general went to the broad proposition only.

About half of the countries represented at the Conference do not grant patents for chemical products, that is, for the substance itself, as is done in the United States. These countries, however, grant patents for processes of making the chemical substance and in some instances the claim for the process confers protection on the product when produced by that same process. In view of the importance of the subject, there was considerable discussion of the broad proposition, taking up an entire session. The United States member spoke at length, showing the weakness or insubstantiality of arguments presented against patenting chemical products. Other countries speaking in favor included Germany, Canada, Sweden, Israel, Australia, Ireland, and Japan. Norway submitted an alternative text (Doc. No. 34) in hope of getting agreement. Countries speaking against included Italy, Bulgaria, Hungary, Austria, Poland, Czechoslovakia, Yugoslavia, Roumania, Spain and Brazil.

The vote on the broad proposition was 16 for, 12 against, 3 abstentions. The 12 countries voting "No" were the ten previously mentioned and France and Portugal. In view of the strong opposition the matter was considered lost.

One remarkable thing in the discussion and voting was the strong support from countries which do not grant patents for chemical products. The countries voting in favor included Germany, Denmark, Finland, Japan, Luxembourg, Norway, Netherlands, and Sweden, which now do not patent chemical products. Switzerland did not speak against and abstained.

Following the defeat of Item VI, Germany introduced a resolution that the Conference invite the member countries to provide for the protection of new chemical products in their national laws. When taken up at a later meeting this was amended by making it an invitation to "examine the possibility," and passed. In the General Committee, the resolution was adopted by a vote of 27 in favor, none against and 12 abstentions.

8. *New Item. Importation of Products Produced According to a Patented Process*

Switzerland introduced a proposal for the addition of a new article to the effect that the importation into, or use or sale in, a country, of products made in a foreign country according to a process which is patented in the country of importation shall constitute infringement of the patent involved. A second paragraph established a presumption of infringement when the product is new. While much broader in scope, the proposal would be of particular application to chemical products in view of the unpatentability of such products in many countries.

In the opening discussion three countries spoke in opposition to the proposal; ten countries, while expressing approval of the principle in whole or in part, generally objected to various parts or wanted some

limitation; and only three countries supported it in toto. The United States member spoke in opposition to the proposal as it stood. He pointed out that in the United States using or selling a product of a patented process was not an infringement, as a matter of principle, and that in no case was the act of importation an act of infringement; he also pointed out that, while under limited circumstances, importation could be prevented on the basis of unfair competition, this provision was too limited to comply with the proposal.

The Chairman appointed a subcommittee, consisting of the United States, Czechoslovakia, Switzerland, Germany, Netherlands, Italy, Roumania, Sweden, Great Britain, Israel and France to study the matter further.

The subcommittee continued the discussion in a lengthy session, and three separate propositions were discussed. The vote of the subcommittee on the first paragraph of the original Swiss proposal (the second paragraph not being acted on) was 7 in favor, 4 against, and 1 abstention. The four countries voting "No" were Great Britain, the United States, Israel and Czechoslovakia.

Switzerland then proposed to amend its resolution to restrict it to those countries in which chemical products could not be patented, the United States member and others having indicated no opposition to such an amended proposal. The vote on this was 4 in favor (including the United States), 5 against, and 3 abstentions.

Great Britain then proposed consideration of a resolution passed at Oslo by the Executive Committee of the International Association for the Protection of Industrial Property. The main objection to it was on the basis of its lack of substance, but the vote on it was 6 in favor, 2 against, and 4 abstentions. The subcommittee reported this resolution as having the best chance of being ultimately accepted (Doc. No. 135). When the matter was again brought up in the Committee, on the basis of the subcommittee report, the countries voting against the Oslo resolution agreed to abstain and it was considered adopted by the Committee. In the General Committee it was adopted by a vote of 29 in favor, none against, and 10 abstentions, becoming new Article 5 quater.

This new article provides that "When a product is imported into a country of the Union where there exists a patent protecting a process of manufacture of the said product, the patentee shall have all the rights, with regard to the imported product, as are accorded to him by the domestic law of the country of importation, on the basis of the process patent, with respect to products manufactured in that country."

As far as the United States is concerned, this Article does not affect our existing laws in any way, but it might have some effect on the laws of some foreign countries.

9. *Item VII. Compulsory Licensing of Patents*

The compulsory licensing of patents and related matters has been the subject of considerable discussion at previous conferences of revision, and these matters also received a great deal of attention at this time. One full session and substantial parts of three other sessions, as well as lengthy subcommittee meetings, were devoted to the subject.

In order to locate the points of discussion it is necessary first to review the provisions now in force. Paragraphs 2, 3, and 4 of Article 5A as revised at London impose certain conditions on the granting of compulsory licenses and the revocation of patents "to prevent the abuses which might result from the exclusive rights conferred by the patent, for example, failure to work." Paragraphs 2 and 3 provide that the countries may take necessary legislative measures for the granting of compulsory licenses in such cases, and that a patent cannot be revoked unless the granting of compulsory licenses is insufficient to prevent the abuse. Paragraph 4 provides a period of three years from the grant of the patent before a compulsory license can be applied for, which compulsory license is not to be granted if the patentee can justify himself by legitimate reasons, and provides a further period of two years after the grant of the first compulsory license before any action to revoke the patent can be initiated.

Before discussing the proposed changes a question of interpretation will be mentioned. Paragraph 4, which has been referred to, begins with the words "In any case * * *." In view of these words, do the conditions expressed in paragraph 4 apply to all compulsory licenses no matter on what basis they may be granted, or do these conditions apply only to compulsory licenses granted for the purpose indicated in paragraphs 2 and 3? It should be noted that in the *Parke-Davis* case in Great Britain (*Parke Davis & Co. v. The Comptroller General of Patents*, 71 Reports of Patent, Design, and Trade Mark Cases (London) 169) the House of Lords considered paragraph 4 as dependent upon the previous paragraphs and that the conditions there imposed, notably the time period, were not mandatory in the case of compulsory licenses granted in pharmaceutical patents under the British statute. Similar rulings have been made in Canada under the Canadian statute, which is similar to the British in this respect. The Preliminary Documents under Item VIII raised this question of interpretation without making any specific proposal. The replies of the governments showed that the vast majority interpreted paragraph 4 as being dependent upon the preceding paragraphs, and the Chairman accepted this as the interpretation.

The proposal in the Preliminary Documents and subsequent proposals may be divided into three parts:

(a) The elimination of revocation of the patent as a remedy against the patent abuses contemplated, leaving the granting of compulsory licenses as the only remedy.

(b) Changing the waiting period before a compulsory license could be applied for, to five years from the date of filing the application for patent, or three years from the date of the grant of the patent, whichever is later, and

(c) Additions to the conditions under which compulsory licenses may be granted.

The first session considering the matter, while giving rise to general discussion, was mainly concerned with the first part of the proposals, the elimination of the revocation penalty. Many countries spoke in favor of the proposition but there was also some opposition.

When the subject was resumed at a later session, the Committee had before it the text proposed by Belgium, which revised Article 5A in the first two respects mentioned above, but limiting paragraph 4

to failure to work, and included a proposed subarticle 5A bis specifying conditions on the grant of compulsory licenses in general (Doc. No. 97). Discussion continued on the abandonment of the revocation penalty, which, being considered as applying only to failure to work, was put to a vote. The vote was 20 in favor (including the United States), 5 against and 3 abstentions. The countries voting "No" were Brazil, Spain, Italy, Mexico and Yugoslavia. The Chairman announced that the proposal was rejected. Switzerland urged that it be passed on to the General Committee but the Chairman insisted that it should be considered as rejected by the Committee as the opposition was irreconcilable.

After this discussion, Switzerland proposed that a special arrangement be entered into between the countries willing to agree to it, that the working of a patent in one country would be equivalent to working in any of the other countries participating in the agreement (Doc. No. 94). The Chairman called for a vote on the willingness to discuss such an arrangement. Only 4 voted in favor, Germany, Switzerland, United States and Lichtenstein, and all other countries abstained. The Chairman first said that the matter could be discussed by a subcommittee consisting of the interested countries but when it became known that the four countries voting for consideration of the subject were four countries between which special bilateral arrangements on the same subject already existed, he withdrew the reference to a subcommittee and the matter was not considered further.

The Chairman turned the remainder of the subject over to a subcommittee consisting of the Drafting Committee augmented by Great Britain, Italy, and Roumania.

The subcommittee on compulsory licenses had a lengthy session during which the Belgian text was debated extensively and revised.

With respect to the waiting period before a compulsory license could be sought, there were varying points of view. Some objected to the proposed change, some wanted no waiting period, and others wanted the waiting period in non-working cases only. As the result a compromise was accepted by the majority, providing for a waiting period for compulsory licenses on the ground of failure to work or insufficient working, of four years from the date of the application or three years from the grant of the patent, whichever expires later.

Most of the discussion revolved around the addition to the conditions under which compulsory licenses were to be granted. The proposal specifically considered placed the new conditions in a separate subarticle, 5A bis, containing two paragraphs, making them apply to all compulsory licenses no matter for what cause given. These conditions required the payment of fair or just compensation to the patentee, with recourse to the courts, and the non-exclusivity and non-transferability of such licenses. The provision in the first paragraph, as worded, would affect the anti-trust laws of the United States and the revision of the proposal in such a manner as to avoid this result was the subject of considerable discussion. The United States member proposed various changes in this respect but the subcommittee reported the proposal without taking care of this matter.

The report of the subcommittee then came up for discussion in the Committee. The revision of Article 5A was accepted but the United States member again proposed that the first paragraph of 5A bis be

amended to exclude its application to "action taken by countries in the administration and enforcement of national legislation designed to prevent monopolization and restraint of trade," receiving some support from Canada. There was substantial opposition to the United States proposal, and some opposition to other matters in 5A bis. The Chairman referred this matter to an ad hoc subcommittee.

The subcommittee reported that no agreement could be reached and as a result the first paragraph of 5A bis was considered rejected. The second paragraph of 5A bis was thereupon transferred to 5A. This revision of Article 5A was adopted and passed in the General Committee.

10. *Item XXI. Temporary Protection at Exhibitions*

The item on the agenda purported to revise Article 11 in procedural matters, although the French text made an important change in substance by changing a "may" to a "shall", which was not reflected in the English translation. In some respects these revisions were objectionable to the United States and the United States member spoke against some of them. It was pointed out by the United States member that clarification of what was meant by "protection" would be helpful and he suggested the addition to the first paragraph of a statement that the protection was against loss of right by reason of the exhibition. A good many of the countries were in favor of completely omitting Article 11 on the ground that the protection afforded by it was illusory. The discussion brought out that clarification of three things was necessary: what was an "official or officially recognized international exhibition"; what was the nature of the temporary protection; and how could an inventor prove what was exhibited?

After the discussion which occupied a whole session, the Chairman appointed a subcommittee consisting of Spain, United States, Germany, Yugoslavia, Great Britain and Israel to study the question.

The discussion was resumed on a text proposed by Germany and Yugoslavia (Doc. No. 129). The United States member objected to the granting of a right of priority to the date of the exhibition. The Chairman observed that the text did not quite agree with the discussion in the subcommittee. Great Britain objected on principle and the Chairman declared that further discussion would be useless. After some further discussion on the abolition of Article 11 the Chairman put three questions to a vote. On the deletion of Article 11: 15 in favor, 7 against, 5 abstentions (the United States member abstained). On the German-Yugoslav proposal: 7 in favor, 12 against (including the United States), 8 abstentions. On an alternate proposal submitted by the International Federation of Patent Agents (Doc. No. 132): 5 in favor; 6 against; 16 abstentions (including the United States). The net result was that Article 11 was retained without change.

11. *New Item. Exchange of Patent Specifications*

Czechoslovakia proposed an addition to Article 12 which would require the countries to exchange copies of their periodical journals, and descriptions of patents granted.

About 14 countries participated in the discussion. The United States member described the existing practice of exchange by mutual

agreements, implying that this method was preferable, and two countries objected to the proposal on the ground that voluntary exchanges gave satisfactory results. The addition of a requirement that the exchange was to be on "conditions to be agreed upon" was suggested by the proponents, and also a provision for regulations governing expenditures. The Chairman appointed a subcommittee consisting of Czechoslovakia, Roumania, United States, Norway and Canada.

The subcommittee submitted for consideration a revised proposal (Doc. No. 170) requiring exchange of official bulletins, and also requiring the countries to enter into negotiations, upon request, to exchange printed descriptions of inventions. (The United States member had made it clear in the subcommittee meeting that no commitment on this proposal was to be understood.)

After discussion and some opposition, a resolution on the subject was substituted and adopted by the Committee; this resolution, recommending that the countries open negotiations to exchange their patent specifications, was passed in the General Committee session.

12. *Item X. Period of Grace and Restoration of Lapsed Patents*

The item on the agenda proposed a revision of Article 5 bis to extend the period of grace for the payment of maintenance fees, and to provide further for the restoration of lapsed patents. The text of the London 1934 revision provides that countries shall grant an extension of three months for the payment of fees required for the maintenance of industrial property. The proposal on the agenda was to change this period from three months to six months. A second part of the proposal concerned the restoration of patents which had lapsed for non-payment of the fees. The London text provides that if the period of grace permitted by a country is less than six months, then that country must provide for the restoration of lapsed patents. In other words, if a six months period of grace is provided, no provision for restoration is necessary. The proposal would require the restoration of lapsed patents without specifying any time limit. Considerable discussion ensued on the details and conditions relating to restoration with opposition by many countries to the idea of compulsory restoration. The Chairman, at the request of Germany, put the question of whether there should be an obligation to restore lapsed patents, to a vote with the result: 21 in favor (including the United States), 6 against, 4 abstentions. The subject was referred to a subcommittee of 11 countries.

The subcommittee reported unanimous agreement to extending the period of grace to six months, but that there was so much difference of opinion on the restoration that it seemed useless to pursue the matter further in the subcommittee.

The extension of the period of grace to six months was put to a vote and carried: 21 in favor, none against, 7 abstentions.

On the principle of restoration the vote was 20 in favor (including the United States), 6 against, and 5 abstentions, and the discussion continued.

Since paragraph 2 of present Article 5 bis would need amendment or deletion in view of the change in paragraph 1, Switzerland proposed a new paragraph 2 providing for optional restoration, which was adopted.

The revised article was passed in the General Committee session.

Since the United States does not provide for the payment of maintenance fees for keeping industrial property rights in force, the change made in Article 5 bis does not require any action by the United States.

13. *New Item. Minimum Terms for Patents*

Italy submitted a proposal that "the duration of the protection of patents shall be at least eighteen years."

The German delegate stated that they would support the proposal if the words "of the protection" were deleted which would make the proposal coincide with the German law. The United States member opposed this suggestion, after commenting on the difference between the duration of a patent and the duration of protection in many countries. (In Germany the 18-year duration of the patent starts the day after the filing date whereas the protection does not start until a date averaging more than three years later.) He intimated that the proposal should refer to the duration of the actual protection, in which event the period specified need not be as long as 18 years and would then be supported. Canada and Yugoslavia spoke against the proposal. The vote on the proposal was 8 in favor, 13 against (including the United States), 7 abstentions.

14. *New Item. Patentability of Inventions the Use of Which Is Prohibited*

Seven countries, Sweden, Norway, Finland, Denmark, Netherlands, Belgium and Luxembourg, jointly introduced a proposal for a new article providing that a patent cannot be refused or cancelled on the ground that the use of the invention would be prohibited by the domestic legislation, except when the invention is contrary to morality or public order (Doc. No. 119).

There was very little discussion. The United States member indicated approval. The vote was: 16 in favor, 1 against (with the member indicating that the position might be changed), 11 absentions. However, Great Britain reserved its position, stating that the proposal was in contradiction to its policy. France did likewise and both countries abstained.

When the proposal came up in the General Committee session, the delegates of France and Morocco, who had opposed it, stated that they were willing to obtain. The delegate for Great Britain, however, stated that British legislation could not be amended in this regard and they would have to vote against it. After he indicated that they were willing to consider a substitute proposal, the Chairman postponed the matter until the following day. On the next day, a substitute proposal was considered and carried after two minor amendments from the floor. This substitute proposal, now Article 4 quater, does not refer to inventions the use of which is prohibited, but to inventions the sale of which is subject to restrictions or limitations.

The adopted proposal is consistent with the United States law and no action is necessary.

15. *Item F. Proposed New Arrangement on Patents of Importation*

Several countries expressed opposition to any new arrangement on this subject and the United States member indicated that, while his country was not in favor of participating in such an arrangement, it

could raise no objection to its consideration by others. There was no interest shown by any country in having such an arrangement, and the matter was dropped after rather little discussion.

16. *New Item. Recognition of Authors' Certificates*

Roumania introduced several proposals relating to "authors' certificates," which are issued in some countries in place of patents. One was the addition of this phrase to Article 1 (4) which lists the various kinds of patents (Doc. No. 157). Later it proposed an amendment stating that applications for authors' certificates rank as applications for patent for the purpose of the right of priority under Article 4, and an amendment to Article 1 (2) to mention authors' certificates. Czechoslovakia, Bulgaria and Hungary supported the proposals.

The United States member opposed the substantive provision. He stated that the problem was more complex than appeared at first sight; not much was known about the actual operation and significance of authors' certificates; even in their home countries they might not be regarded as patents; in the United States and in many other countries special provisions would have to be enacted; and a detailed study would be necessary. Action at this time was premature.

The Israeli member stated that an authors' certificate constituted an abandonment of the exclusive right to a patent. Germany and Brazil also expressed disapproval and it was apparent that other countries did not favor the proposition.

The Roumanian member insisted on a vote, which resulted in 7 in favor, 12 against, and 8 abstentions.

C. COMMITTEE V, DESIGNS

Committee V, Designs, had as its assignment Item XI, the consideration of some resolutions concerning designs, and the revision of the Hague Arrangement on designs. The Committee had 5 meetings. Messrs. Dixon and Metzger attended the meetings except those concerning the Hague Arrangement.

1. *Item XI. Industrial Designs*

The agenda proposed a new article relating to the protection of designs. The four paragraphs of this article related to

1. A declaration that designs shall be protected.
2. A definition of designs.
3. Novelty to be determined by each country.
4. A minimum period of protection of five years.

The United States in its comments and observations printed in the Preliminary Documents approved the addition of a new article providing for the protection of industrial designs and suggested revised language. However, because of intervening developments, the instructions were to oppose or abstain. In view of the fact that the printed agenda indicated support, and that the United State delegation had to oppose various other propositions, the delegation abstained on the general question.

Paragraph 1 of the proposed new article was discussed, with Great Britain and Yugoslavia speaking in opposition to taking action at this time. The delegates for Germany, Italy and France spoke in

favor and maintained that the paragraph would not interfere with the work of a study group (referred to in the next section). The vote was 10 in favor, 2 opposed (Great Britain and Yugoslavia), and 3 abstentions (including the United States), and the paragraph was considered adopted by the Committee.

After three delegates spoke against the second paragraph, the representative of the Bureau withdrew it. This was agreed to unanimously.

Four delegates opposed saying anything about novelty and on the vote on paragraph 3 there were none in favor, 13 against (including the United States) and two abstentions.

Paragraph 4, specifying a minimum term of 5 years, was discussed with most remarks in opposition. The paragraph received neither affirmative nor negative votes and there were 15 abstentions. It was hence considered dropped.

The general sense of the Committee was that while adoption of a general proposition merely calling for the protection of designs would not interfere with the work of the study group, the insertion of specific details would.

The only matter submitted for action to the General Committee was the single sentence proposed new article providing simply that "industrial designs shall be protected." As stated, there were two votes against it in the Committee. When the matter was taken up in the General Committee session the vote was 28 in favor, none against, and 8 abstentions (including the United States), and the proposition was hence adopted. Great Britain did not vote at all and Yugoslavia abstained.

No action is called for on the part of the United States in view of the absence of definition and details. The existing design patent law, 35 U.S.C. 171-173, would constitute a compliance.

2. *New Item. Resolution on Study of Designs*

The Permanent Committee of the International Union for the Protection of Literary and Artistic Works (Berne Union) and the Intergovernmental Copyright Committee (under the Universal Copyright Convention) both passed resolutions inviting the International Union for the Protection of Industrial Property to participate, on a basis of equality, in studies and meetings concerned with the international protection of works of applied art, and designs and models.

The delegates of the United States, Great Britain and Sweden submitted a draft resolution (Doc. No. 10) for initiation of the discussion. After initial discussion a subcommittee consisting of France (Chairman), Germany, Italy, Netherlands, Great Britain, Sweden and the United States was appointed to consider the matter. When the subcommittee met the resolution was explained by the United States member. The delegate from Italy proposed that only a general statement be made, expressing the desire to cooperate on this subject. The United States member insisted that the specific text be considered, with which several of the countries agreed. The chairman then proposed that a text be prepared by the Rapporteur, but the United States member intervened to secure action on the text already submitted. When this was finally agreed upon, the text was approved except for minor drafting changes and reported to the full Committee V (Doc. No. 23).

Two points of substance were raised, the first of these was to make it clear that if any governmental body of the Industrial Property Union is appointed, that body will be concerned with this subject. The second concerned the attendance of private organizations at the study meeting.

The draft resolution accepting the invitation of the Copyright organizations to engage in a joint study on the protection of designs, which had been presented by the United States, Great Britain and Sweden, was reported to the full Committee, as revised, and was adopted unanimously.

The Resolution was adopted by the General Committee by a vote of 32 in favor, none against, and 5 abstentions.

3. *Item C. Arrangement of The Hague*

Committee V had for consideration various amendments to the Arrangement of The Hague for the International Registration of Designs and Models, grouped under Item C. These and other proposals were considered by the countries which are members of this Arrangement. The United States delegation did not participate.

After consideration of the amendments on the agenda, the Committee came to the conclusion that the Arrangement needed more serious amendment and decided to recommend postponement to a special Conference on the subject to be held not later than 1960, and a resolution to this effect was adopted.

The resolution was approved in the General Committee.

D. COMMITTEE III, TRADEMARKS

Committee III had assigned to it all the items on the agenda specifically dealing with trademarks; it did not have the item dealing with state emblems and items dealing with unfair competition, which were assigned to other Committees, and the items relating to the right of priority considered by Committee II would also, in part, apply to trademarks. While the Committee had a number of very difficult questions, it only held nine sessions. Messrs. Ladas and Myers attended the sessions of this Committee and participated in its work.

The Committee considered twelve different subjects and adopted nine proposals for amending the Convention, and one resolution, for action by the General Committee. Of these, three proposals were defeated and the resolution and six proposals carried, two of them after being amended.

1. *Item II. Extension of the Period of Priority*

The first topic considered by the Committee was Item II, to change the period of priority for trademarks from 6 to 12 months (Article 4C 1). The main argument for the proposal was uniformity with the period for patents, but there was no proposal to similarly increase the six months' period for designs. Ten countries reported adversely in the Preliminary Documents, and two favorably. After some discussion, mostly against the extension, a roll call was taken with 12 for the proposal and 15 against. The United States and Israeli members had stated that they would support the majority opinion and voted in favor.

2. *Item IX. Concurrent Use of Trademarks*

Paragraph 3 of Article 5C of the Convention as revised in 1934 deals with the simultaneous use of a trademark by two or more persons, but is limited to providing that such use of the same mark by "co-proprietors" shall not prevent registration nor prejudice protection of the mark. Item IX of the agenda proposed to replace this paragraph 3 by four new paragraphs, numbered 3 to 6, which would permit simultaneous use of the same trademark by a plurality of persons on a considerably broader basis, and would also recognize ownership of a mark by one person while use of the mark is by another.

The paragraphs of the proposal read as follows:

(3) When, between the proprietors of a mark and other individuals or corporate bodies there exist contractual, financial or other relationships ensuring the unity of control over the use of the said mark by the proprietor and such other persons or bodies, the use of the said mark by such other persons or bodies with the consent of the proprietor thereto shall for all purposes be considered as constituting use of the said mark by the proprietor himself and not to constitute use thereof by the said other persons or bodies.

(4) Such use shall not derogate from the validity of the said mark or the registration thereof in any Convention country.

(5) Subject to the provisions of the national legislation in any country of the Union, Holding Companies may be registered as the proprietors of marks although they are not themselves manufacturers of goods and the provisions of this article shall apply to them.

(6) The countries of the Union may make such provisions in their national laws as may be necessary to ensure that the use of the mark shall not mislead the public and is not contrary to the public interest.

The position of the United States was that the wording of paragraph 3 was objectionable in that the unrestricted licensing of trademarks which could result from the provision was inconsistent with American principles of the use of trademarks. Paragraph 5 was also considered unnecessary.

The discussion of the proposition was opened during the first session of the Committee, with a summary by the Chairman and some consideration of the main features.

The United States had introduced a substitute for paragraphs 3 and 4 (Doc. No. 4) reading as follows:

When between the proprietor of a mark and other individuals or corporate bodies there exists a relationship whereby the proprietor legitimately controls the nature and quality of the goods of such other persons or bodies in connection with which the mark is used, the use of said mark by such other persons or bodies with the consent of the proprietor thereto shall enure to the benefit of the registrant or applicant for registration, and such use shall not derogate from the validity of the said mark or the registration thereof in any Convention country.

The main point in this substitute proposal was in the phrase "the proprietor legitimately controls the nature and quality of the goods * * * with which the mark is used."

Several delegates spoke on the subject during the first session. Three countries, Yugoslavia, Czechoslovakia and Hungary mainly desired to substitute the word "propriétaire" in the French text by the word "titulaire," explaining that in their countries the "propriétaire" of a trademark and the "titulaire" of a trademark may not be the same entity. Delegates from four countries spoke against the reference to holding companies (paragraph 5).

Most of the delegates who spoke raised doubts about the language used in the United States text "legitimate control of the nature and quality of the goods." They said that they did not know what this meant and that it would be difficult to apply. They referred to the Bureau proposal which referred to "unity of control over the use of the mark" and other delegates to the text of the proposal of the International Association for the Protection of Industrial Property (Preliminary Documents, Part 4) which referred to "effective control over the use of the mark."

It was suggested by some that they preferred a much vaguer expression than "control of the nature and quality of the goods," and that this was the reason why they preferred the other expressions. Some of them went on to express the view that the definition of control should be left sufficiently vague so that final control would be sufficient.

The British also preferred the expression "unity of control," stating that, in some cases, both the proprietor and the licensee may actually be controlled by a third entity.

There was nearly unanimous agreement that no special provision should be made for holding companies but most of the delegates wished to have a provision that the proprietor of a trademark need not be a producer or trader.

Leaving aside these differences of opinion on terms to be used, there was no delegation that expressed itself as generally against the principle of licensing of trademarks except Ireland which declared that, if there was a large majority for the licensing of trademarks, although its own law is against licensing, it would try to adapt its law, but it desired time for further consultation with its Government.

The Chairman summarized preliminarily the discussion by suggesting that the only point which appeared controversial was in respect to inclusion of the requirement for "legitimate control of the nature and quality of the goods."

The subject was resumed at the next session of the Committee and the Chairman suggested dividing the subject into the various items for separate voting.

Some delegates spoke on several aspects of the problem before proceeding to vote. Yugoslavia particularly noted that the text being discussed rested on the idea of private economy and should be adapted to take into account the countries which have a socialized economy where trademarks may be used by associations belonging to the State. Czechoslovakia asked whether the United States text was broad enough to include Government organizations either as proprietors or as licensees and was answered in the affirmative.

Germany suggested an amendment of the United States proposal to merely refer to "control of the goods." The German delegate appreciated the distinction between "control of the use of the mark" and "control of the nature and quality of the goods on which a mark is used." The United States member reiterated that control of the use of the mark was not sufficient. The Chairman stated that the result of the meeting would be merely directive to the Drafting Committee and that no delegation would be committed by the voting. Thereupon the voting proceeded as follows:

1. Whether Article 5C 3 should be revised: 25 were in favor of revision, 3 against and 3 abstained.

2. Whether any specific reference should be made to holding companies. The vote was none in favor, 28 against and 4 abstentions.

3. Whether the provision should contain a clause to the effect that the proprietor of a trademark need not be a manufacturer or a trader. The vote was 18 in favor, 4 against and 5 abstentions.

4. The question of control was divided into four parts, as follows:

(a) To specify control of the nature and quality of the goods (The United States proposal). The vote was 3 in favor, 15 against and 8 abstentions.

(b) To specify control of the goods (the German proposal): 5 in favor, 10 against, 11 abstentions.

(c) To specify "effective control of the use of the trademark" (the International Association for the Protection of Industrial Property proposal): 17 in favor, 3 against, 4 abstentions.

(d) Whether the word "legitimate" should be used with respect to the control: 5 in favor, 10 against, 6 abstentions.

5. Whether a provision such as paragraph 6 should be included: 7 in favor, 10 against, 4 abstentions.

6. Whether measures to protect the public against fraud should:

(a) be specified in the Convention (for 4, against 12, abstentions 5),
 (b) constitute a simple right for each country to take (for 22, against 0, abstentions 0), or
 (c) be required of each country (for 7, against 4, abstentions 4).

The matter was thereupon in the hands of the Drafting Committee.

In answer to a remark by the delegate of Czechoslovakia as to whether the proprietor also included liquidators, trustees in bankruptcy, and other bodies which may be deemed to be "titulaires", the German delegate indicated that in this article, as in all other articles of the Convention it is understood that the proprietor himself is also the successor in title. The French term "ayant cause" which correctly may be rendered in English as "successor in title", was also mentioned.

The Drafting Committee reported a substitute for the original proposal (Doc. No. 36), which read as follows:

(3) When there exists between the owner of a mark and other persons, whether physical or moral, relations or agreements which ensure the owner's effective control over the use of the mark on products of the said persons, such use authorised by the owner shall be considered as made by the owner, even if he is not a manufacturer or dealer.

(4) The countries of the Union may make such provisions in their national law as may be necessary to ensure that the use of the mark shall not mislead the public and is not contrary to the public interest.

This was considered at a subsequent session of the Committee. There was discussion of various terms used, as a matter of drafting, with several suggestions made. The United States member stated that the language "control over the use of the mark on products" was ambiguous and vague, that it was questionable whether it could be interpreted to mean control of the nature and quality of the products themselves, and stated that there should be a clear reference to such control over the products.

The member also suggested that in the language of the draft the words "such use * * * shall be considered as made by the owner"

be replaced by the words "such use * * * shall inure to the benefit of the owner", and on request that an appropriate French translation of these terms be supplied, the member suggested "servant au bénéfice". This as well as certain other changes of wording of the draft were indicated as acceptable.

The Chairman then proposed that a vote be taken on the text of the draft with the addition of the United States amendment to include also control of the products bearing the trademark. The vote was: 11 in favor, 7 against, and 12 abstentions.

In view of the indecisive nature of this vote the Chairman then put to vote the Drafting Committee text without the United States amendment, but with some language amendments, and the vote then was 22 in favor, 4 against (Italy, Ireland, Portugal, United States), and 3 abstentions.

Italy explained that its negative vote was directed to the inclusion of the provision which permitted a mark to be registered by a person who is not a manufacturer or dealer, and the negative vote of Portugal was due to a similar reason.

The matter was then referred back to the Drafting Committee.

Following this session the Irish delegation suggested a possible change of wording in the second paragraph of the proposal, which appeared to be acceptable to a number of delegations who were approached. The change would consist in stating that the countries may make such provisions in their national law as may be necessary to ensure that the above provision shall not apply so as to mislead the public or be contrary to the public's interest.

This proposal was taken up at a later session, as well as the deletion from paragraph 1 of the words "even if he is not a manufacturer or dealer". There was general agreement on the deletion of this phrase; Italy stated that it would have no further objection and Portugal also stated that it would vote in favor. After considering a redraft of the second paragraph by the Drafting Committee and its further revision, the text of this paragraph was considered approved by the Committee without further vote.

The final text of the Committee, as sent to the General Committee, read as follows:

(3) When there exist, between the proprietor of a mark and other natural or juridical persons, relations or agreements which ensure the proprietor's effective control over the use of the mark on the goods, of the said persons, such use authorised by the proprietor shall inure to the benefit of the proprietor.

(4) The countries of the Union may apply such provisions in their national laws as may be deemed necessary to ensure that the application of para. 3 of this article will not be prejudicial to the public interest or be likely to mislead the public.

In the General Committee, the United States member explained that the nature of the draft language made it necessary to vote against the proposal. The Chairman stated that, the United States' own proposal not having been adopted by Committee III, there was no alternative but to take a vote on the proposition as submitted to the session. The vote was 33 in favor, 1 against (the United States), 5 abstentions (Brazil, Indonesia, Mexico, Union of South Africa, Yugoslavia). The proposal was therefore defeated. Whether any of the countries abstaining would have voted "No" if the vote of the United States had been different is not known.

3. *New Item. Required Use of Trademarks (Article 5C(1))*

Article 5C (1) provides that if the use of a trademark is compulsory in a country, the registration cannot be cancelled until after a reasonable period, and then only if the person concerned cannot justify his inaction.

The Swedish delegation raised the question of amending this paragraph and proposed a text (Doc. No. 13) for consideration at the next meeting. A similar text approved by the International Association for the Protection of Industrial Property at its Stockholm 1958 meeting was also circulated (Doc. No. 8). The effect of these proposals was to specify 5 consecutive years of unjustified non-use of a trademark before the registration could be cancelled.

The United States member suggested amending the proposal by adding that a registration could be cancelled at any time on the ground of abandonment. He stated that the proposal was not included in the original agenda, that the United States position on it had not been developed and that the possibility of obtaining favorable consideration would be enhanced with the amendment.

The British delegate supported the United States proposal, and further suggested that a mark could be cancelled in the absence of a bona fide intention to use the mark (a trademark being registrable before use in Great Britain).

There was some discussion of what was meant by abandonment of a mark, the United States member stating that that would be a matter for domestic legislation.

The Japanese delegate spoke against the Swedish proposal and the Yugoslav delegate suggested three years instead of five years. The Bulgarian delegate proposed a clarifying language amendment.

The Chairman called for a vote on four questions with the following results:

On the United States amendment: 10 for, 11 against, 5 abstentions.

On the British amendment: 10 for, 14 against, 5 abstentions.

On the Yugoslav proposal (three years): 3 for, 27 against, 2 abstentions.

On the Swedish proposal unamended: 17 for, 6 against, 4 abstentions.

The matter was referred to the Drafting Committee, the Chairman stating that it should consider the United States and British proposals as had been suggested by the United States and several other delegates.

The Drafting Committee submitted a text (Doc. No. 26) with a sentence added in parentheses reading as follows:

(This paragraph does not apply to cases in which there was, at the date of registration, no bona fide intention to use the mark, or when the owner has effectively abandoned his mark.)

After an explanation of the meaning of the added sentence by the United States member, the Chairman put the entire text, with the added sentence, to a vote with the result: 23 for, 1 against (Japan), 5 abstentions. The Japanese delegation indicated that their objection was to the period of five years, as being too long, but that they would study the matter further and hoped that they would receive instructions to agree with the majority.

When the proposal came up for vote in the General Committee session the vote was 31 for, 1 against (Japan), 5 abstentions, and the proposal was lost.

4. *Item XII. Basic Trademark Article*

The Preliminary Documents presented two important problems in connection with Article 6 of the Convention. One was the introduction of a new article, and the other the revision of the text of the existing article.

Subsection A of Article 6 now in effect provides in effect that if a trademark is duly registered in the country of origin, it must be registered in the other countries of the Union in its original form (*telle quelle*). The provision goes to the form or character of the mark and the second country must register it despite the fact that its own principles of trademarks do not recognize such marks. Subsection B enumerates certain grounds of refusal relating to the form or character of the mark, which might still be used by the second country to refuse registration. Subsection C defines country of origin. Subsection D relates to the independence of registrations of the same mark in different countries. Subsections E and F are not involved.

Despite the requirement of Article 2 for national treatment and the limited scope of Article 6, some countries specifically require a home registration in all cases before a foreigner can register his trademark in those countries. The proposed new article was intended to insure that a person entitled to the benefits of the Convention had the right to register his trademark in any country of the Union, if he satisfied the requirements of the laws of that country, without regard to the fact of whether or not he has a registration in his home country.

Discussion opened on the revision of Article 6 and during this consideration the United States member called attention to the proposed new article. Without discussion the Chairman proposed that the principle of the new article be adhered to, and there being no objection, the proposal was referred to the Drafting Committee.

The Drafting Committee submitted a text (Doc. No. 81) at the same time that it submitted a first text on the revision of Article 6. The new article, numbered 6, was discussed briefly and after a few language amendments was voted on with 17 for (including the United States), none against and 13 abstentions. Some of the abstentions were made only because the revision of Article 6 (old) had not been completed and one favorable vote with the same reservation.

In the General Committee session the new article was adopted with 35 voting for, none against, and 2 abstentions.

The new article provides, in the first paragraph, that the conditions for filing and registering trademarks are to be determined by the domestic law of each country. Paragraph 2 states that an application for registration cannot be refused, nor may a registration be cancelled, on the ground that filing, registration, or renewal was not effected in the country of origin. Paragraph 3 makes marks registered in different countries of the Union independent of each other.

Old Article 6 as ultimately revised became renumbered as Article 6 quinquies, but during the discussions it was referred to by its then existing number.

The Chairman opened the discussion on the revision of Article 6 by reviewing the subject, pointing out that its principle was that any

trademark registered in the country of origin could be registered in any other country of the Union without any objection being raised as to the form of the mark.

The first question was whether this principle should be maintained, Great Britain and Rhodesia having suggested the deletion of Article 6. This was put to a vote with the result of 27 for retention and 5 against.

The next question considered was whether to accept the proposal in the agenda draft to replace the word "trademark" in 6A by the word "sign". When put to a vote there were only 7 in favor of this change, with 22 opposed and 6 abstentions.

The Chairman then introduced 6B by raising the question of whether the restricted grounds for refusing registration authorized by subsection B applied generally or only to cases coming under subsection A. After some comment the Chairman instructed the Drafting Committee that the grounds for refusal listed in B were directed only to marks coming under A, and that for other marks the national law of the country should apply.

On the resumption of the discussion at the next session the first question considered was whether marks registered pursuant to subsection A should be independent of the mark in the home country. The United States member spoke in favor of independence while the Roumanian and Israeli delegates opposed this view. A vote resulted in 6 for independence, 7 against and 8 abstentions.

In view of the closeness of the vote the discussion was continued, with the German, Austrian and Belgian delegates speaking against dependence. The International Federation of Patent Agents observer urged that it was illogical to permit a person to retain a registration obtained on the basis of subsection A contrary to the national law of the country, if he had no registration in the country of origin, and suggested as a compromise that dependence should be for a period of five years.

A second vote resulted in 6 in favor of independence, 10 against and 8 abstentions. The Drafting Committee was instructed to draw up a text, considering the suggested compromise.

Discussion returned to subsection B with the question of whether the list of grounds of refusal was exhaustive or merely enumerative. It was stated that the existing text had been interpreted as restrictive (exhaustive) and that this could be made clear by adopting the wording "no marks shall be refused or canceled except * * *." Delegates from Germany, Belgium and the Netherlands supported the exhaustive view, which was opposed by the British and Australian delegates. The vote was 11 for the exhaustive view, 10 against, and 3 abstentions. It should be noted that the exhaustiveness contemplated was with respect to grounds of refusal going to the nature or form of the mark and not to the conditions for obtaining registrations under the domestic law of a country.

The next question taken up was whether the existing text of B should be retained or revision considered. The Italian and British delegate urged retaining the existing text. The vote was, 19 for maintaining the existing text, 4 against, 2 abstentions.

The addition of a fourth ground for refusal to the list in B, namely, when the mark constituted unfair competition under Article 10 bis,

had been proposed. This was opposed by the Belgian, Italian and United States delegates on the ground that this was not a proper matter for an administrative office to decide but should be left to the courts. The Swiss delegate pointed out that the clause should be added since the list was to be exhaustive.

The Chairman then proposed the addition of a clause to the effect that application of Article 10 bis was not affected. The United States and Italian delegates expressed approval of this suggestion. The vote was 23 in favor of omitting the proposed new ground, with the reservation, 1 against, 5 abstentions.

The second item of B permits refusing registration when the mark is not distinctive, and further states that in determining whether a mark is distinctive all the circumstances of the case must be taken into consideration, particularly the length of time the mark had been used. The question as to whether other circumstances should be enumerated, as proposed by the International Association for the Protection of Industrial Property, was discussed. The United States member supported this text which had been incorporated in the United States proposed revision of the article, but other countries, including Great Britain, opposed any change. The vote was 20 in favor of maintaining the existing text, 4 against, 2 abstentions. A vote was also taken on changing the introductory phrase to "In determining whether a mark is *eligible for protection*" (instead of *distinctive*), as proposed in the Preliminary Documents, with the result, 17 in favor, 4 against, 6 abstentions.

Existing subsection B (2), which stated in effect that registration could not be refused if the mark differed in immaterial respects from the mark in the home country, had been omitted from the proposal on the agenda. The Bureau representative explained the omission of this paragraph. Several delegates spoke in favor of retaining the paragraph, which was considered the sense of the Committee. (In the re-draft this paragraph became renumbered.)

With respect to subsections E and F, being considered as applying only to marks registered under subsection A, the Chairman declared that the Committee was in favor of their retention.

Subsection C, defining country of origin, was also passed on to the Drafting Committee, with a minor change in wording. (In the re-draft this subsection became renumbered.)

Before the discussion was closed the United States member made several suggestions for the Drafting Committee which, however, were not followed.

The Drafting Committee submitted a draft of revised Article 6, now numbered 6 quinquies (Doc. No. 81), which was considered at later sessions of the Committee. Several changes in language and arrangement were proposed, and the second and third sentences of 6A which had been omitted (presumably inadvertently) were restored. Revision of subsection A to make its meaning clearer was proposed but there was general disinclination to attempt any change in language. The question of dependence was again discussed. After a vote on a compromise to have dependency for five years showed 8 for, 4 against and 15 abstentions, the Chairman attempted to designate a subcommittee to work the matter out, but the delegates asked to serve were unwilling to do so.

The Drafting Committee produced another draft (Doc. No. 122). Apart from certain minor drafting changes, the only discussion which took place was on subsection D which made a foreign registration dependent on the home registration in Article 6 cases. Germany interpreted this provision as mandatory and proposed that the provision should be redrafted so as to make it discretionary with each country. After some discussion, with disagreement showing divergent views, the proposal was voted on. The result was 13 for the German proposal, 9 against and 6 abstentions. Whereupon the Chairman suggested that there was no chance of the German amendment being accepted and he ruled that it not be included in the draft.

Then the whole Article 6 quinquies (Doc. No. 122), subject to minor drafting changes, was put to vote. There were 19 in favor, none against, and 9 abstentions.

In the General Committee session the revised article was adopted with a vote of 32 in favor, none against and 5 abstentions (all British countries).

The net result of all the activity on Article 6 was very little change in the article itself, now Article 6 quinquies. The addition of the new article, numbered 6, however, is considered of great importance; first, it assures to American trademark owners the basic right to register their trademarks in the foreign countries which are members of the Union solely on the basis of complying with the same requirements which apply to the nationals of those countries, and second, its presence serves to place old Article 6 (now 6 quinquies) in its proper perspective and shows its actual narrow scope.

The only new matter requiring study from the standpoint of possible change in the United States statute is subsection D of new article 6 quinquies. The present trademark statute makes all United States trademark registrations by foreigners *independent* of registrations of the same mark in the country of origin. This was not required by the Convention, old Article 6D being so worded that registrations by foreigners effected under the principle of Article 6 could be made either dependent or independent. The wording of new subsection D and the remarks of some of the delegates would suggest that registrations must be made dependent. However, it is proposed that the principle that the Convention does not prevent a country from giving foreigners greater rights than it is required to give them be followed for the time being, and that no change be made in the statute at this time.

5. *Item XIII. Service Marks*

The subject of service marks was on the original agenda but with no particular proposal. The United States submitted a proposed new article, which was included in Volume 4 of the Preliminary Documents, reading as follows:

The countries of the Union undertake to permit the registration of and to protect trademarks used to designate services under substantially the same conditions as trademarks used to designate goods. The term "trademark", wherever used in this Convention, is to be understood as including trademarks for services as well as trademarks for goods.

The comments of the governments in this volume included opposition by Belgium, France, Netherlands, Rhodesia, South Africa and

Great Britain, mainly on the ground that the time was not yet ripe. On the other hand, ten countries expressed approval. Sweden also submitted a proposed text.

The Chairman opened the subject by summarizing the position as disclosed by the comments and observations of the various Governments and concluded that most countries desired to include a provision for the protection of service marks though some countries considered the matter premature and one country was definitely against it.

The Chairman pointed out that the Committee was confronted with two actual texts on the subject, the United States proposal and the Swedish proposal, and that there existed a slight difference between the two. Thereupon the Swedish delegate announced that on further study of the United States proposal, they were willing to withdraw theirs and support the latter.

The delegates for Great Britain and the Netherlands urged that since many countries did not yet protect service marks, the addition at this time was not desirable.

The observer for the International Federation of Patent Agents proposed a substitute which merely provided that if a country protected service marks then the term "trademarks" included trademarks for services as well as trademarks for goods.

The Italian delegate objected to the United States proposal because it would compel each country to protect and register service marks but proposed that registration and protection of service marks be included in Article 6A, so that if a service mark is registered in a country of origin then it must be accepted for registration and protection in another country, irrespective of whether or not the second country had changed its law to take care of the protection of service marks generally. The theory of this proposal was that if a country was obligated under the Convention to protect foreign service marks, there would be a desire in that country to protect native service marks.

The British point of view was that, while they could not object to the protection of service marks on logical grounds, they felt that, as most countries did not provide for their protection of service marks, the inclusion of a provision in the Convention requiring them to protect service marks would be a cause for delay in ratifying the Convention until their law was changed. Other delegates who voiced an opinion against the United States proposal also thought the matter premature.

Finally it was decided that the International Federation of Patent Agents and the Italian Delegation would submit their specific proposals so that a vote could then be taken on the three texts, the United States, the Italian and the third.

Discussion was resumed with three texts, the United States, the Italian (Doc. No. 46), and the International Federation of Patent Agents. The Netherlands delegate objected to the latter two and proposed a new text which was a revision of the first sentence of the United States text made by changing the last clause to read "according to the methods laid down by the domestic legislation of the country concerned" and hence would not compel service marks to be treated identically as trademarks. This was supported by the Belgian and German delegates, the latter also indicating that he would support the United States proposal. Several delegates spoke; the United States member reviewed the desirability of protecting service marks;

the German delegate proposed to amend the Netherlands text by deleting the reference to registration, which amendment was accepted by Netherlands and Belgium; the Italian delegate stated that he had been impressed by the remarks of the United States member and was now in favor of the Netherlands text.

The Chairman then put various questions to a vote with the following results:

1. On the first sentence of the United States text: 10 in favor, 9 against, 3 abstentions.

2. On the second sentence of the United States text: 14 in favor, 7 against, 2 abstentions.

3. On the Netherlands proposal as amended: 10 in favor, 6 against, 8 abstentions.

4. On the International Federation of Patent Agents' proposal: 6 in favor, 8 against, 7 abstentions.

5. On the Italian proposal: 12 in favor, 11 against, 4 abstentions.

The Israeli delegate proposed taking a vote on the addition of a reference to service marks to Article 1(2) which had been suggested by several of the speakers. The result was 18 in favor, 2 against, 5 abstentions.

The Drafting Committee submitted a report including the amendment to Article 1 and three alternative new articles, the United States text, the Netherlands text, and the Italian text. The Chairman announced that the Committee seemed agreed on the amendment to Article 1 and proposed that the Committee adopt the Netherlands text as the one most likely to be adopted. The Netherlands and Belgian delegates stated that they could go no further than this proposal and would oppose the other two.

The vote on the proposal was 21 in favor, 1 opposed (Australia), 4 abstentions (Austria, Great Britain, Indonesia, Ireland).

The text of the new article, to be numbered 6 *sexies*, as referred to the General Committee for action was:

The countries of the Union undertake to protect trademarks used to designate services according to the terms prescribed by their domestic legislation.

In the General Committee session, the amendment to Article 1(2) was adopted with 34 in favor and 4 abstentions.

The delegate from Australia announced that he must oppose the proposed new article, because it was ambiguous and contained the word "legislation" implying that it would be necessary to amend the national laws. He doubted whether, under their constitutional system, Parliament could legislate on the matter but pointed out that a certain amount of protection was possible without legislation. After indicating that it would be possible to amend the article to eliminate the objections, further action was deferred to a subsequent session.

The Swiss introduced a new text (Doc. No. 261) designed to eliminate Australia's objections. The Australian delegate thought this an improvement but proposed a further revision which was acceptable to the Swiss. After exchanges of views involving Australia, Canada, France, Netherlands, the United States, Turkey and Yugoslavia, and the suggestion of various changes, the Canadian delegate proposed an acceptable form of wording which was adopted by a vote of 35 in favor with 3 abstentions. (The General Drafting Committee broke the single sentence into two for the final text.)

6. *Item XIV. Well-Known Marks*

Article 6 bis deals with the situation in which a person in one country owns a trademark, and someone else registers or attempts to register the same or a similar trademark in a second country (in which the owner presumably does not have his mark registered). The owner in the first country is given the right to prevent the registration or have it cancelled if there is likelihood of confusion, provided the mark is considered in the second country to be well known as being the mark of the owner in the first country. A minimum period of three years is prescribed for seeking cancellation of the mark.

The revision of Article 6 bis in the agenda item proposed two changes:

1. The protection of well-known marks to be strengthened by prohibiting the use by others of such marks, in addition to prohibiting their registration.

2. Increasing the minimum period for seeking cancellation from 3 to 5 years.

In addition, two other amendments were subsequently proposed:

3. The addition of a provision declaring that the well-known marks need not have been actually used in the country where its protection under the article is claimed.

4. The addition of a definition of when a mark shall be considered as well known.

A further topic which was in part connected with Article 6 bis and in part considered as a separate subject (Item XX) was:

5. Exceptionally well-known or famous marks and their protection even with respect to dissimilar goods.

After the Chairman brought up the Item and a preliminary general discussion, consideration proceeded to the first point, prohibition of the use of the well-known mark.

The delegates from Netherlands, Rhodesia, Denmark, Belgium and Yugoslavia had stated their opposition. Sweden and Germany supported the proposal. The United States member asked whether the measures to prohibit use were to be taken by the Administration, or by action of the interested party in the courts, and the German delegate also asked for an answer to the same question. The Chairman indicated that action would be in the courts which would have jurisdiction by the usual procedure.

A vote was taken with the result: 21 in favor of the amendment, 5 opposed, no abstentions.

The second question, the extension to five years of the period recited in the article, now took on a different aspect since both cancellation of the registration and prohibition of use were involved and, on the suggestion of the British delegate, the question was divided. On the extension of the period for seeking cancellation the vote was: 21 in favor, 2 opposed, 2 abstentions.

The second part was put as: Should a period be stated for taking action against the use of a well-known mark? This was opposed by the British and Australian delegates on the ground that allowing a period of at least 5 years would interfere with the application of the principle of laches. The German delegate stated that a fixed period would be of advantage to an infringer starting to infringe in

a limited area. The question was then voted on with the result: 16 for not including a period, 7 in favor, 5 abstentions.

The third question was not on the original agenda but several countries, including the United States, had made proposals in their comments and observations that it should not be necessary that the well-known mark be used in the country where protection was claimed. After a brief discussion a vote was taken with the result: 13 in favor, 3 against, 5 abstentions.

The fourth question was not discussed and then the fifth question was taken up. Since this was the occasion of the greatest discussion and was in effect a consideration of the subject of Item XX, the outcome was separated from Article 6 bis; it is treated separately.

The Committee returned to Article 6 bis, at a subsequent meeting, with a draft incorporating the three amendments agreed upon, prepared by the Drafting Committee (Doc. No. 82). After a drafting change the Article was adopted with a vote of 21 in favor, none against and 6 abstentions.

The United States member explained that his affirmative vote was based on the view that a mark was to be deemed well known if it has been substantially used in the country where protection was sought, or has been made known to the trade or general public in that country by local or foreign advertising or by any other means of publicity.

When the article came up for action in the General Committee, the Australian delegate announced that he could not agree to the last sentence of the first paragraph, providing that it was not necessary for the well-known mark to have been used in the country where protection is claimed. A vote first was taken on the article omitting this sentence with the result of 36 in favor, none against, and 2 abstentions. A second vote on the article including this sentence resulted in its defeat by a vote of 29 in favor, 2 against (Australia and Brazil) and 7 abstentions.

No amendment to United States statutes is considered necessary. The article is considered satisfied by the existing remedies of a trademark owner against an infringer, including sections 43 and 44(h) of the Trademark Act (15 U.S.C. 1125, 1126h). The period for seeking cancellation of a trademark registration is already 5 years, with no limit in case of fraud (15 U.S.C. 1064) and no change is necessary in this respect.

7. *Item XX. Famous Marks*

Item XX on the original agenda brought up the subject of famous marks, but contained no specific proposals and recommended against any special provision. A number of countries disagreed and made proposals either as part of the revision of Article 6 bis (Item XIV) or otherwise. The United States agreed with the Bureau, but proposed an added paragraph to Article 6 bis to the effect that the protection of Article 6 bis should extend to dissimilar goods, provided that the mark, as a result of its uniqueness and celebrity, has become so well known as to induce members of the trade or the general public to assume that there may be a connection in trade between the second registrant or user on the dissimilar goods and the owner of the well-known mark. Other proposals with respect to use on dissimilar goods were not so restricted and even included the concept of dilution of trademarks.

The discussion of this subject started as part of the discussion of Item XIV when the question of the protection of well-known marks against use on dissimilar goods was raised. There was considerable discussion, first with respect to the proper place for such a provision with three alternatives, (1) to include it as a part of Article 6 bis, (2) to include it as a part of Article 10 bis, dealing with unfair competition, and (3) to draft a separate article. After a preliminary discussion showing varying points of view and a summarization by the Chairman, further discussion was deferred to the next meeting when specific texts would have been presented.

Discussion was resumed with the following texts having been submitted.

1. A proposal by Japan to amend Article 10 bis (3) defining unfair competition, to replace the words "of a competitor" by the words "of another", so as to explicitly broaden the concept of unfair competition (Doc. No. 61).

2. A proposal by the Netherlands to add a fourth paragraph to Article 10 bis prohibiting as an act of unfair competition the registration and use of a well-known mark or name belonging to another, even if the industrial or commercial activities are neither identical or similar (Doc. No. 62).

3. The United States proposal to add the provision which has already been described (Doc. No. 78).

4. A proposal by Portugal to add a paragraph to Article 6 bis, similar to the limited United States proposal, providing that the protection under the article extended "even to unidentical or dissimilar products, where there is any possibility that the public may be falsely led to believe (in any way whatsoever) that the original owner of the trademark has any connection with the production or sales of the new product" (Doc. No. 63).

5. A proposal by Sweden to add a paragraph to Article 6 bis to the effect that the protection under this article shall apply "in respect of goods which are not identical or similar if there is a possibility of confusion, of unjustified advantage or of effective weakening of the distinctive character of the mark or its attraction" (Preliminary Documents, Vol. 4, this was also the proposal of the International Association for the Protection of Industrial Property at its Brussels 1954 meeting).

6. A proposal by the Union des Fabricants and the League Against Unfair Competition for a new article similar in terms to the Swedish proposal but with the added sentence that the provision extended to trade names, signs and slogans.

The Italian delegate, concurred with by the Yugoslav, opposed the principle and, in particular, the Netherlands and Union des Fabricants proposals. The British and Israeli delegates supported the Japanese proposal, the latter suggesting a further amendment. The United States member spoke against the Union des Fabricants proposal as going too far, particularly in the extension to trade names, signs and slogans, but did not oppose the idea of a separate article. After further discussion, the Chairman put various questions to vote with the following results:

1. Should specific provision be made for protection against use of a mark on different products? Yes: 20; No: 3; Abstentions: 3.

2. Should the provision be in Article 6 bis? Yes: 6; No: 16; Abstentions: 6.

3. Should the provision be in Article 10 bis? Yes: 6; No: 10; Abstentions: 9.

The Committee having decided in favor of a separate article, the Chairman called for a vote on two proposals:

(a) The Netherlands proposal: 6 in favor, 4 opposed, 11 abstentions.

(b) The common part of the Swedish and Union des Fabricants proposals: 10 in favor, 4 against, 11 abstentions.

Then a vote was taken on the balance of the Union des Fabricants proposal:

(a) Extension to trade names: 16 in favor, 1 against, 11 abstentions.

(b) Extension to shop signs: None in favor.

(c) Extension to slogans: 1 in favor, 18 against, 17 abstentions.

A final vote on the Japanese proposal showed 11 in favor, 3 opposed, and 12 abstentions.

The matter was then turned over to the Drafting Committee.

The Drafting Committee introduced (Doc. No. 107) a text of an amendment to Article 10 bis eliminating the necessity for competition (the Japanese proposal) and three alternative suggestions for a new article:

(a) Prohibition of the use of a famous mark or trade name even in relation to non-identical or dissimilar industrial or commercial activities, without any limitation.

(b) Applying the protection of Article 6 bis to non-identical or dissimilar products if there is likelihood of confusion, unjustified advantage, or a weakening of the distinctive character of powers of attraction of the mark, extended to include trade names.

(c) A compromise proposal of the Drafting Committee similar to (b) but limited to famous trademarks or trade names.

The Chairman stated that the Committee had already agreed on the Japanese proposal and did not call it up for vote. The Israeli delegate stated that they would vote against the amendment.

Discussion proceeded on the three texts of the proposed new article. The British delegate opposed the texts. The Austrian delegate was opposed to the principle. The United States member spoke against the texts as they introduced criteria which were too vague and not well known. He called attention to the United States proposal as preferable since it was limited to the possibility of confusion as to origin or relationship. The Italian delegate stated that they were opposed to the second and third texts but they were prepared to accept the substance of the United States proposal if the opening was replaced by the language of the first text.

The meeting was suspended for the preparation of a joint text by the United States and Italy and resumed when this was distributed (Doc. No. 173).

The Yugoslav and Austrian delegates declared that they were opposed to any provision concerning famous marks. The Belgian delegate objected to the text. After further discussion the proposition was submitted to a vote with 18 voting in favor, 3 against (Austria, Belgium, Yugoslavia) and 6 abstentions.

The Chairman ruled that since certain delegates were categorically opposed to the proposal, it would not be sent to the General Committee.

Subsequently the amendment to Article 10 bis was taken up for vote and separated into two. The vote on the basic change was 9 in favor, 2 against and 15 abstentions, but the Chairman again ruled that there would be no purpose in sending the text to the General Committee.

8. *Item XVI. Assignment of Trademarks*

The proposed revision of Article 6 quater would require the countries to permit the free assignment of trademarks, that is, to permit trademarks to be assigned without either the business or the goodwill of the business in which it is used.

The Chairman opened the discussion by pointing out that the countries fell into two groups, those which permitted free assignment and those which permitted only assignment of a mark along with the goodwill of the business. He said that, however, similar results could be achieved in each class of country. Article 6 quater (which permits a country to do either) made the requirement for assignment along with the goodwill more flexible, but the proposal would require free assignments.

The Yugoslavian and Italian delegates opposed the proposition, the former on the grounds that it was against the interests of the consumer and contrary to the very principle of trademarks. The United States member spoke against the proposal and stated that, while he was prepared to submit a new text (which would still permit a country to require transfer of the goodwill), he would be willing to accept the proposed text with the reference to the "goodwill" deleted therefrom, which would leave a country free to require assignment of the goodwill if it so chose. The delegate for Germany supported this suggestion. The British delegate supported the Bureau proposal. He admitted that the French phrase "*fonds de commerce*" was difficult to translate, though "goodwill" was the nearest equivalent. The delegates from Denmark and Iran also supported the proposal.

The Chairman called for a vote on the text with the United States suggestion to delete the reference to "goodwill," with the result: 10 in favor, 4 against, 14 abstentions.

At the request of the French delegate, the unamended text was put to a vote with 10 in favor, 9 against, and 9 abstentions.

The matter was thereupon referred to the Drafting Committee which introduced two texts, one a drafting revision of the Bureau text and the second the same with the omission of reference to "goodwill" (Doc. No. 104A). The Chairman proposed consideration of the second only, as the only one likely to be adopted. After a minor amendment and some discussion, this was put to a vote with 29 voting in favor, 5 against (Germany, Bulgaria, Italy, Czechoslovakia, Yugoslavia) and 3 abstentions.

The Chairman stated that, in view of the negative votes, there would be no object in sending the proposal to the General Committee and concluded that it be dropped.

9. *Item XVII. Registration of a Trademark by an Agent*

A proposed new article under this Item provided that, if the agent or representative of the owner of a trademark applied for registra-

tion in another country without the authority of the owner, or when such authority previously granted had been withdrawn, the owner has the right to oppose the registration, or have it cancelled or transferred to him if a registration has been obtained. A second paragraph further provided that the representative or agent could not validly use a mark against the wishes of the owner.

In the comments and observations Belgium proposed a time limit of three years; the United States proposed adding "or customers" after "agent"; the International Association for the Protection of Industrial Property suggested a revised wording of the article; Czechoslovakia proposed to strengthen the article by requiring that any authority should be in writing.

After the discussion opened it was pointed out that the article concerned relations between an agent and his principal and that such relations were matters of contract governed by civil law. The United States member agreed but urged that the proposal was desirable because of the frequent cases of dishonest registration. This view was supported by delegates of the Netherlands, Belgium, Hungary, Czechoslovakia and Germany. The British, Australian and Swedish delegates also supported the principle but made some proposals as to details. The phraseology of the Bureau and International Association for the Protection of Industrial Property texts was discussed. The only delegate speaking wholly in opposition was from Japan.

The Chairman then put a number of questions to a vote.

1. On the principle of including an article on the subject in the Convention: 28 in favor, 1 against (Japan), no abstentions.

2. On requiring authorization for an agent to register: 28 in favor, none against, 1 abstention.

3. On whether authorization should be required to be in writing (the Czechoslovakian proposal, Doc. No. 96): 6 in favor, 10 against, 12 abstentions.

4. On whether the reference to withdrawal of authorization should be retained (the British delegate had proposed its removal, during the discussion): 5 in favor, 18 against, 7 abstentions.

On two changes the consensus was in favor, without a vote being taken, namely that the text should apply to registration obtained by an agent in any country including the country of the owner, as proposed by the observer for the International Federation of Patent Agents, and the Swedish proposal that the text be flexible enough to allow a court to take into account special circumstances which might justify the agent's action.

The Belgian proposal to specify a time limit for the owner to take action was then discussed with the result (without vote) that there should be no time limit specified, but that the text should not exclude the right of a country to fix one.

The United States suggestion to include a reference to customers was then adopted with a vote of 18 in favor, 1 against, 10 abstentions.

The Drafting Committee text thereafter prepared (Doc. No. 105) was discussed at a subsequent meeting. On objection to the inclusion of the word "customer" as not being clear or necessary, the word was withdrawn. A paragraph 4 specifying that Article 6 bis was still applicable to well-known marks was also withdrawn on objection by Israel and explanation by the Chairman that Article 6 bis would in

any case still be applicable. The United States member objected to the wording of the clause embodying the Swedish proposal, but, on the statement of the Chairman that agreement would not be likely without the clause, the objection was withdrawn.

The article as amended was voted on with 24 in favor, 1 against and 2 abstentions. The negative vote was by Japan and, at the request of the Chairman, the Japanese delegate explained that his delegation was unanimously opposed to the proposal but that, in view of the almost unanimous desire for it, they would refer the matter to their government for instructions.

When the proposal came up for action in the General Committee the Japanese delegate announced that they had decided to withdraw their objection and the new article, numbered 6 septies, was adopted with 33 votes in favor and 5 abstentions.

10. Item XVIII. Nature of Product Covered by Trademark

Article 7 provides simply that the nature of the goods on which a trademark is used cannot form an obstacle to the registration of the mark. Two proposals were suggested for consideration in the Preliminary Documents. One was the recommendation of the International Association for the Protection of Industrial Property at its Washington 1956 meeting to:

(1) Insert the words "or renewal" after registration.

(2) Add a paragraph stating that the exclusive right in the owner to use the mark shall not be suppressed or limited when the sale of the goods on which it is used is legal.

The other was a suggestion by the Bureau to:

(3) Add language to the effect that the article applies even if the production or sale of the goods is a state monopoly or if the production or sale is restricted.

The purpose of these suggestions was in part aimed at laws which would make a trademark lose its status as a trademark after a certain period or after expiration of the original registration, such as the Danish pharmaceutical law of 1955.

Considerable discussion took place on these proposals. There seemed to be general agreement on adding the words "or renewal" but there was diversity of opinion with regard to the others, and also some confusion. As a result the Chairman appointed a subcommittee to prepare a new text, taking the record proposals and the discussion into consideration. This subcommittee consisted of Holland (chairman), Italy, Australia, Switzerland, and the United States.

The subcommittee draft (Doc. No. 128) embodied the first and third of the points enumerated above. After discussion of the text and of various amendments, with the adoption of only a drafting amendment, the proposal was put to a vote. The result was 16 in favor, 1 against (Denmark), and 11 abstentions.

In the session of the General Committee the Danish delegate announced that they could not support the proposal because his government wished to reserve the right to make regulations governing marks for chemical products. The vote was 23 in favor, 1 against (Denmark), 12 abstentions, and the proposition was defeated.

11. *New Item. Translation of Trademarks*

The Preliminary Documents, Vol. 4, contained similar recommendations of the International Association for the Protection of Industrial Property and the International Chamber of Commerce for a new article providing that a trademark could be registered both in the language of the country of origin and in translation into other languages, in a single registration, with each form being protected separately.

The United States member called this proposal up for action and spoke in its favor. Where a manufacturer was forced to use a translation of his mark in some countries, it would be an advantage to have both in a single registration.

The observer for the International Federation of Patent Agents suggested that the proposal be broadened to include transliterations of the mark to allow for different types of writing.

Considerable discussion was had, with some countries, such as Great Britain, taking the position that the matter was not ripe for action. Others discussed the question not only of translation of the trademark but also the transliteration or phonetic rendering of the mark in the foreign language. The question was also raised concerning different scripts and also in regard to pictorial illustrations corresponding to a word and vice versa.

The German delegate seemed to put the things in the right manner by suggesting that this did not involve so much a question of priority or infringement but rather the right of an applicant who applies in a foreign country to add to his mark the foreign transliteration or translation.

The United States member agreed that this was the correct position, and also stated that the object was a practical one of meeting requirements of foreign laws against variation of registered marks or user requirements which made it a practical necessity for the applicant to indicate, at the time of application, that he might use the mark in the foreign translation or transliteration of the original form.

The Chairman then put to vote the proposition of whether the subject should be deferred to the next Conference of Revision or be dealt with at this time, dividing the question in two parts. On postponing the question of translation the vote was: 13 against and 11 for postponement. On the question of transliteration there were 16 votes against postponement, 10 in favor, and 2 abstentions.

The next question raised was whether the matter should be sent to a subcommittee to draft an appropriate text. This was approved and the Chairman appointed a subcommittee consisting of: United States (Chairman), Germany, Canada, Yugoslavia, Belgium, and Italy.

The subcommittee submitted a draft (Doc. No. 133) on which considerable discussion took place, some to the effect that the question was not ripe and had not yet been thoroughly discussed and some recording the interpretation which they gave to the text of the proposal. A vote on the first sentence (translations) resulted in 14 in favor, 8 against, and 7 abstentions. A vote on the second sentence (transliterations) resulted in 14 in favor, 6 against and 8 abstentions.

The Chairman stated that the opposition was such that he did not feel there was any chance of those voting against changing their position, and he concluded that the matter should not be sent to the General Committee. There was no disagreement with this conclusion.

12. *New Item. International Search Center*

The International Bureau (Doc. No. 2) submitted a proposal for a resolution to the effect that the Bureau should continue the studies undertaken with a view toward creating an International Center for making searches to determine if a trademark had been anticipated. The report of a second meeting, held in June 1958, of a Committee of Experts on the subject was attached to the proposal.

The delegate for Czechoslovakia stated that a universal center of this kind could not be set up for a long time and would be very costly. He proposed regional centers for groups of countries and his proposal, when later submitted in writing, called for 11 centers scattered throughout the world.

The British delegate doubted the possibility of creating such a center and suggested as an alternative that each country should agree to supply the necessary information as to whether a mark had been registered, to individual applicants. The Netherlands delegate agreed. The Swedish delegate doubted the usefulness of the project. The United States member expressed the view that if the project were approached in a modest manner, it could result in something useful. The delegates were requested to submit their proposals in writing.

When the subject was resumed at the last session of the Committee, the Czechoslovakian delegate stated that its proposal was only a suggestion for the Bureau. Only two proposals were hence up for action, one submitted by the British (Doc. No. 102) and one by the Swiss (Doc. No. 156).

The Swiss proposal was a revision of the Bureau proposal resolving that it continue the studies already undertaken. No action was taken on it and only one delegate supported it. The German delegate stated that it was beyond the jurisdiction of Committee III which did not know whether the Bureau had the necessary funds.

The British delegate said it was Utopian to hope to establish an international search center and even disagreed with the United States member's suggestion for a small scale project. He urged their proposal as more realistic. This proposal (as revised during the discussion) was that the Conference express the wish that each of the countries of the Union shall consider the means whereby facilities may be provided through official or private organizations to enable a person to be informed whether a mark is already registered in that country in respect of any specified goods.

The British position was supported by the delegates for the Netherlands and Germany and others agreed, with several modifications being suggested.

The vote on the British proposal was 10 in favor, none against, and 17 abstentions (including the United States) and the matter was referred to the Drafting Committee to prepare the final text.

The resolution was adopted in the General Committee with a vote of 28 in favor, none against, and 8 abstentions.

The United States already has a public Trademark Search Room in the Patent Office, and private trademark search organizations are also in operation.

E. COMMITTEE IV, UNFAIR COMPETITION

Committee IV had assigned to it only one item of the original agenda concerning a revision of the Convention, Item XIX. It also had Item B, concerning revision of the Arrangement of Madrid on False Indications of Origin, and Item E proposing a new Arrangement for the Protection of Appellations of Origin. The Committee held seven meetings. Messrs. Ladas and Federico, in turn, attended some of the meetings.

1. *Item XIX. False Indications of Origin*

Paragraph 1 of Article 10 of the Convention provides that the provisions of Article 9 (prohibiting importation of goods illegally bearing a trademark of trade name) shall also apply in the case of goods which falsely bear, as indication of origin, the name of a specified country or locality when such indication is joined to a trade name of a fictitious character or used with fraudulent intent. The proposed revision of this paragraph made two important changes, first, the restriction to being joined to a fictitious trade name was eliminated, and second, the provision was extended to include not only false indications of origin but also false indications of the identity of the producer, manufacturer or trader. In addition the words "or misleading" were also added after "false", and the reference to fraudulent intent omitted.

The second paragraph of the article names various classes of parties as interested persons in the case of indications of origin. The proposal would cancel this paragraph.

The Swedish delegate proposed that the revision should be inserted in Article 10 bis as a more appropriate place.

The Israeli delegate stated that Article 10 as it stood, and as proposed to be revised, depended upon Article 9 and hence was limited to importation. He proposed a new article with a first paragraph giving protection generally and a second paragraph referring to Article 9. This was supported by the German and Austrian delegates. The delegate for Netherlands opposed, and supported the Bureau proposal. Discussion continued on the two texts and on language used, with the delegates of ten countries speaking. Some favored the Bureau text, some the Israeli suggestion, and some desired the words "any direct or indirect use" and "or misleading" to be inserted or retained.

The Swiss had made a proposal revising the first paragraph to refer only to "a name or a sign which directly or indirectly conveys a false or misleading indication of the origin of the product, even where such indication contains such terms as 'type', 'kind', 'nature', or 'imitation'". This was put forward by the Swiss delegate and opposed by the Canadian, Swedish, Austrian and British delegates. The German delegate suggested that a vote be first taken on the Swiss proposal, which was lost with a vote of 7 in favor, 8 against and 3 abstentions (the United States did not vote).

The Committee then voted to set up a subcommittee, and proceeded to consider the deletion of the second paragraph. A vote was taken with 5 in favor of deleting, 10 opposed, and 5 abstentions.

At the next meeting the Committee considered the draft of paragraph 1 which had been submitted by the subcommittee (Doc. No. 126). This was a revision of the Bureau proposal reading simply :

The provisions of the preceding article shall apply to any use, whether direct or indirect, of a false or misleading indication of the origin of the goods or of the identity of the producer, manufacturer or trader.

The Chairman of the subcommittee explained that the extension to all possible legal remedies was not considered necessary and called attention to Article 10 *ter*. Most of the delegates who spoke approved the text. A vote was taken with the result of 19 in favor (including the United States), none against, and 8 abstentions.

The Italian delegation had submitted a simplified version of the second paragraph (Doc. No. 123) which was opposed by Germany and supported by Czechoslovakia and Portugal, with France suggesting a compromise. The British, supported by Israel, again brought up the question of deleting the second paragraph. This was voted on again with 9 in favor of deletion, 18 opposed (including the United States) and 4 abstentions.

The French delegate then proposed retaining the existing text of the second paragraph with the addition of the words "or misleading" where necessary to be in keeping with the revised first paragraph, which was supported by the Italian delegate (thus showing that their own proposal had been dropped). The vote retaining the paragraph, so amended was: 25 in favor, none against and 5 abstentions.

Another vote was taken on an amendment proposed by the Czechoslovakian delegate, to change the last words "interested party" to "interested or injured party", which was lost with 4 votes in favor, 8 against and 17 abstentions.

When the revised article came up before the General Committee, discussion was adjourned to a subsequent meeting in view of difficulties which had arisen. When taken up, the Swiss delegate first made a drafting suggestion which was left to the General Drafting Committee. The delegate from the Union of South Africa then stated that they could not accept the words "or misleading" which appeared in the two paragraphs. On the suggestion of the delegate from Canada, supported by the Belgian delegate, the Chairman took votes with and without the words objected to :

1. On the text of paragraph 1 as submitted; 28 in favor (including the United States), 1 against (Union of South Africa), 10 abstentions.

2. On paragraph 1 with the words "or misleading" deleted; 23 in favor (including the United States), none against, 16 abstentions.

3. On paragraph 2 as submitted; 25 in favor (including the United States), 1 against (Union of South Africa), 13 abstentions.

As the deletion of the words in question left paragraph 2 identical with the existing text a second vote on this paragraph was not taken.

No change in United States laws is necessary in view of the revised article, as sections 42 and 43 of the Trademark Act (15 U.S.C. 1124 and 1125) cover this subject.

2. *New Item. Unfair Competition Article*

Article 10 bis assures persons entitled to the benefits of the Convention protection against unfair competition; paragraph 2 broadly defines unfair competition and paragraph 3 contains two subparagraphs listing various illustrative acts of unfair competition which are prohibited. Austria had suggested in its comments and observations (Preliminary Documents, Vol. 4) the addition of a third subparagraph listing certain other acts. The delegate from Austria brought this up at the beginning of the discussion on Item XIX, was supported by a few other countries, and the proposal was alluded to several times during the course of the consideration of XIX. The subcommittee referred to under Item XIX submitted a text of this proposal (Doc. No. 142) which as subsequently revised by the Drafting Committee (Doc. No. 161) read as follows:

(iii) The use, in the course of trade, of indications or allegations likely to mislead the public on the nature, including the manufacturing process, the origin, the characteristics, the suitability for their purpose of the quantity of the goods.

Although the delegates for Belgium and the Netherlands questioned the necessity for this addition, there was very little discussion before it was adopted by a vote of 15 in favor, none against, 11 abstentions (including the United States).

When the proposition came up before the General Committee, the United States member expressed opposition to the addition of the subparagraph; since other articles and arrangements dealt with the subject, it was not thought to have been given sufficient consideration, and would only lead to unnecessary misunderstanding. He stated that there would be no objection to the paragraph without the words "the origin", and suggested a separate vote on the text without these words. Section 43 of the United States Trademark Act (15 U.S.C. 1125) prohibits false designations of origin and false descriptions and representations, but nevertheless the objection to including these words lay in the confusion with other provisions and the interpretation intended by some countries. The Australian delegate agreed with the United States position. The vote was:

1. On the text as submitted; 24 in favor, 1 against (the United States), 14 abstentions (including Australia).

2. On the text with "the origin" deleted; 17 in favor, none against, 22 abstentions.

Although the Australian delegate agreed with the United States position it merely abstained, relying on the United States negative vote.

No change in United States laws is necessary by reason of the added subparagraph.

3. *New Item. Amendment of Article 1*

Paragraph 2 of Article 1 lists the various items included under industrial property, the list ending " * * *, trademarks, trade names, and indications of origin or appellations of origin, and the repression of unfair competition." A supplementary proposal of the Bureau, not distributed until the beginning of the Conference (Preliminary Documents, Vol. 1, part 4) proposed to substitute for the word "or", which implied that the two things connected by it were synonymous, the word "and" to show that they were different.

The Swedish delegate considered that the distinction between the two expressions, which were unknown in many countries, was not clear and opposed the proposal. The delegate from Israel agreed. Other delegates thought the distinction was clear.

The German delegate also stated that the difference was not clear to them, he suggested that "appellations or origin" seemed to be a special case of "indications of origin" and stated he would prefer the word "including" to "and". The Austrian delegate agreed with one being a special case of the other, and with this proposal. The delegate of Portugal regretted that some countries could not understand "appellations of origin" and stated he could support the last suggestion. The German proposal was also favored by the Hungarian, United States and Swiss delegates. The Spanish delegate pointed out that the Bureau amendment would raise no difficulties in those countries which made no distinction since it carried no obligation. The German delegate pointed out that if the Bureau amendment were adopted, Article 10 (which referred to indications of origin only) would no longer apply to appellations of origin.

A vote was taken on the German proposal to use the word "including", which was adopted by the Committee by a vote of 19 in favor (including the United States), none against, and 8 abstentions (including the Union of South Africa).

In the General Committee session the delegate from the Union of South Africa announced that he had instructions to oppose the amendment, and it was lost by a vote of 22 in favor, 1 against, 15 abstentions.

4. *Item B. Arrangement of Madrid for the Prevention of False Indications of Origin*

The Committee spent two whole sessions and parts of two others in considering the revision of this Arrangement. The United States delegation did not participate nor did any of its members attend any of these sessions.

5. *Item E. New Arrangement on the Protection of Appellations of Origin and their International Registration*

The Committee spent two whole sessions in considering this new Arrangement. The United States delegation did not participate nor did any of its members attend any of these sessions.

F. COMMITTEE I, GENERAL MATTERS

Committee I was charged with the proposals of a general nature, not relating specifically to any particular technical subject, mainly administrative and general treaty provisions, with the addition of the item dealing with state emblems.

The Bureau had submitted a paper on plant patents (Doc. No. 77) and the schedule of topics distributed on opening day listed this subject as being on the agenda of Committee I. However, there was no proposal and no country had submitted any and it was later announced that the subject was not on the agenda. The subject of ownership of patents by intergovernmental organizations, brought up in the letter from the Secretary General of the United Nations referred to in the next section, was also referred to Committee I, but it was not considered for lack of time. Subsequently, on October 24, 1958, the Director of the Bureau addressed a letter (Doc. No. 271) to the

Secretary General of the United Nations stating that the Conference did not think it was able, at that stage, to work out a provision. The reason given was that the administrative committee had not been able to submit the proposition to the countries in time for the required study. The Director further stated that the matter would be referred to a study group of representatives of the secretariats of a number of intergovernmental organizations.

Committee I held eight sessions, not counting meetings of sub-committees and special meetings of heads of delegations called to discuss organizational and other matters. Messrs. Dixon and Metzger attended all the meetings and participated in the work of the Committee; Mr. Federico attended and participated in sessions considering Item XV, and Mr. Watson attended and participated in sessions dealing with some other matters.

1. *Item XV. Protection of State Emblems, etc.*

The first subject taken up by Committee I was Item XV, proposing a revision of the first paragraph of Article 6 ter of the Convention. This paragraph provides that the countries agree to refuse to register or to cancel the registration, and to prohibit the use, as trademarks or elements of trademarks, armorial bearings, flags and other state emblems of the countries of the Union, and official signs and hall-marks adopted by them indicating control or warranty. This protection is to extend to "all imitations thereof from a heraldic point of view", and when the registration or use is "without authorization by the competent authorities."

The proposal made four changes in this paragraph:

1. Deletion of the words "from a heraldic point of view" and expressing the protection as applying to "any imitations thereof."

2. Omission of the reference to official signs and hall-marks adopted by the countries to indicate control or warranty.

3. Omission of the phrase "without authorization by the component authorities."

4. Extending the protection by adding the phrase "or otherwise as distinctive signs of goods or as shop signs or any other means of advertisement in any form," to the prohibition.

The Chairman introduced the subject and outlined the four points mentioned above.

The United States member spoke in opposition to the deletion of the words "from an heraldic point of view" as unduly broadening a provision already possibly too broad. He stated that such a large number of animals, flowers, and common objects (giving examples) were used in state emblems and armorial bearings that it would be impossible to apply the enlarged provision and would introduce complications in the consideration of a large number of proper trademarks. On the second point he suggested that it might be an advantageous change, pointing out that in the United States such marks could be registered as certification marks in the same manner as trademarks. He also spoke against the fourth point, considering it too broad; there were some proper uses of state emblems, etc., and use which would create deception or confusion was prohibited by other provisions. It was also pointed out that the provision would be difficult to apply in a country with separation of many federal and local matters.

The British delegate agreed with the United States on the fourth point, stating that it would be a mistake to cover too many subjects, and the delegates from Australia, New Zealand and Japan concurred. The delegate from Rhodesia stated he was opposed to any of the amendments.

On the second point, deletion of the reference to official control and warranty marks, the French, Irish, Belgian, Japanese and Italian delegates indicated that the phrase should be retained. They also indicated that the reference to authorization also should be retained.

The British delegate disagreed with the United States delegate on the first point, stating that the words "from an heraldic point of view" should be deleted as they were likely to be misunderstood. The delegates from Australia, Japan, Yugoslavia and Switzerland also supported the deletion. The French delegate stated that it might be useful to retain the phrase but to add the word "particularly" so that it would read "any imitation thereof, particularly from an heraldic point of view," which was agreed to by Belgium, Canada and Italy.

The following votes were then taken:

1. On restoration of the phrase referring to authorization: 19 in favor (including the United States), 6 against.
2. On restoration of the reference to official signs and hall-marks: 22 in favor, 1 against (the United States).
3. On deleting the extension to shop signs and advertisements: 11 in favor (including the United States), 1 against.
4. On the French proposal to insert the word "particularly": 12 in favor, 5 against (including the United States).
5. On deleting the phrase "from an heraldic point of view": 8 in favor, 5 against (including the United States).

The Chairman announced that as a result of the vote the original text of the paragraph was retained with the exception of the changes relating to the word "heraldic" which would be referred to the General Committee.

A second phase of the revision of Article 6 ter concerned a proposal by the United Nations. The Secretary General of the United Nations addressed a letter, dated August 18, 1958, to the Director of the International Bureau suggesting the adoption of a provision protecting the flags, emblems, names and abbreviations of the United Nations, the Specialized Agencies and the International Agency for Atomic Energy, which letter had been communicated to the countries of the Union.

The Bureau submitted a specific proposal taking the form of an added subparagraph (b) to paragraph (1) (now becoming subparagraph (a)) of Article 6 ter stating that the provisions of subparagraph (a) applied equally to armorial bearings, flags and other emblems, abbreviations or titles of intergovernmental organizations comprising one or more countries of the Union, together with the necessary consequential additions to some of the following paragraphs.

Although the matter had been scheduled for a specific later date, the Chairman brought it up on conclusion of the first day's discussion of Article 6 ter. Very few of the countries were prepared to say anything and the matter had to be handled on an extempore basis. The United States member spoke on the proposition. He stated that the position of the United States was opposed to the change which had

already been made in the first subparagraph of Article 6 ter and that this opposition was such that it would carry opposition to the entire paragraph. Nevertheless, he stated that the United States was in favor of developing a proposition to protect the emblems of such organizations as the United Nations; the principle was approved, but there were three points of detail which needed to be raised. The first of these was that there were already in existence treaties protecting the emblems of particular organizations. If these new provisions were adopted, there would be the two treaties relating to the same organization and the same emblems, which would introduce confusion, especially since other treaties have carefully worked out details. It was suggested that the paragraph be amended to exclude from its scope emblems of organizations in respect to which treaties were already in existence. The second point made was concerned with the fact that there were many symbols and abbreviations in existence and that the subparagraph should be limited to prohibiting such use as was deceptive. The third point raised by the United States member was that there should be a cut-off date since it was contrary to principle to enact legislation which would be retroactive in operation.

The Chairman asked whether these "proposals" had been made in writing and it was explained that the subject had come up unexpectedly and there had been no opportunity to prepare anything and that they were not intended as proposals. The Chairman then requested that the United States delegation submit suggestions in writing.

United States members met with the representative of UNESCO and together prepared an addition to the proposal (Doc. No. 71), which would accomplish the following three objectives:

1. The proposal is not to apply when the international organization already has some protection for its emblems by treaty or other international provision.

2. The proposal is to apply only when the use of the emblem, initials, names, etc., is such that the organization would be normally identified by it and there would be deception of the public.

3. A sentence was added preventing the proposal from operating in any manner to the prejudice of rights bona fide acquired before it comes into effect in a particular country.

The added part to the proposal was discussed briefly, with no objection to its substance being raised and a language suggestion being made. A vote was taken on the addition with the result: 12 in favor, none against, 17 abstentions. A vote was then taken on the whole of the new subparagraphs with 19 in favor, none against, and 1 abstention (Great Britain), but 9 countries did not vote. This matter was thereupon referred to the Drafting Committee. In the Drafting Committee text the proposal became subparagraphs (b) and (c) of paragraph 1.

Paragraphs (3) and (4) of Article 6 ter require, for the application of paragraph (1), a transmittal procedure whereby the countries communicate lists of their state emblems, etc., to the Bureau, which in turn transmits them to the individual countries, who are given a period of twelve months to forward objections.

The Italians had submitted a proposal to eliminate this requirement in the case of internationally recognized flags of states and international organizations, and this was now taken up. Considerable

discussion followed as to whether the waiver of communication should apply to the flags of international organizations, many urging that it should not, after which the Italians limited their proposal to state flags. The Chairman put the text as thus amended, and also with the words "internationally recognized", to a vote with the result of 24 in favor, none against, and 5 abstentions.

The question then arose as to who should make the communication in the case of international organizations, whether it should be done through a Union country or by the organization itself directly to the Bureau. The question was voted on with the result of 18 in favor of direct communication, none against, and 10 abstentions.

Paragraph 6 of Article 6 *ter* provides that in the case of emblems which are not well known, and official signs and hall-marks, the provisions (of paragraph 1 *et seq.*) are only applicable to marks registered more than two months after the receipt of the communication provided for in paragraph 3. The Germans had proposed an amendment (Doc. No. 58) to add the emblems etc. of international organizations to this paragraph, which had been only briefly alluded to in the preceding discussion. This proposal was now voted on with the result of 26 in favor, none against, and 1 abstention.

The Drafting Committee submitted a text of the whole Article (Doc. No. 124) which was referred back for correction and a new draft submitted (Doc. No. 183). This was considered at two sessions of the Committee.

The United States member again raised objection to the elimination of the words "from an heraldic point of view" from 1(a), but the Chairman ruled that further action should be taken at the General Committee meeting.

The Austrian delegate proposed that the restrictions contained in subparagraph (c), referring only to subparagraph (b) should also refer to subparagraph (a), (these being points 2 and 3 of the United States amendment). The British delegate agreed and the Irish delegate joined. The Chairman pointed out that this would be a restriction of the present Article and the Swiss delegate stated that he could not accept the perceptible reduction in the scope of subparagraph (a). The British proposal was put to a vote with 4 in favor, 10 against, and 15 abstentions (including the United States).

Discussion was continued at the following meeting when an English text was available.

Paragraph 5 refers to state emblems which are well known and Paragraph 6 to emblems which are not well known. The Canadian delegation proposed that this distinction be replaced by a distinction between State flags, as to which no notification was to be required, and other State emblems etc., as to which notification was to be required, and submitted a proposed text of these paragraphs (Doc. No. 193). In reply to a question the Bureau representative stated that the proposal did not alter the substance of paragraph 5. The Canadian proposal was adopted with a vote of 10 in favor, none against, and 20 abstentions.

The Chairman stated that the other paragraphs of Article 6 *ter* had met with no objection and that the French text could be considered as adopted. The United States member suggested that the language might need further revision.

In the session of the General Committee considering this Article, the United States member requested that a separate vote be taken on paragraph 1(a) before voting on the rest of the article. This was done and 21 voted in favor, the United States against, and there were 17 abstentions. Thus the omission of the words "from an heraldic point of view" was not carried and 1(a) remained unchanged. The large number of abstentions includes some countries which, from the nature of their activities during the discussions in Committee I, undoubtedly were also against the change but, knowing the position of the United States, did not vote "No".

On the rest of the Article the vote was 33 in favor, none against, and only 6 abstentions (11 of the previous abstainers now voting in favor).

It is believed that the revision of Article 6 *ter* does not absolutely require changes in the United States statute. As to eliminating the notification procedure in the case of State flags, the Trademark Act already prohibits the registration of trademarks which include flags, without regard to the notification procedure, in Section 2b (15 U.S.C. 1052b). As to the addition of emblems, etc. of international organizations, the Trademark Act in section 2a (15 U.S.C. 1052a) prohibits the registration of any mark which "consists of or comprises * * * matter which may falsely suggest a connection with * * * institutions, * * *" The word "institution" is broad and would encompass inter-governmental organizations. As to prohibiting the use of emblems, etc., there is now no explicit provision prohibiting use in the Trademark Act, the matter being taken care of by general provisions which hence would not need amendment. However, it still may be desirable to study the whole matter from the viewpoint of determining what explicit provisions ought to be made.

2. *Item XXII. Languages*

The Convention itself has been signed in French text only. Article 13(2) specifies that the official language of the Bureau is French and 13(3) refers to the publication of a periodical in French. The proposal on the original agenda presented three changes in the Convention relating to languages, these were:

1. The addition of a sentence to paragraph (2) of Article 13 stating that "The working languages of the Bureau shall be French, English and Spanish."

2. The addition of sentences to paragraphs (3) and (5) of the same article stating that publications of the Bureau could be issued in languages other than French, in the discretion of the Director and within the limits of available funds.

3. The addition of a sentence to Article 19 stating that "Official texts of the present Act shall be established by the Conferences of Revision in English and Spanish."

Discussion on the question of languages extended over parts of five sessions of the Committee. At first it was general with representatives of various countries expressing their views on the language of the treaty, the languages of the publications and business of the Bureau, and the languages used at conferences. The Bureau representative attempted to distinguish between official languages and working languages, but these terms were not clear and were not ulti-

mately adopted. The United States delegate actively participated in the discussion and, supported by the Canadian and British delegations, proposed that Article 19 be amended to provide that the treaty be in French and English, each equally authentic (Doc. No. 60).

At the conclusion of the first day's discussion, a vote was taken on whether paragraph 2 of Article 13 (the official language of the Bureau is French) should be changed, with the result: 15 in favor of changing, 13 against, 2 absentions.

During the meeting the "Iron Curtain" countries several times injected the question of an invitation to East Germany to attend the Conferences, deploring such noninvitation, and were declared out of order.

The discussion was continued without action at the next session. The Bureau proposed an amendment of its original proposals involving a proposed new article stating that the official language of the Union is French and that all documents shall be published in French, and revising Article 19 to the effect that the treaty was to be executed in French only, which was to be the only authentic text, but that an equivalent text was to be drafted in English (Doc. No. 113).

After further discussion at a third session, the matter was deferred to give the delegates time to discuss the matter among themselves and possibly reach some agreement.

There were several meetings of delegates from a number of countries including the United States, France, Great Britain, Canada and others, after which the Swiss delegation introduced a proposal representing a compromise position (Doc. No. 164). This consisted of:

1. A revision of Article 13(2) into two subparagraphs providing (a), that the Bureau is to carry out its functions in French and English and, (b) that conferences and meetings are to be conducted in French and English.

2. A revision of Article 19 continuing French as the language of the treaty and adding a paragraph stating "An official translation of the present Convention has been established in the English language."

Approval of this proposal was expressed by most of the delegates speaking on it. Several proposed amendments added further languages but the proposal as it stood was voted on first. The result was: 29 in favor, one against (Spain) and one abstention (Mexico).

Next a vote was taken on the proposal by Spain that Spanish be added to Article 13. The vote was 2 in favor, 14 against and 14 absentions (including the United States).

Then by a series of votes Spanish, Portuguese, German and Italian were added to the proposed second paragraph of Article 19 establishing official translations.

The intention in this respect was that translations would be prepared during the remainder of the Conference and adopted by the Conference itself as "official" translations, and several delegates proposing additional languages implied that this could be done.

At the session of the General Committee the Spanish delegate announced that they could not accept the proposal as the Spanish language was not included (in Article 13), and this statement was supported by the delegates for Cuba, Mexico and the Dominican Republic. The delegate for Australia proposed that Spanish be added in subparagraphs (a) (publications, etc.) and (b) (meetings and con-

ferences), which was supported by the United States delegate. The Canadian delegate pointed out that English and French were widely used internationally but that only 4 of 19 Spanish speaking countries were members of the Union. The Director of the Bureau pointed out that there would be additional expense in printing their publications in another language and, in response to an inquiry, estimated the increase in the neighborhood of 100,000 Swiss francs per annum.

The Israeli delegate proposed separate votes, and a series of votes were taken with the following results:

1. Subparagraph (a) amended to include Spanish: 13 in favor, 1 against (Bulgaria), 25 abstentions.

2. Subparagraph (a) without amendment: 33 in favor, 2 against (Spain and Mexico), 4 abstentions.

3. Subparagraph (b) amended to include Spanish: 11 in favor, 1 against (Turkey), 27 abstentions.

4. Subparagraph (b) without amendment: 31 in favor, 2 against (Spain, Dominican Republic), 6 abstentions.

5. Paragraphs 3, 4 and 5 (only paragraph 3 contained an incidental change): 39 in favor, none against, none abstaining.

6. On the first paragraph of Article 19 (preserving the status quo as to the language of the Convention) after, on motion of the Israeli delegate accepted by the delegate of Switzerland for his government, a blank was filled in by inserting "the Swiss Confederation" as the depository of the treaty: 38 in favor, none against, 1 abstention (Austria).

7. On the second paragraph of Article 19 (official translations): 38 in favor, none against, 1 abstention (Indonesia).

It may be noted here that the words "in Berne" in Paragraph 1 of Article 13 had been deleted by consent.

While the revision of Article 19 was thus carried, the language amendments to Article 13 were lost but the matter was not yet finished.

At the Plenary Session which occurred two days after the vote above recounted when the two changes in Article 13 were taken up (the omission of "at Berne" in paragraph 1 and the omission of the words "in French" in paragraph 3), the Turkish delegate announced that his only objections to the matter of languages had been on financial grounds and he withdrew his objection. The effect of this would be to change the third vote (to amend defeated paragraph 2(b) to include Spanish as well as English and French). The Spanish delegate expressed satisfaction that the English language was to be adopted and the delegates for Cuba, Dominican Republic and Mexico supported his remarks. The Chairman declared the subject reopened and, after some remarks by others, proposed that paragraph (2) might be worded as two subparagraphs, (a) that French and English be used by the Bureau (the second vote referred to above) and (b) that conferences and meetings be held in French, English and Spanish (the third vote). The Portuguese and United States delegates supported this suggestion and the matter was put to a vote. The result was 39 in favor with none against and no abstentions, one of the few actually unanimous votes.

This entire incident was very dramatic with considerable excitement shown by many. When it was concluded the Chairman thanked the delegates for their understanding and particularly the Turkish dele-

gate for his initiative and the Spanish speaking delegates for their helpful attitude.

When Article 19 came up in this same session the Australian delegate pointed out that the paragraph, referring to the five official translations, stated that they "have been established" and suggested that these words be changed to "shall be established." This was adopted without vote.

As far as known only two groups of delegations concerned themselves with preparing joint translations of the text of the Convention. It is understood that the German speaking delegations did some work concerning a commonly agreed German translation but that no agreement was reached. The English speaking delegations concerned themselves with a commonly agreed translation.

In preparation for various results concerning the use of the English language, prior to the Conference, English and American officials of the respective Patent Offices, with the aid of official translators in the respective departments, unofficially concerned themselves with the preparation of common English draft translation of the existing text of the Convention. A copy of this draft was supplied to the Bureau and printed versions were distributed at the opening of the Conference as a working English text. During the course of the meetings of Committees II and III, the English speaking delegations kept a close watch on the English texts which were distributed and assisted in their preparation. About the middle of the Conference an unofficial working group of delegates of English speaking countries was formed. This included representatives from Australia, Canada, Great Britain, Ireland and the United States. This group met daily during the last part of the Conference for the purpose of arriving at a jointly agreed English text of the Convention as revised by the Conference, starting with the working English translation of the existing text. At the conclusion of the Conference there was thus in existence an English translation which had the agreement of some of the English speaking countries, with, however, reservations by others. The official translator attached to the United States delegation participated in all the meetings of the informal group.

The work of the Conference was so rushed during the last week that it would have been impossible for either co-authentic texts in any language or official translations in any language to have been formally adopted by the Conference. There was so much going on during the last days in addition to preparation of the French texts for the plenary session and the final copy for signature that additional work of a similar character would have been impossible.

3. *Item XXIII. International Court of Justice*

The agenda proposed a new article requiring disputes concerning interpretation or application of the Convention (not settled by negotiation or otherwise) to be brought before the International Court of Justice.

Delegates from the United States, Australia, France, New Zealand, Poland and Czechoslovakia spoke against the proposal on various grounds from simple absence of necessity for it, to legal reasons. The French delegate distinguished between simple jurisdiction to handle such disputes, which he stated all countries were in favor of,

and the obligation to refer such disputes as proposed, which would have grave consequences. No one spoke in favor of the proposal.

The Chairman summarized the discussion and concluded without dissent that in view of the categorical statements of some of the delegates the proposal would be dropped.

4, 5, 6. *Items XXIV, XXV, XXVI. Finances and Organizational Matters*

The original agenda, under three item numbers, listed a number of interrelated proposed amendments to the Convention and resolutions relating to financial and organizational matters. In view of the nature of the comments and observations of various governments (Preliminary Documents, Vol. 4), the Bureau submitted amended proposals on the same subjects which were distributed shortly before the opening of the Conference (Preliminary Documents, Vol. 1, Part 3). This contained the following:

Under Item XXIV—

1. A resolution fixing the amount of the annual expenses of the Bureau at 588,000 Swiss francs, under Article 13(6).

2. A substitute paragraph (6) for Article 13 providing that Administrative Conferences meeting at intervals of not more than 5 years, or a Diplomatic Conference in lieu thereof, shall fix the expenses of the Bureau, by a two-thirds majority vote.

3. A new paragraph to be added to Article 14 formally establishing Administrative Conferences to meet to fix the amount of the expenses of the Bureau and for other administrative purposes.

Under Item XXV—

4. A resolution seeking support of the Conference of the efforts of the Director of the Bureau to make agreements with other intergovernmental organizations concerning the scope of their respective activities.

Under Item XXVI—

5. A new paragraph to be added to Article 14 creating an Intergovernmental Council consisting of representatives of 12 countries (membership to be rotated) having the functions of rendering advisory opinions on disputes and, on request, calling attention of countries to failures to carry out their obligations.

6. A resolution setting up an ad interim committee to act until the Intergovernmental Council provided for by the 5th proposition could be created.

About a month prior to the opening of the Conference, patent office officials of a group of European patent offices met at Nice, France, and discussed the subjects and proposals originally included in the agenda under these three Items. The resolutions of this group (Germany, Austria, Belgium, France, Italy, Luxembourg, Netherlands) were submitted to the Conference (Doc. No. 20). These proposed, among other things, a permanent Conference consisting of representatives of the Industrial Property Offices to fix the expenses of the Bureau and advise the Director. This Conference was to set up an Executive Committee with a rotating membership of 12, to have various functions.

When the subjects first came up there were some general remarks that time for more thorough study was needed. The Chairman dis-

nated a study group or subcommittee of Sweden (chairman), Germany, France, Great Britain, Switzerland, Czechoslovakia, and the United States, with the officers of the Committee also to participate. This subcommittee was to distribute its report three days later and the Committee would meet the following day; there were to be no intervening Committee meetings.

At the first meeting of the subcommittee the following morning, the French delegate proposed that the work be broken down into the following questions:

1. Could the Conference vote a budget increase for the Bureau by resolution which has immediate effect?
2. Should the budget cover separately the deficit of the Bureau to the Swiss Government and the yearly credit for the Bureau, or, should it cover both types of expenditure?
3. Should there be periodic Administrative Conferences to vote the expenses in future?
4. If so, should this be provided for by a new article of the Convention or by resolution?
5. What should be the composition of this Conference, representatives of Industrial Property Offices, or otherwise?

The morning's discussion was entirely on the financial aspects. The German delegate indicated that, while the Federal Republic could accept the resolution procedure for the year 1959, it would need ratification by its parliament for subsequent years.

The Czechoslovakia delegate indicated that he could not accept the resolution at all without subsequent ratification.

The German delegate also wished to see written into the Convention a provision that the Administrative Conference could not adopt a budget above a specified amount which he indicated should be fairly generous.

In order to meet the German view that they would need ratification of the resolution, it was suggested in addition that Administrative Conferences be provided for by resolution in the interim period before the new Convention comes into force.

The United States and British delegates both made it clear that they could accept an immediate increase of the budget by resolution in view of the authority provided by the present Convention. The United States further stated, however, that they could not accept putting into effect by resolution a new procedure for the adoption of a budget by resolution. It would be only possible to put such a procedure into effect by ratification.

Both the British and United States delegates spoke against the idea of writing a specific sum into the Convention. If this amount were made generous, as proposed, it would appear to be a blank check. On the other hand, if it were set too low, it would in effect continue the present situation for another twenty years.

No decisions were taken at the first meeting and the subcommittee met again the next day when it began with a continuation of the discussion on how best to provide funds for the Bureau in the interim period prior to ratification of the new Convention.

The discussion was highly confused and little progress was made. It became apparent in private conversations that this subject would solve itself after the Committee agreed upon interim organization

or arrangements which would provide some measure of control over the Bureau's use of the funds.

For the permanent arrangements on finance, it was agreed that there should be written into the Convention a provision for Administrative Conferences which would set the amount of expenditure from time to time and would otherwise advise the Bureau concerning matters of administration.

The United States delegate presented a revised proposal for the creation of an Intergovernmental Committee with specified terms of reference. After adjournment during which discussions previously begun with those subscribing to the Nice proposals were continued, a compromise was reached. The essence of this compromise was that the Administrative Conferences should establish a Committee rather than it being directly created in the Convention, i.e., the Committee to be an arm of the Administrative Conference.

Several delegates spoke against assignment to the Committee of the function of giving advice relative to the obligations under, or the interpretation of, the Convention.

The subcommittee met again the next day to consider the draft report being prepared and thereafter submitted a report (Doc. No. 159) which discussed the various problems and stated their conclusions and recommendations. However, no texts were submitted.

When the subject next came up in Committee session there had been submitted a Portuguese proposal (Doc. No. 162) on Administrative Conferences, and a joint French-United States proposal (Doc. No. 169). The latter proposal was explained. It included three proposed new articles, one on fixing expenses by Administrative Conferences, one establishing such conferences and their functions, and one providing for a Council of twelve countries and its functions, and a resolution concerning a temporary administrative conference and council.

Roumania and Bulgaria opposed the French-United States proposal primarily on political grounds—absence of East Germany—and Canada and Italy had doubts about an Interim Council and an Intergovernmental Council of a permanent character limited in membership.

During the discussions the Roumanian delegate made a long speech, the burden of which was that East Germany had not been invited to be present as a member country and that nothing could be approved in its absence.

The Chairman stated that a number of countries were opposed to the Intergovernmental Council and proposed dropping this point.

The Roumanian delegate spoke in approval of an Administrative Conference and some sort of a Committee. He was asked to submit this proposal in writing.

The situation by this time had become somewhat tense because of the attitude of the "Iron Curtain" countries and some effort was needed to reach a solution. At the next session of the Committee the chairman of the United States delegation spoke at length, explaining the significance of the French-United States proposal and discussing the problems involved, and urging some agreement. A 48-hour deferment was suggested to permit the countries to review their positions and clarify and simplify the proposals (the number of separate pro-

posals filed had grown to nearly twenty), and to continue informal discussions between groups of countries. After some further discussion, the adjournment was voted with 25 in favor, 2 against and 5 abstentions.

At the next session the proposals had been reduced to two, both introduced by the Portuguese delegation (Doc. Nos. 233 and 235), but which had been worked out by a number of countries during the adjournment. Before their consideration, the Roumanian delegate again spoke stating that in order to improve the financial situation of the Bureau it would be necessary to send an immediate invitation to East Germany. The Bulgarian delegate, after some comments by other delegations, also stated that he would vote against the Portuguese proposals since, there being an uninvited country, there could not be a unanimous decision, referring to the provision in Article 14(6) that the budget may be increased by a unanimous decision of a conference.

The Chairman then called for a vote on Doc. No. 235, there having been in fact no actual discussion of its contents. The vote was 28 in favor, 1 against (Roumania) and 4 abstentions (Bulgaria, Hungary, Poland, Czechoslovakia).

This proposal provided for a new paragraph to be added to Article 14 relating to triennial conferences to fix the budget, by unanimous vote, and some consequential changes in Article 13, paragraphs 6 to 10.

The other proposal (Doc. No. 233) was a resolution increasing the expenses of the Bureau, under Article 13(6). The Czechoslovakian delegate spoke against this on several grounds but mainly because of the absence of a delegate from East Germany. The Chairman called for a vote with the result of 27 in favor, 4 against (Bulgaria, Poland, Roumania, Czechoslovakia) and 1 abstention (Hungary).

These two were the results sent to the General Committee.

When they first came up in the General Committee session Roumania had submitted amendments to them, and the matter was postponed for consideration by a small study group. The Roumanian amendment to the Convention provisions involved only a matter of language. The amendment to the resolution, however, while making a slight reduction in the amount, was so worded that it would constitute an acceptance of the argument that East Germany should have been present.

The study group reported a revision of the amendment to the Convention consisting only of an addition to Article 14 relating to the administrative conferences. This was voted on with 37 in favor, none against, and 1 abstention (Union of South Africa).

The study group also reported a resolution "provisionally" fixing the expenses at a blank amount and calling for a future Conference of Plenipotentiaries to fix the expenses, and providing for a consultative committee. While this was carried by a vote of 34 in favor, none against and 4 abstentions (Bulgaria, Italy, Czechoslovakia, Union of South Africa), in view of further action by the Committee only the part relating to the consultative committee was left in the resolution by the General Drafting Committee.

Further consideration was postponed to the following day when the Chairman announced that a vote would be taken first on the Rou-

manian resolution (Doc. No. 269) and then on the Portuguese Resolution (Doc. No. 233). The Roumanian delegate submitted an amendment to its resolution provisionally fixing the expenses for a specified number of years. The German and United States delegates spoke against the Roumanian resolution since it was still based on the premise that East Germany should have been present. The Roumanian delegate disagreed and would not accept a simple amendment the Germans had suggested, namely, that the provisional amount run until action was taken on the basis of the revised Convention. The United States delegate spoke against the Roumanian proposal, questioned why the German suggestion could not be accepted, and stated that the proposal could not be accepted without this suggested amendment.

After some discussion the Chairman called for a vote on the Roumanian proposal with the result: 19 in favor, 2 against (the United States, Germany), and 18 abstentions. The German amendment was then voted on with the result: 26 in favor, 1 against (Roumania), 12 abstentions.

The Portuguese proposal was then taken up and, after a detail amendment proposed by Bulgaria, and the distribution of a new text, voted on. The result was 32 in favor (including the United States and Germany), 1 against (Roumania), 6 abstentions. The unamended Portuguese proposal was also defeated by the one negative vote of Roumania.

After some further discussion the Netherlands delegate proposed a resolution which invited the countries to increase their contributions (Doc. No. 307). This was accepted with a vote of 31 in favor and 8 abstentions.

It may be noted here that the Czechoslovakia delegate again protested the absence of an invitation to East Germany in the Closing Plenary Session.

7. *New item. Opening for Signature*

The Australian delegation proposed the addition of a paragraph to Article 19 to provide that the Convention shall remain open for signature until April 30, 1959 (Doc. No. 92). After an explanation by the Australian delegate the proposal was adopted by a vote of 18 in favor, none against and 11 abstentions.

In the General Committee session the proposal was adopted with 38 in favor, none against and 6 abstentions.

8. *New Item. Revision of Articles 16 and 18*

The United States introduced a proposal revising and consolidating Articles 16 and 18 dealing with accession, ratification, and coming into force of the Convention, concerned only with form and language, to make the text clearer. The Swiss delegate suggested that it would be better to deal with this matter when the rearrangement of the whole text of the Convention took place, and the United States member indicated that he had no objection to this suggestion.

9. *New Item. Non-Self-Executing Provision*

Article 17 of the Convention is intended to be a non-self-executing provision. The United States proposed a revision of this article to make it clearer and to add a paragraph providing that a country must

be in a position under its domestic law to give effect to the Convention, at the time it deposits its instrument of ratification or adherence (Doc. No. 154). The text submitted is substantially identical with Article X of the Universal Copyright Convention.

The United States member pointed out that there was no great difference in substance between the first paragraph of the proposal and the existing text, and explained the purpose of the second paragraph which was to avoid delay after ratification of a country in bringing its national legislation into harmony with the treaty.

After a brief discussion, the proposal was voted on with the result: 23 in favor, 1 against (Netherlands), and 6 abstentions.

In the General Committee session the proposal was adopted with 32 in favor, [none] against and 6 abstentions.

10. *New Item. Supervision of Swiss Government*

The Swiss delegation introduced a proposal to revise paragraph 10 of Article 13, dividing it into two paragraphs 10 and 11 and separating the supervision of accounts, which is done by the Swiss Government, from the communicating of annual reports to the countries, which is in fact done by the Bureau. After a brief explanation of the purpose, to harmonize the language with the existing situation, the proposal was adopted with 30 in favor, none against, and one abstention.

In the General Committee session the proposal was adopted with 37 in favor, none opposed, and one abstention.

11. *Rearrangement of the Text of the Convention*

The Preliminary Documents, Volume 2, included a proposal to rearrange the text of the Convention to eliminate the confused state of the numbering, order, and content of the articles. Conditions were such and time was so pressing that the plan submitted could not have been discussed. Realizing this, the United States delegation introduced a proposal for a minimum rearrangement consisting of reordering a few articles and numbering all the articles in sequence (Doc. No. 213). The Swedish delegation submitted a proposed resolution to have a further study made and draft prepared, the draft to be submitted to the countries for their comments and then considered as soon as convenient at a conference of the countries (Doc. No. 234). After a brief discussion the Swedish proposal was carried with 27 in favor, none against, and 5 abstentions. The United States proposal was withdrawn. The discussion indicated that the proposed rearrangement would also consider clarifying the language.

In the General Committee session the resolution was adopted with 38 in favor, none against, and no abstentions.

G. GENERAL COMMITTEE AND CLOSING SESSIONS

The General Committee, under the chairmanship of the President of the Conference, began its sessions on October 23, after the various Committees had concluded their meetings, but before the reports of some of them had been filed. The proposals submitted by each of the Committees for action were taken up by Committees in the order of V, III, II, IV, and I, with, however, deferments of particular items from time to time. The activity in the General Committee on each

item has been summarized in the preceding sections, in connection with the activity in the Committee on the same item. The General Committee held eight sessions, the last one during the morning of October 29.

The propositions adopted by the General Committee were referred to the General Drafting Committee which edited them, revising the language, and texts were distributed for action by the Plenary Session which was held in the afternoon of the same day as the last session of the General Committee. In the Plenary Session, the Chairman brought up each proposal adopted by the General Committee, called for anyone who wished to speak, and, in the absence of objection, the matter would be considered carried. Occasionally a point of explanation would be made, and a few drafting matters were taken care of by agreement. The reopening of the language question has been noted under that subject. The chairman of the Austrian delegation extended an invitation by his government to hold the next Conference of Revision in Vienna, which was accepted by acclamation.

The Closing Plenary Session was held after an interval of a day for the preparation of engrossed copies of the final acts of the Conference. The Rapporteur Général read the conclusions in his preliminary report. After expressions of thanks and appreciation, the texts were signed.

**REPORT OF REPRESENTATIVE ROLAND V. LIBONATI, MEMBER OF CONGRESS,
ON THE INTERNATIONAL PATENT AND TRADEMARK CONFERENCE LISBON, PORTUGAL, OCTOBER 1958**

[Submitted to House Committee on the Judiciary]

March 30, 1959

INTRODUCTION

Representative Roland V. Libonati, accompanied by Cyril F. Brickfield, counsel, attended, on behalf of the committee, a Conference of the International Convention for the Protection of Industrial Property, held in Lisbon, Portugal, from October 6 to October 31, 1958. Mr. Libonati's report of the proceedings follows:

The International Convention for the Protection of Industrial Property deals with patents, trademarks, and related subjects, and was originally concluded in Paris in 1893. It has been revised in successive conferences of revision which have been held in Brussels (1900), Washington (1910), The Hague (1925), and London (1934). The last revision of the convention was held in 1934. There are 47 contracting countries to this convention.¹ All were invited to attend. Forty sent official delegates. Seven did not.² In addition, nine nonmember countries³ sent observers to the Conference as well as various intergovernmental agencies.⁴ The United States had an official delegation headed by the Honorable Robert C. Watson, Commissioner of Patents.⁵ In addition, the Honorable Alexander Wiley, U.S. Senator from Wisconsin and myself attended as congressional adviser and observer, respectively, together with congressional staff observers.⁶ The U.S. delegation prepared itself in advance of the Lisbon Conference through a series of meetings of an advisory committee con-

See Citations on pages 131-133.

sisting of representatives of associations and organizations in the United States which are normally concerned in patents and trademark matters. In addition there was an interdepartmental committee including representatives of internal-government agencies. As a result of these meetings, the State Department prepared a series of instructions for the guidance and direction of the delegates while at the Conference.

When the Conference convened on October 6, it was divided into five Working Committees; Patents, Trademarks, Designs, Indications of Origin and Unfair Competition, and General Provisions, respectively. There was also a Technical Committee on Drafting. These Committees worked for the first 2½ weeks of the Conference. At the end of this period, the delegates met as a Committee of the Whole to receive and act on the reports of the Working Committees containing suggested changes and recommendations. The Drafting Committee then put the work into text form and thereafter the last stage consisted of the Plenary Meeting of the Conference which took final action on the text of the amendments.

The Conference was governed by a unanimous consent vote rule. In other words, no amendment of the Conference was adopted which was not unanimously agreed to by countries participating and voting.

A review of what I consider were some of the important subjects taken up by the Conference follows. It may well be at the outset, however, to make a few general observations.

Most of the amendments, which were of a clarifying nature or which consolidated and rearranged old text and provisions, were adopted. In addition, a revision was made of the basic articles of the convention on the right of priority (art. 4), the working of patents (art. 5), the registration of trademarks (art. 6 quinquies), the protection of well-known marks (art. 6 bis), the prolongation of the period of grace for the payment of fees for the maintenance of industrial property rights (art. 5 bis) and false indications of origin and unfair trading (art. 10 and 10 bis). Some new subjects were also considered and adopted; for example, the importation of products infringing on a process patent (art. 5 quater), obligating countries to protect designs (art. 5 quinquies), protection of service marks (art. 6 sexies), and protection of trademarks against unauthorized registration by an agent or representative of the proprietor (art. 6 septies).

Provisions which were not adopted included the nonuse of trademarks, the licensing of trademarks, the protection of famous marks, the patentability of chemical products, working of patents and certain aspects of compulsory licensing.

It was generally agreed that there was too little time and too much to do. Doubtless many provisions which were not adopted may have been approved at least in a modified form if there had been more time available to discuss them. Because of this circumstance, an administrative Conference Committee was created which will meet during the interval before the next general Conference to consider questions relating to the protection and expansion of the union as well as preliminary work on desirable amendments. When the Conference next meets, the items which it will consider will have had a larger measure of preparatory work, including the consensus of views which will have been obtained prior to the meetings.

It should not be forgotten that a quarter of a century has elapsed since the last revision of the convention. The interim period has been one of World War and marked uncertainty with resultant far reaching effects on the international industrial field. The delegates from the various nations approached the revision of this convention with understandable caution. The revision of a law which will be basic for all countries is a difficult undertaking, especially when the issues examined include the field of political economy and social efforts. It is therefore commendable with respect to such issues as the patentability of chemical products, as such, that while agreement could not be reached, the delegates nonetheless were able to translate their common desires and hopes into a resolution looking toward further study and containing the germ of future agreement.

I hope, since the provisions of this convention are non-self-executing and Congress will be called upon to enact implementing legislation and appropriations, that this report will be of considerable aid to the future work of this committee.

I cannot praise too highly the professional and many other services contributed by our Committee Counsel Cyril F. Brickfield, to the successful accomplishments of our humble effort to advise and confer with the official members of the U.S. delegation. The Honorable Mr. Watson and his assistant, Mr. Federico, together with all the other members of the delegation, are also to be complimented for their patience, persistence, thorough knowledge of the problems presented, and the rational analytical treatment of subjects in debate. They gained the confidence and approval of the members of the convention on delicate issues and in matters, that under lesser personalities, would have been rejected. The U.S. delegation merits the gratitude of the industry in the success of its major proposals in this specialized field of operation. We were proud to be associated with them in our modest responsibilities to their great and important task.

The constant vigilance and attendance of our distinguished U.S. Senator Alexander Wiley of Wisconsin, representing the Senate Judiciary Committee, at all conferences and convention subcommittee meetings was commented upon by everyone. His agile mind and judicious analytical acuteness, together with a complete understanding and knowledge of the problems and subjects in this area, earned for him the enviable and authoritative recognition of the members of the convention. He is to be highly complimented for his contribution to the success enjoyed by the U.S. delegation.

PATENTS

Patentability of chemical products. Proposed article 4 quater (not adopted)

This suggested proposal would have obligated countries to grant patents for chemical products. It was strongly supported by the United States.

As a matter of interpretation, the term "chemical products" is understood in a broad sense as including all chemical products, no matter what their purpose or function may be. It covers foodstuffs as well as pharmaceuticals. The proposal as worded did not preclude the protection of processes. There was strong opposition to this

proposal by some nine countries, principally because of the reluctance of those countries to grant patents on pharmaceutical products.

While the proposal did not prevail, a resolution was adopted, however, recommending to the participating nations that the subject be studied with the possible view of making provision in their national law for the patentability of chemical products (Doc. No. 280 A; see appendix).

Compulsory licensing of patents. Article 5A (partially adopted)

The present text of the convention, article V in paragraphs 2, 3, and 4 thereof, imposes certain conditions on the granting of compulsory licensing to prevent abuses which might result from the exercise of the exclusive rights conferred by the patent; for example, failure to use. It also provides that a patent cannot be revoked unless the granting of the compulsory license was insufficient to prevent abuse and further it sets out a period of 3 years before a compulsory license could be applied for and a further period of 2 years after the grant of the first compulsory license before revocation can be sought. These provisions were changed somewhat in substance at the time the proposal was finally adopted. Under the new language, each country has the right to adopt legislative measures providing for the granting of compulsory licenses to prevent abuses which result from the exclusive rights conferred by patents. In addition, where there is a failure to work the patent, the patent itself may be revoked where the granting of compulsory licenses would not have been sufficient to prevent the nonuse. No proceeding, however, for the revocation of such a patent can be instituted, under the new provisions, before the expiration of 2 years from the granting of the first compulsory license.

Also, an application for a compulsory license may not be made on the ground of failure to work or nonuse before the expiration of a period of 4 years from the date of filing of the patent application, or 3 years from the date of the grant of the patent, whichever period is longer.

Right of priority; regularly filed application. Article 4A(3) (adopted)

Article 4 provides for a right of priority based on a first application filed in another member country. A provision was adopted stating that any formal filing with a country would be adequate to establish the date of application (art. 4A(3)) and that such right of priority shall be extended to a subsequent application under certain conditions if the first is withdrawn, abandoned or refused (art. 4C(4)). This provision was adopted.

Disclosure of invention before applying for Patent. Proposed article 4J (not adopted)

This provision would have permitted an invention to be disclosed before applying for a patent without losing the right to a patent. In the United States, disclosure of the invention by anybody and under any circumstances during the year preceding the filing of an application for patent does not defeat the right of a patent. This liberal provision was unacceptable to several countries because of different

philosophies regarding patents and under the unanimity rule failed of adoption.

TRADEMARKS

Concurrent use of trademark by several persons. Proposed article 5C(3) (not adopted)

The U.S. delegation opposed this proposal as written. Present paragraph 3 provides that the concurrent use by "co-proprietors" of the same mark shall not prevent registration nor prejudice its protection. The proposed paragraph 3 would have provided that where certain specified relationships exist between the proprietor and other persons (such as contractual, financial and others) the use of the mark by such other persons would be considered as use by the proprietor. The American objection was based on the grounds that this expansion of the co-proprietor relationship went beyond the wording of present U.S. statutes.

Industrial designs; proposed article 5 quater, now article 5 quinquies (adopted in part)

This suggested provision would require the participating countries to adopt legislation protecting industrial designs and included some details. It was the subject of much discussion and only the broad proposition was adopted. In addition a general resolution was adopted accepting the invitation of other unions to meet for the purpose of working out means to insure the international protection of works of applied art, designs and models (Doc. No. 275A; see appendix).

Right to registration without registration in home country. Article 6 (adopted)

The United States strongly supported this new article. It provides that a person shall be entitled to register his trademark in a member country if he satisfies the requirements of the laws of that country without regard to whether or not he has registered the mark in his home country.

In view of article 2 of the convention that a national of one country is entitled to all the advantages that the law of a country grants to its own nationals, it logically follows that if a U.S. citizen applying for registration of his trademark in a particular member country satisfies all the requirements of the trademark law of that country applicable to its own nationals, he should be entitled to register his mark in that country, and the question of whether he had already obtained a registration in the United States is wholly immaterial. Several countries presently require a home registration in all cases of applications to register a trademark by nationals of other countries. This will no longer be a requirement.

Service marks. Article 6 sexies (adopted)

The United States proposed this new article, which requires member countries to protect trademarks used for services in the same manner as trademarks used to designate goods.

GENERAL PROVISIONS

Compulsory jurisdiction of the International Court of Justice. Proposed article 13 (bis) (not adopted)

A proposal was made to confer on the International Court of Justice compulsory jurisdiction over disputes concerning the interpretation and application of the convention, if such disputes cannot be settled by means of negotiation or international means of conciliation.

The U.S. delegation opposed this proposal on the general ground that there was no need for such an article. The convention, it argued, has been successfully in operation for 65 years without such provisions and amendments such as the one here proposed should only be made when positive need for the change is shown. No such need was apparent, in fact, it was pointed out, in technical fields such as are particularly involved in the convention, the consultative method is preferable to a general system of compulsory adjudication.

Finances of the Administrative Bureau under the convention. Article 13(6) (not adopted)

The present convention fixes the budget ceiling to maintain the Administrative Bureau of the Convention at 112,000 Swiss francs yearly (approximately \$28,000) and further provides that only Conferences of Revision can change the amount of the funds so fixed. The U.S. delegation supported a resolution raising the ceiling to approximately 600,000 Swiss francs (approximately \$150,000) and further proposed that administrative conferences could be held from time to time as needed for the purposes of adjusting these expenses.

The last time the ceiling was fixed was in 1934. Experience has shown that the cost of living has gone up since that time and that the convention's activity and workload has increased, resulting in higher costs. While periods of 10 to 20 years has proved best suited for the technical provisions of the convention dealing with material rights, it is entirely inadequate for revision of financial provisions.

Certain member countries urged that a unanimous decision could not be reached in this instance since East Germany was not invited to the Conference and therefore could not participate in voting for a change in the budget sum. (The financial article, art. 13(6), is the only provision in the convention which refers to unanimity. While the convention worked under a unanimity vote it was the result of a rule adopted at the convention, and should be distinguished from the provision in article 13(6) of the convention expressly requiring unanimity as to finances.) The U.S. delegation and West Germany resisted this argument taking the position that the Conference could reach decisions in the absence of East Germany.

As a result of the impasse article 13(6) remained unchanged and the expenses of the Bureau remain at 112,000 Swiss francs. However, a resolution was adopted which invites the member countries on their own volition to increase their contributions to the Administrative Bureau with a view to providing the Bureau with an annual sum of 600,000 Swiss francs (Doc. No. 307A; see appendix).

Languages of the convention. Articles 13(2) and 19 (adopted)

Since the origin of the convention in 1883, French has been the sole language of the convention. During the intervening years, international practice with respect to treaty languages has undergone a considerable change. It is now the standard practice for international treaties involving free world countries, to be signed not only in French but also in English and Spanish and the U.S. delegation supported a proposal which would make English and Spanish as well as French the official languages of the convention.

This proposal ran into strong opposition by the German, Italian, and Portuguese delegations and as a result a compromise was reached providing that the French and English languages are to be used in performing administrative work and French, English, and Spanish are to be used at convention proceedings. A provision for an "official" English translation was adopted.

Self-executing provisions. Article 17 (adopted)

The U.S. delegation proposed a revision of this article, setting forth (1) that the provisions of the convention are not self-executing and (2) that, before ratification of the revised convention, each country was to amend its domestic laws so as to give effect to the convention's provisions.

This proposal was first opposed by several of the countries on the theory that international law generally considers treaties as self-executing, particularly if there is a provision within the treaty itself so stating. However, a provision was adopted whereby each country to the convention undertakes to adopt, in accordance with its own national laws, the measures necessary to insure the effectiveness of the convention. Further, each country's national law will be so changed that at the time of ratification its law will be able to give effect to the terms of the convention.

Signature and ratification of convention. Articles 18 and 19 (adopted)

The Conference approved a revision of article 19 which provides that the convention, as revised, shall remain open for signature by the member countries until April 30, 1959, in order that the governments themselves may have a reasonable time to study its provisions.

With regard to ratification, the new article 18 provides that instruments of ratification may be deposited at Bern, Switzerland, up to May 2, 1963. Prior to that time, if six countries ratify, the convention will come into full force and effect as between the ratifying countries 1 month following the deposit of the six ratifications and for countries ratifying later, 1 month after the notification of their ratification.

ITALIAN LAW AND PROCEDURE ON INDUSTRIAL INVENTIONS

A tour was made of the Italian Patent Office, known as Ministry of Industry and Commerce, Central Bureau of Patents. Signor Max Angel, Chief Patent Examiner and Signora Elemaria Massuchetti, Patent Examiner, discussed the functions of that office and the procedures which inventors must follow in applying for patents.

The Central Bureau maintains a staff of approximately 18 to 20 people. They process about 18,000 applications yearly. Unlike the American system, in which each application is thoroughly scrutinized as to novelty, utility, first inventor, prior art, abandonment, etc., the Italian system is one largely of registration. In other words, upon compliance with certain procedures and basic substantive requirements, a patent is issued. Many of the problems that are dealt with at the Patent Office level in the United States are, therefore, left for remedy, in Italy, to the courts.

Inventions and industrial models in Italy are governed by four royal decrees which were promulgated prior to World War II and by one general law relating to the extension of the terms of patents, enacted subsequent to World War II. They are Royal Decree No. 1127 of June 29, 1939, as amended; Royal Decree No. 244 of February 5, 1940, as amended; Royal Decree No. 1411 of August 25, 1940; and Royal Decree No. 1354 of October 31, 1941; and Public Law No. 842 of October 10, 1950. There is also the Civil Code of 1942, sections 2584-2591, which reflects the foregoing decrees in part and also contains procedural provisions.

The Italian inventor acquires an exclusive right to his invention and may exploit it himself, sell, or assign it. He has the right, as in the American system, to use it to the exclusion of others. If the invention is a method or process and is directed toward obtaining a new industrial product, the patent extends also to the product thus obtained. Any other product which is identical, unless there is strong evidence to the contrary, is presumed to be obtained by the method or process which has already been patented.

An employer is entitled to be recognized as the inventor when the invention was made by an employee within the scope of his employment.

An application involving the issuance of a patent for an industrial invention is filed either at the Central Bureau of Patents in Rome or with one of the provincial offices of the Ministry of Commerce and Industry. Applications filed in the provinces are forwarded to the Central Bureau for processing. If one is dissatisfied with the findings of the Central Bureau of Patents either denying the application in whole or in part, or is a third party objecting to the issuance of such patent, he may appeal to the Secretary of the Commission for Appeals, which is a part of the Ministry of Commerce and Industry.

The Central Bureau of Patents, like our own Patent Office, publishes patents which are granted in "The Bulletin of Patents."

Patents are issued for 15 years, counting from the date when the patent is filed. Once issued, it may neither be removed nor have its duration extended. The only exception to this rule was in 1950, when certain patents were extended because of the events caused by World War II. This action was similar to that taken by the United States whereby veterans and their spouses were permitted extensions on patents whose exploitation was curtained because of World War II.

Actions involving industrial invention are considered as choses-in-action of a commercial nature. They are brought, as a rule, in a court of defendant's domicile. The burden of proof is upon the party attacking the validity of the patent. Generally, under Italian law, a patent is null and void (1) when the invention does not comply with the requirements prescribed by law, for example, when it does not meet procedural requirements of the Patent Office; (2) when the patent was granted for an invention for which a patent already existed; (3) when the description of the invention does not include all the information necessary to satisfy an expert in order to put the invention into practice.

The Italian patent officials pointed out that resort to the courts by patent holders for infringements has been exceedingly light—only about 1 percent of the patents issued are thereafter the subject of litigation. This fact, together with the registration method for issuing patents requiring a comparatively small number of personnel, makes the Italian patent system a most economical one to operate.

In summary, it may be said that the Italian patent system has many desirable features. The registration type of system, as distinguished from our own examination system, does not require large numbers of personnel or exhaustive searching. This saves time and effort which would otherwise be spent on patents which are never or only partially used or exploited. In addition, no abuse apparently results from this system, since less than 1 percent of the patents find their way into the courts. It also should be noted that while Italian examination is largely one of clerical effort, the facilities maintained permit exhaustive searching by applicants or their attorneys.

CITATIONS

(1) MEMBERS OF THE UNION FOR THE PROTECTION OF INDUSTRIAL PROPERTY

The following is a list of countries which have adhered to the International Convention for the Protection of Industrial Property as revised at London in 1934, as reported up to July 1, 1958, and to previous versions of the convention, the revision of The Hague of 1925 and the revision of Washington of 1911. The original date is given and also the date of the adherence to the different versions. In some instances a country becoming independent or acquiring a separate status has continued previous adherence under a new name or under the new status; in such cases the original dates are still used.

NOTE.—For references, see page 123 et seq.

Country	Original date	Washington, 1911	The Hague, 1925	London, 1934
Australia.....	Aug. 5, 1907	Oct. 10, 1925	Feb. 12, 1933	June 2, 1936
Papua and New Guinea.....	Feb. 12, 1933do.....do.....do.....
Norfolk Island and Nauru.....	July 29, 1936do.....	July 29, 1936do.....
Austria.....	Jan. 1, 1909	May 1, 1913	June 1, 1928	July 19, 1947
Belgium.....	July 7, 1884	Aug. 8, 1914	July 27, 1929	Nov. 24, 1939
Brazil.....do.....	Dec. 17, 1914	Oct. 26, 1929do.....
Bulgaria.....	June 13, 1921	June 13, 1921do.....do.....
Canada.....	Sept. 1, 1923	Sept. 1, 1923	June 1, 1928	July 30, 1951
Ceylon.....	June 10, 1905	June 20, 1913do.....	Dec. 29, 1932
Cuba.....	Nov. 17, 1904	Jan. 3, 1922do.....do.....
Czechoslovakia.....	Oct. 5, 1919	Oct. 5, 1919	Mar. 3, 1933do.....
Denmark (Including Faroe Islands).....	Oct. 1, 1894	Aug. 30, 1914	Sept. 10, 1937	Aug. 1, 1933
Dominican Republic.....	July 11, 1890	May 1, 1913do.....do.....
Egypt.....	July 1, 1951do.....do.....	July 1, 1951
Federation of Rhodesia and Nyasaland.....do.....do.....do.....	Apr. 1, 1953
Finland.....	Sept. 20, 1921	Sept. 20, 1921do.....	May 30, 1953
France (Including Algeria and colonies).....	July 7, 1884	May 1, 1913	Oct. 20, 1930	June 25, 1939
Germany.....	May 1, 1903do.....	June 1, 1928	Aug. 1, 1938
Great Britain.....	July 7, 1884do.....do.....do.....
Tanganyika.....	Jan. 1, 1938do.....	Jan. 1, 1938	Jan. 28, 1951
Trinidad and Tobago.....	May 14, 1908	June 20, 1913	Oct. 21, 1929do.....
Singapore.....	Nov. 12, 1949do.....do.....	Nov. 12, 1949
Greece.....	Oct. 2, 1924	Oct. 2, 1924do.....	Nov. 27, 1953
Haiti.....	July 1, 1958do.....do.....	July 1, 1958
Hungary.....	Jan. 1, 1909	May 1, 1913	May 16, 1929	Aug. 8, 1948
Indonesia.....	Oct. 1, 1888do.....	June 1, 1928	May 14, 1958
Ireland.....	Dec. 4, 1925	Dec. 4, 1925do.....	Mar. 24, 1950
Israel.....	Sept. 12, 1933do.....	Sept. 12, 1933	July 15, 1955
Italy.....	July 7, 1884	May 1, 1913	June 1, 1938	Aug. 1, 1938
Japan.....	July 15, 1899do.....	Jan. 1, 1935	Sept. 30, 1947
Lebanon.....	Sept. 1, 1924	Sept. 1, 1924	Nov. 17, 1930	Jan. 28, 1951
Liechtenstein.....	July 14, 1933do.....	July 14, 1933	July 30, 1945
Luxembourg.....	June 30, 1922	June 30, 1922do.....	July 14, 1955
Mexico.....	Sept. 7, 1903	May 1, 1913	Jan. 16, 1930	Apr. 29, 1956
Monaco.....	Apr. 29, 1956do.....do.....	Jan. 21, 1941
Morocco.....	July 30, 1917	July 30, 1917	Oct. 20, 1930	Aug. 8, 1948
Netherlands.....	July 7, 1884	May 1, 1913	June 1, 1928do.....
Netherlands Indies.....	Oct. 1, 1888do.....do.....do.....
Surinam and Curacao.....	July 1, 1890do.....do.....do.....
New Zealand.....	Sept. 7, 1891	June 20, 1913	July 29, 1931	July 14, 1946
Western Samoa.....	July 29, 1931do.....do.....do.....
Norway.....	July 1, 1885	May 1, 1913do.....	Aug. 1, 1938
Poland.....	Nov. 10, 1919	Nov. 10, 1919	Nov. 22, 1931do.....
Portugal (Including Azores and Madeira).....	July 7, 1884	May 1, 1913	Nov. 17, 1928	Nov. 7, 1949
Rumania.....	Oct. 6, 1920	Oct. 6, 1920do.....do.....
Spain.....	July 7, 1884	May 1, 1913	June 1, 1928	Mar. 2, 1956
Spanish colonies.....	Dec. 15, 1947do.....	Dec. 15, 1947do.....
Sweden.....	July 1, 1885	Jan. 11, 1917	July 1, 1934	July 1, 1933
Switzerland.....	July 7, 1884	May 1, 1913	June 15, 1929	Sept. 24, 1939
Syria.....	Sept. 1, 1924	Sept. 1, 1924	Nov. 17, 1930	Sept. 30, 1947
Tunis.....	July 7, 1884	May 1, 1913	Oct. 20, 1930	Oct. 4, 1942
Turkey.....	Oct. 10, 1925	Oct. 10, 1925	Aug. 21, 1930	June 27, 1957
Union of South Africa.....	Dec. 1, 1947do.....do.....	Dec. 1, 1947
United States.....	May 30, 1887	May 1, 1913	Mar. 6, 1931	Aug. 1, 1938
Vietnam.....	July 7, 1884do.....	Oct. 20, 1930	June 25, 1939
Yugoslavia.....do.....	Feb. 26, 1921	Oct. 29, 1928do.....

- (2) Ceylon, Greece, Haiti, Lebanon, Tunis, Egypt, and Syria.
- (3) Saudi Arabia, Ecuador, Iran, Iraq, Liberia, Panama, Vatican City, Venezuela, and Russia.
- (4) International Labor Bureau.
European Economic Community.
Council of Europe.
International Office of Grapes and Wine (O.I.V.).
Food and Agriculture Organization (F.A.O.).
Organization Mon Diale de la Sante (O.M.S.).
UNESCO.
International Organization for the Unification of Private Rights at Rome.
International Bureau for the Convention for the Protection of Industrial Property (A.I.P.P.I.).
International Literary and Artistic Association (A.L.A.I.).
International Chamber of Commerce.
International Confederation of the Society of Authors and Composers (C.I.S.A.C.).

International Federation of Inventors Councils for Industrial Property (F.I.I.C.P.I.).

International League Contre La Concurrence Deloyai (L.I.C.C.D.).

Manufacturers Union.

Chamber of Commerce of Lisbon.

- (5) Delegate: The Honorable Robert C. Watson, Commissioner of Patents, Patent Office, Department of Commerce.

Advisers:

Roger C. Dixon, Chief, International Business Practices Division, Department of State,

Pasquale J. Federico, Examiner-in-Chief, Patent Office, Department of Commerce.

Steven P. Ladas, 10 Columbus Circle, New York, N.Y.

Stanley D. Metzger, Assistant Legal Adviser for Economic Affairs, Department of State.

John Dashiell Myers, 730 Hazelhurst Avenue, Marion, Pa.

Albert R. Teare, 1114 Terminal Tower, Cleveland, Ohio.

Observer:

George F. Westerman, Lt. Col., U.S. Army, patent adviser to defense adviser, U.S.R.O., Paris.

Arpad Bogsch, legal adviser: U.S. Copyright Office.

- (6) U.S. Congressional Representation:

Senator Alexander Wiley, Adviser.

Representative Roland V. Libonati, observer.

Congressional staff observers:

Cyril F. Brickfield, counsel of the Judiciary Committee, House of Representatives.

Carlisle Bolton-Smith, counsel for the Antitrust and Monopoly Subcommittee, Senate Judiciary Committee.

Robert L. Wright, counsel for the Subcommittee on Patents, Trademarks and Copyrights, U.S. Senate.

[Senate, Executive D, 86th Cong., 2d sess.]

MESSAGE FROM THE PRESIDENT OF THE UNITED STATES TRANSMITTING A CERTIFIED COPY, IN THE AUTHENTIC FRENCH TEXT, WITH AN ENGLISH TRANSLATION, OF THE CONVENTION OF PARIS FOR THE PROTECTION OF INDUSTRIAL PROPERTY OF MARCH 20, 1883, AS REVISED AT BRUSSELS, DECEMBER 14, 1900; AT WASHINGTON, JUNE 2, 1911; AT THE HAGUE, NOVEMBER 6, 1925; AT LONDON, JUNE 2, 1934; AND AT LISBON, OCTOBER 31, 1958

FEBRUARY 17, 1960.—Convention was read the first time and the injunction of secrecy was removed therefrom. The convention, the President's message of transmittal, and all accompanying papers were referred to the Committee on Foreign Relations and ordered to be printed for the use of the Senate

THE WHITE HOUSE, *February 17, 1960.*

To the Senate of the United States:

With a view to receiving the advice and consent of the Senate to ratification, I transmit herewith a certified copy, in the authentic French text, with an English translation, of the convention of Paris for the protection of industrial property of March 20, 1883, as revised at Brussels, December 14, 1900; at Washington, June 2, 1911; at The Hague, November 6, 1925; at London, June 2, 1934; and at Lisbon, October 31, 1958.

I transmit also, for the information of the Senate, the report of the Secretary of State with respect to the Convention.

DWIGHT D. EISENHOWER.

FEBRUARY 10, 1960.

The PRESIDENT,
The White House:

I have the honor to submit to the President, with a view to its transmission to the Senate to receive the advice and consent of that body to ratification, if his judgment approve thereof, a certified copy of a convention revising the convention of Paris for the protection of industrial property of March 20, 1883, revised at Brussels, December 14, 1900; at Washington, June 2, 1911; at The Hague, November 6, 1925; and at London, June 2, 1934. The United States was a party to the original convention and became a party to these four later revisions. The present revision was formulated at an International Conference held at Lisbon (October 6-31, 1958) for the purpose of revising the convention in force. At the conclusion of the Conference, the present revision was signed October 31, 1958, on behalf of the United States of America and 29 other countries of the Union for the protection of industrial property constituted under the convention in force. One country not a member of the Union also signed the revision and two other member countries signed at a later date.

The convention, as presently in force, to which the United States and 49 other countries are parties, is the major intergovernmental instrument assuring protection of industrial property rights (patents, designs, trademarks, commercial names, and related rights) of U.S. nationals abroad. Under the terms of the convention, the government of each member country is required to extend to nationals of other member countries the same treatment with respect to the protection of these rights as it extends to its own nationals. U.S. citizens are thus assured that they will not be discriminated against under the laws of other countries which are members of the convention. Nationals of member countries are also accorded certain special rights and advantages in all member countries. One of the most important rights is a 1-year period, from the date of filing a patent application at home, in which to file corresponding applications abroad and acquire appropriate protection in other member countries (right of priority). Nationals of member countries are also accorded protection against arbitrary forfeiture of their patents in member countries if they are not immediately worked.

A Bureau of the International Union established by the convention handles its administrative activities. The Bureau also prepares, organizes, and performs the administrative services for the conferences of revision.

The preparatory work which the United States undertook for the Lisbon Conference included the organization of an Advisory Committee consisting of representatives of leading business and professional groups in the United States interested in the industrial property rights field. The views of this Committee were thoroughly considered at a series of interdepartmental meetings and discussions which were held by various agency representatives preparatory to the adoption and transmission of instructions to the U.S. delegation to the Conference. The delegation included three leading private patent and trademark attorneys as advisers. It was also fortunate in having the Honorable Alexander Wiley of the Judiciary Committee of the U.S. Senate as an adviser and the Honorable Roland V. Libonati of the Judiciary Committee of the House of Representatives as an observer.

The Conference, in formulating a new revision to the convention, adopted a number of provisions designed to broaden its protective framework and to remove certain longstanding ambiguities. In this connection, the basic provisions on trademark protection were substantially rewritten in such a way as to define more clearly their purposes and to increase the scope of protection accorded for the trademark rights of nationals of member countries. The Conference also agreed on the inclusion of a new requirement in the convention that all countries grant protection to industrial designs. This new provision should enable U.S. nationals to acquire design protection in those member countries where, in the past, they have been unable to do so because of the absence of domestic legislation. It also included in the convention for the first time a specific reference to the protection of trademarks associated with services, as distinct from those used to identify goods. While the United States provides for registration of service marks under the United States Trademark Act of 1946 (60 Stat. 427), very few other countries of the Union have such provisions in their laws. This new convention provision will significantly assist U.S. businessmen in acquiring such protection abroad. Another important step was the adoption of a provision for regular triennial meetings of representatives of the convention countries. While there had previously been a certain amount of coordination through the International Bureau, the member governments had not met on a multilateral basis since 1934. This new provision for regular meetings will enable representatives of the member governments to discuss more frequently than in the past common problems respecting the administration of their respective patent and trademark laws. The member governments will also be in a better position to facilitate the preparatory work for the diplomatic conferences of revision through regular opportunities for preliminary discussions of the basic issues to be considered. They will also be able to resolve certain administrative details which might otherwise have to be dealt with at the diplomatic conferences of revision.

Under the provisions of article 17 of the revised convention, each member government agrees to adopt, in accordance with its constitution, such measures as are necessary to insure the application of the convention within its jurisdiction. Further, each member government agrees that it will be in a position under its domestic law to give effect to the convention at the time at which it deposits its instrument of ratification. Accordingly, the United States' instrument of ratification of the convention will not be deposited until after the adoption of such legislation as is necessary to bring the domestic law of the United States into conformance with the provisions of the convention. A draft of suggested legislation to this end is being submitted to the Congress. The only legislative changes which will be necessary are amendments to the patent and trademark laws which will permit applicants to claim their right of priority (1 year for patents and 6 months for trademarks) in the United States not only from the date of their first filing but also from the date of a subsequent filing in a member country should the first filing be withdrawn under certain specified conditions.

It will be noted from the certified copy that the original of the convention is in the French language and that official translations by the

International Bureau for the Protection of Industrial Property will be established in other languages, including English. There is enclosed for the information of the Senate, an English translation which has been certified by the Department of State as being in conformity with the authentic French text and that both texts have the same meaning in all substantive respects. Due to various technical reasons the Department of State did not receive the certified copy of the authentic French text until December 1959.

The convention will come into force on June 1, 1963, with respect to those countries which have deposited an instrument of ratification with the Swiss Government not later than May 1, 1963. If, prior to the latter date, the new convention is ratified by at least six countries, it shall come into force between those countries 1 month after they have been notified by the Swiss Government of the deposit of the sixth ratification.

The revised convention effects long-needed changes in the field of international protection of industrial property rights. U.S. participation in this new convention will significantly improve the protection in this field accorded to U.S. private interests abroad. Further, U.S. participation in the new convention will insure continuing sound and cooperative relations in the important field of industrial property rights with the other 49 countries that are parties to 1 or more of the revision conventions presently in force. Therefore, it is hoped that the newly revised convention will be given early and favorable consideration.

Respectfully submitted.

/s/ CHRISTIAN A. HERTER.

EXECUTIVE COMMUNICATIONS

THE SECRETARY OF COMMERCE,
Washington, D.C., March 17, 1961.

HON. EMANUEL CELLER,
Chairman, Committee on the Judiciary,
House of Representatives, Washington, D.C.

DEAR MR. CHAIRMAN: On January 17, 1961, before the present administration took office, the Department of Commerce submitted to the 87th Congress for introduction the following item of draft legislation to carry into effect a provision of the Convention of Paris for the Protection of Industrial Property as revised at Lisbon, Portugal, October 31, 1958.

The draft legislation was referred to your committee for consideration on January 18, 1961, by Executive Communication No. 367 but has not as yet been introduced.

You are advised that the Department has reexamined this item and we continue to support its enactment and urge that it be introduced.

The Bureau of the Budget has advised that there is no objection from the standpoint of the administration's program to our continued support of this draft legislation.

Sincerely yours,

LUTHER H. HODGES,
Secretary of Commerce.

STATEMENT OF NEED FOR AND PURPOSE OF PROPOSED LEGISLATION

The International Convention for the Protection of Industrial Property to which the United States has been a party since 1887, was revised on October 31, 1958, and the new convention has been submitted for ratification by the Senate (Congressional Record, Feb. 17, 1960, pp. 2529-2530). This convention is not self-executing and legislation would be required to carry into effect any provisions not already in our present law. Article 17 of the new convention also requires that the time an instrument of ratification is deposited the country must be in a position under its domestic law to give effect to its terms.

The revised convention makes quite a number of changes in detail over the previous revision of the instrument. However, most of these changes are already provided for or taken care of in one way or another by existing law in the United States. There is one change which would require a specific amendment to the statutes. This is new paragraph 4 which has been added to article 4C of the convention, relating to the right of priority.

According to article 4 of the Convention, if a person has regularly filed an application for a patent in one country and thereafter within 1 year files another application for patent for the same invention in another country, the second application is given as an effective filing date the date of filing the first application; in effect, the filing of an application for patent in one country constitutes a constructive filing of applications for patent for the same invention in all the other countries on the same date, which constructive filing is made actual in a particular country by the filing of a formal application in that country within 1 year of the date of filing of the first application. The period of priority is specified in article 4C as 1 year from the date of filing of the first applicaiton in the case of patent applications and 6 months in the case of trademark applications. This provision of the Convention is enacted in title 35, United States Code, section 119 in the case of patent applications and in title 15, United States Code, section 1126(d) in the case of trademark applications.

The revision of article 4C of the Convention provides that under certain exceptional circumstances the period of 1 year for the right of priority may start from a second or later filed application, instead of from the filing date of the first foreign application. The conditions under which this may be done are somewhat limited but the provision would be an advantage to American Citizens filing abroad in some cases. Inasmuch as title 35, United States Code, section 119 and title 15, United States Code, section 1126(d) are both limited in language to the first foreign application, an amendment to these two sections is necessary. The proposed form of the amendment is merely the addition of a paragraph to the two sections mentioned, in language paralleling the language of the treaty.

DEPARTMENT OF STATE,
Washington, May 16, 1961.

HON. EMANUEL CELLER,
Chairman, Committee on the Judiciary,
House of Representatives.

DEAR MR. CHAIRMAN: In your letter of April 28, 1961, you advise the Department that Subcommittee No. 3 will conduct public hearings, May 18, 1961, on a bill (H.R. 5754) to carry into effect a provision of the Convention of Paris for the Protection of Industrial Property as revised at Lisbon, Portugal, October 31, 1958, and suggest the submission of a statement for the record, if the Department does not plan to send a representative to testify.

The Department appreciates the invitation to provide a representative at these hearings to acquaint the subcommittee with its views on the bill. Although it does not plan to have a representative testify, the Department is strongly in favor of the bill and has prepared a statement for inclusion in the record supporting its enactment. The statement is enclosed.

Sincerely yours,

BROOKS HAYS,
Assistant Secretary
(For the Secretary of State).

DEPARTMENT OF STATE STATEMENT ON H.R. 5754

The Convention of Paris for the Protection of Industrial Property, to which H.R. 5754 pertains, is the major intergovernmental instrument assuring protection abroad of industrial property rights of U.S. nationals (patents, trademarks, designs, commercial names, and related rights). The Department also considers this Convention the most effective mechanism for insuring continuing and sound cooperative relations with other countries in the industrial property rights field. The Convention is based on two important principles; namely, "national treatment" and the extension of special rights or advantages. Under the "national treatment" principle each member country is required to extend to nationals of other member countries the same protection and rights which it grants to its own nationals in this field. Under the second principle each country is required to provide certain rights or special advantages for other members' nationals. One of the most important of these rights is the right of priority for foreign patent and trademark applicants. H.R. 5754 deals specifically with implementation of these right of priority provisions in the United States.

This Convention, to which the United States and approximately 50 other countries are parties, was originally adopted in 1883 and was revised 4 times (1900, 1911, 1925, and 1934) prior to the revision adopted at Lisbon in 1958. The changes which have been made over the years in these four revisions have strengthened and made more effective the patent and trademark protection afforded nationals of of the member countries. The United States became a party to the original convention and these four subsequent revisions. The Lisbon revision is not yet in force as between any countries. The Department believes, however, that this new revision is particularly significant and merits this Government's strong support because of the far-reaching improvements which it has provided for in the international

industrial property field. One of the most important of these improvements relates to the establishment of machinery for interim meetings by the member governments between diplomatic conferences of revision to enable them to study and discuss more frequently than in the past problems arising under the Convention. In this connection, the revised Convention includes a provision for regular triennial meetings of representatives of the member governments. Significant changes have also been effected by the Lisbon revision through a re-writing of the basic provisions in the Convention concerning the protection of trademarks. These have been rewritten in such a way so as to increase substantially the protection accorded for the trademark rights of nationals of member countries. Also for the first time specific reference to the protection of trademarks associated with services, as distinct from those used to identify goods, has been provided for in the new Convention revision.

The Lisbon revision of the Convention was transmitted to the Senate by the President on February 17, 1960 (S. Doc. Ex. D, 86th Cong., 2d sess.) and received the Senate's advice and consent to ratification on August 17, 1960. This new revision received strong support of the Department in testimony by Assistant Secretary of State for Economic Affairs, Mr. Edwin M. Martin, before the Senate Foreign Relations Committee, June 21, 1960. Leading business and professional groups in the United States interested in the industrial property rights field, such as the National Foreign Trade Council, the U.S. Council of the International Chamber of Commerce, and the Patent and Trademark Section of the American Bar Association, also wholeheartedly endorsed this new revision. In fact, the Department is not aware of any business or professional group that is opposed to the United States becoming a party to this latest revision. Under the terms of article 17 of the Lisbon revision, this revision is not self-executing; that is, its ratification would not by itself modify our domestic law. This article specifies that at the time a country deposits its instrument of ratification it must be in a position under domestic law to give effect to the Convention's terms. Most of the changes embodied in the new revision do not require amendments to U.S. statutes since such changes are already consonant with our law. Only minor changes will be needed in the right of priority provisions of our patent and trademark laws in order fully to implement the new Convention. These changes would be effected with the enactment of H.R. 5754. The United States, therefore, will not be able to deposit its instrument of ratification until after enactment of the legislation embodied in H.R. 5754 which is designed to make these necessary changes in our patent and trademark laws.

The Department accordingly is strongly in favor of the enactment of H.R. 5754 at an early date since the legislation which it embodies is essential for ratification of the revised Convention and its entry into force as between the United States and other countries. Also, U.S. participation in the new revision will insure that our relations with the other member countries will continue on a sound basis in this important area of our foreign economic policy relating to the protection of industrial property rights. For these reasons the Department is strongly convinced that enactment of H.R. 5754 is most desirable and it will be in the public interest by fully implementing under our present laws the Industrial Property Convention as revised at Lisbon.

DEPARTMENT OF JUSTICE,
May 12, 1961.

HON. EMANUEL CELLER,
Chairman, Committee on the Judiciary,
House of Representatives,
Washington, D.C.

DEAR MR. CHAIRMAN. This is in response to your request for the views of the Department of Justice concerning the bill (H.R. 5754) to carry into effect a provision of the Convention of Paris for the protection of Industrial Property as revised at Lisbon, Portugal, October 31, 1958.

Section 119 of title 35, United States Code, provides that an application for a patent filed in the United States by a person who has previously filed an application for a patent for the same invention in a foreign country which affords similar privileges, shall have the same effect as if filed in this country on the date on which it was first filed in the foreign country, subject to certain conditions. This bill would grant the same priority rights with respect to a subsequent application filed in a foreign country if the first filed foreign application has been withdrawn, abandoned, or otherwise disposed of, without leaving any rights outstanding. A similar change would be made in section 44(d) of the act of July 5, 1946 (15 U.S.C. 1126(d)) which pertains to the registration of trademarks. The amendment suggested by this bill closely follows the substance of subparagraph (4) of article 4C of the Convention of Paris for the Protection of Industrial Property of March 20, 1883, as revised at Lisbon October 31, 1958.

This bill involves matters not within the purview of the Department of Justice and accordingly the Department prefers to make no recommendation concerning its enactment.

The Bureau of the Budget has advised that there is no objection to the submission of this report from the standpoint of the administration's program.

Sincerely yours,

BYRON R. WHITE,
Deputy Attorney General.

CHANGES IN EXISTING FEDERAL LAW AFFECTED BY HR 5754 AND HR 7347

(New matter in italics)

TITLE 35, UNITED STATES CODE

§ 119. BENEFIT OF EARLIER FILING DATE IN FOREIGN COUNTRY, RIGHT OF PRIORITY.

An application for patent for an invention filed in this country by any person who has, or whose legal representatives or assigns have, previously regularly filed an application for a patent for the same invention in a foreign country which affords similar privileges in the case of applications filed in the United States or to citizens of the United States, shall have the same effect as the same application would have if filed in this country on the date on which the application for patent for the same invention was first filed in such foreign country, if the application in this country is filed within twelve months from

the earliest date on which such foreign application was filed; but no patent shall be granted on any application for patent for an invention which had been patented or described in a printed publication in any country more than one year before the date of the actual filing of the application in this country, or which had been in public use or on sale in this country more than one year prior to such filing.

No application for patent shall be entitled to this right of priority unless a claim therefor and a certified copy of the original foreign application, specification and drawings upon which it is based are filed in the Patent Office before the patent is granted, or at such time during the pendency of the application as required by the Commissioner not earlier than six months after the filing of the application in this country. Such certification shall be made by the patent office of the foreign country in which filed and show the date of the application and of the filing of the specification and other papers. The Commissioner may require a translation of the papers filed if not in the English language and such other information as he deems necessary.

In like manner and subject to the same conditions and requirements, the right provided in this section may be based upon a subsequent regularly filed application in a foreign country, instead of the first filed foreign application, provided that any foreign application filed prior to such subsequent application has been withdrawn, abandoned, or otherwise disposed of, without having been laid open to public inspection and without leaving any rights outstanding, and has not served, nor thereafter shall serve, as a basis for claiming a right of priority.

TITLE 15, UNITED STATES CODE

§ 1126. INTERNATIONAL CONVENTIONS.

* * * * *

(d) **RIGHT OF PRIORITY.**—An application for registration of a mark under sections 1, 2, 3, 4, or 23 of this Act filed by a person described in paragraph (b) of this section who has previously duly filed an application for registration of the same mark in one of the countries described in paragraph (b) shall be accorded the same force and effect as would be accorded to the same application if filed in the United States on the same date on which the application was first filed in such foreign country: *Provided, That—*

(1) the application in the United States is filed within 6 months from the date on which the application was first filed in the foreign country;

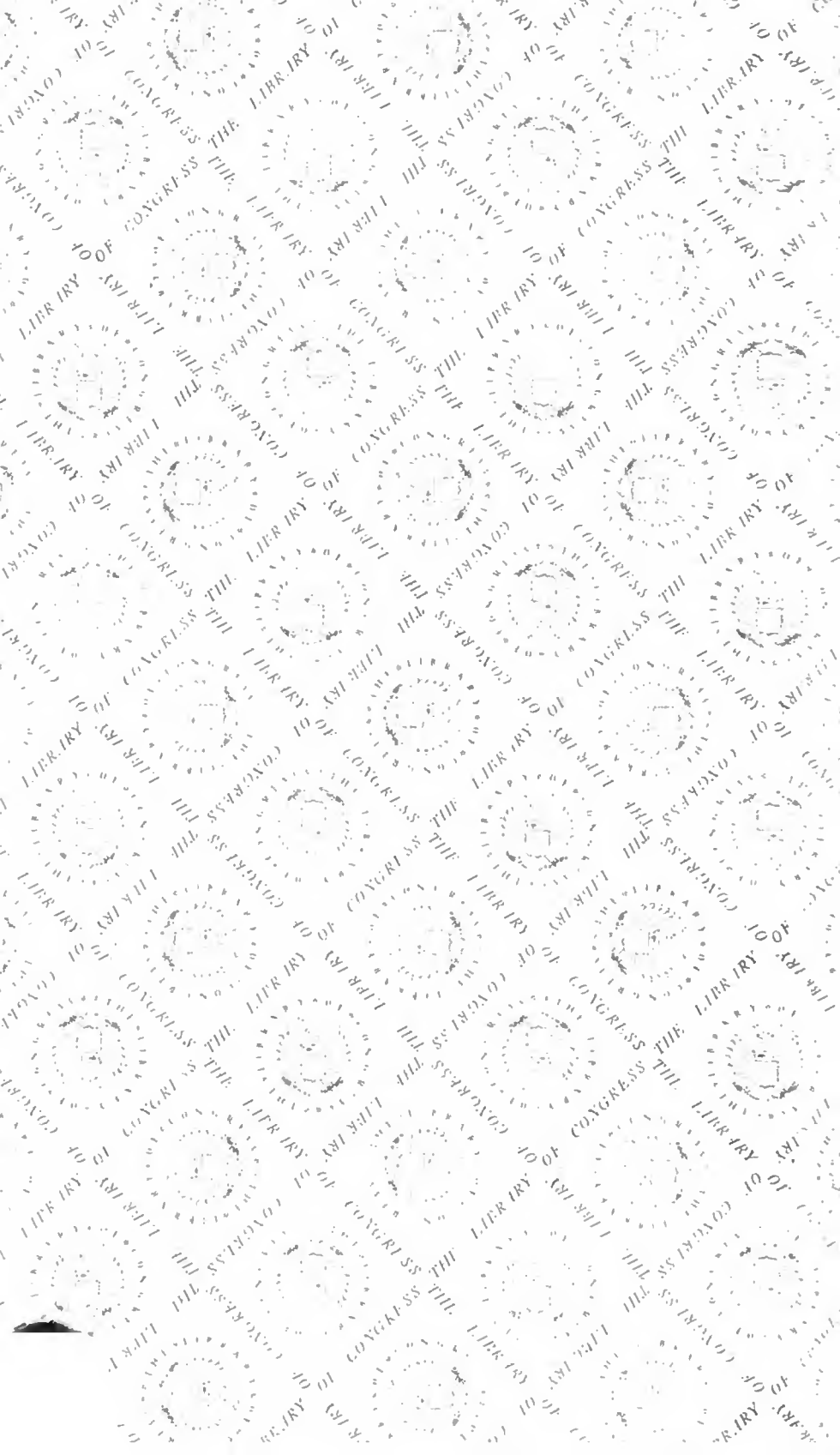
(2) the application conforms as nearly as practicable to the requirements of this Act, but use in commerce need not be alleged;

(3) the rights acquired by third parties before the date of the filing of the first application in the foreign country shall in no way be affected by a registration obtained on an application filed under this subsection (d);

(4) nothing in this subsection (d) shall entitle the owner of a registration granted under this section to sue for acts committed prior to the date on which his mark was registered in this country unless the registration is based on use in commerce.

In like manner and subject to the same conditions and requirements, the right provided in this section may be based upon a subsequent regularly filed application in a foreign country, instead of the first filed foreign application: Provided, That any foreign application filed prior to such subsequent application has been withdrawn, abandoned, or otherwise disposed of, without having been laid open to public inspection and without leaving any rights outstanding, and has not served, nor thereafter shall serve, as a basis for claiming a right of priority.







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